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Express Mail No.: EV452 772 641 US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of: Ajit Rajasekharan

Confirmation No.: 7385

Serial No.: 09/987,597

Art Unit: 2876

Filed: November 15, 2001

Examiner: K. Koyama

For: SYSTEM AND METHOD FOR  
AUTHORING AND PROVIDING  
INFORMATION RELEVANT TO  
THE PHYSICAL WORLD

Attorney Docket No.: 802959-999002

**AUTHORIZATION FOR FEE PAYMENT UNDER 37 CFR § 1.17(h)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

It is believed that a processing fee under 37 CFR § 1.17(h), estimated to be \$130, is required for the accompanying petition under 37 CFR §§ 1.181-183, which is attached to the above mentioned petition, for an estimated total of \$130. The commissioner is authorized to charge the required processing fees for the attached petition to Jones Day Deposit Account No. 503013. A copy of this page is enclosed.

Respectfully submitted,

Date May 24, 2004

Rattan Nath  
for

Registration No. 43,827

Ognjan V. Shentov

Registration No. 38,051

**JONES DAY**

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New York, New York 10017  
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05/28/2004 AWONDAF2 00000005 503013 09987597

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Express Mail No.: EV 452 772 641 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Ajit Rajasekharan.	Confirmation No.:	7385
Serial No.:	09/987,597	Art Unit:	2876
Filed:	November 15, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO THE PHYSICAL WORLD	Attorney Docket No.:	033393.0003
Application of:	Kovesdi et al.	Confirmation No.:	3522
Serial No.:	10/035,952	Art Unit:	2876
Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	802959- 999002

REQUEST FOR RECOGNITION AS A PROPER PARTY  
UNDER 37 C.F.R. §§ 1.181-1.183

Commissioner for Patents  
Office of Petitions  
P. O. Box 1450  
Alexandria, Va 20231

Dear Sir:

The inventorship of the above-captioned applications (hereafter the '597 application and the '952 application) is in dispute. To resolve this dispute, Petitioner Rozsa Kovesdi, a co-inventor of the '952 application, respectfully requests the Commissioner to grant her Proper Party in Interest status in the '597 application, which names Mr. Ajit Rajasekharan as the sole inventor. In the alternative, Ms. Kovesdi respectfully requests that no patent be allowed to issue from the '597 application before the inventorship issue is resolved by the Patent Office on the merits to ensure compliance with 35 U.S.C. §§ 102(f), 116 & 131.

Both the '597 and the '952 applications claim priority to Provisional Application Ser. No. 60/306,356 ("the '356 application) and cover substantially similar subject matter. The original '356 application was filed on July 18, 2001 naming Ms. Kovesdi and Mr. Rajasekharan as co-inventors. Despite that, on November 15, 2001 Mr. Rajasekharan filed the '597 application as a sole inventor. Ms. Kovesdi filed the '952 application on December 26, 2001, naming both herself and Mr. Rajasekharan as inventors. At this time, the applicants dispute the inventorship of claims in both applications, but for procedural reasons their dispute cannot be properly presented to the Patent Office for resolution.

In particular, Mr. Rajasekharan was allowed by the Patent Office to join in the prosecution of the '952 application despite his express declaration that he considers himself to be the sole inventor of "a substantial number of the presented claims including all independent claims" and the disclosure that he had already filed an application that names him as the sole inventor. Instead of inviting Mr. Rajasekharan pursuant to MPEP 409.03(i) to prove his sole-inventorship claim through interference, at his request the Patent Office further required that any response filed in the '952 application must be signed by representatives of both inventors. This way, the Patent Office effectively precluded Ms. Kovesdi from seeking an interference in her own '952 application. Indeed, at this time, Mr. Rajasekharan has refused to sign any substantive response in the '952 application unless it involves cancellation of all claims that he considers to be his sole invention in favor of corresponding claims in his '597 application.

By contrast, Ms. Kovesdi was precluded from establishing her status as a co-inventor of the '597 application. Specifically, the Patent Office denied Ms. Kovesdi's request to join in the prosecution of the '597 application as a co-inventor solely on the ground that she was not named as an inventor in the declaration filed by Mr. Rajasekharan. Because Ms. Kovesdi also is not an assignee of the '597 application, the Patent Office determined that she is not a "proper party in interest" in this application. Thus, the Patent Office effectively decided the inventorship dispute in the '597 application based solely on a document filed by Mr. Rajasekharan, with no other corroboration.

These two decisions by the Patent Office have practically precluded consideration of the inventorship issue on the merits and have given Mr. Rajasekharan control over both the '952 and the '597 applications. So far, this control has manifested itself in his apparent willingness to let the '952 application go abandoned unless all claims of which he is the



alleged sole inventor are canceled. Further, in a letter of April 8, 2004, Mr. Rajasekharan and representatives of a commercial entity, Readia, to which he appears to have assigned his interest (collectively “Rajasekharan”) have continued to insist on a resolution of the inventorship dispute outside the Patent Office and in a manner unacceptable to Ms. Kovesdi.

To remedy this exceptional situation, Ms. Kovesdi respectfully requests that the Patent Office allows her to join in the prosecution of the ‘597 application on the ground that she is a proper party in interest as a co-inventor of claimed subject matter. In particular, Ms. Kovesdi provides herewith substantive evidence of her claim to co-inventorship of the ‘597 application, establishing her proprietary interest in this application. The submitted evidence is in the form of documents, including admissions by Mr. Rajasekharan of Ms. Kovesdi’s contribution to:

(i) the subject matter of “most” claims, which contribution was so extensive that Mr. Rajasekharan himself judged the task of separating her contributions from his own to be “futile;” and

(ii) the conception and development of “coincident authoring,” a specific feature pervasive in the claims in the ‘597 application.

In the alternative to letting her join in the prosecution, Ms. Kovesdi asks the Patent Office to require Mr. Rajasekharan to rebut the supplied evidence in support of her claim as a co-inventor in the ‘597 application, pursuant to 35 U.S.C. §102(f) and MPEP 2137 and in particular that he did not derive the subject matter claimed in the ‘597 patent from the collaboration work that resulted in the filing of the provisional ‘356 application. Until the inventorship issue is resolved, Ms. Kovesdi requests that the Patent Office does not allow any patent to issue from the ‘597 application.

### **STATEMENT OF FACTS**

1. During 2001 while working to develop technology to link customizable information to physical objects, locations and events, Ms. Rozsa Kovesdi disclosed her ideas to Mr. Ajit Rajasekharan. Ms. Kovesdi proposed an idea referred to as the “Talking Treasures,” where objects can relate information to a user. Although on March 14, 2001 in view of prior art brought to his attention by Ms. Kovesdi Mr. Rajasekharan questioned “[c]an

we still do something in this area then" (Exh. A, p.1), Mr. Rajasekharan admitted in an email dated March 15, 2001 that "Talking Treasures" and related ideas of Ms. Kovesdi sent him "into a frenzy." (Exh. A, p. 3).

2. Mr. Rajasekharan summarized their developing collaboration in a document entitled "Barcode - compilation of our thoughts" sent to Ms. Kovesdi by email on March 16, 2001. (Exh. A, p. 6). Two days later, in an email dated March 18, 2001, Mr. Rajasekharan proposed filing at least two patent applications - one directed to a device and one broadly related to service. (Exh. A, p. 10). The latter was subsequently referred to as the 'system patent.' (Exh. A, p. 11).

3. Mr. Rajasekharan conceded that he had not been "of much help" in the 'system patent', the "key patent." (Exh B, p.1 (1st email)) and in several email messages he identified and acknowledged Ms. Kovesdi's contributions to the joint effort. (Exh. B). In particular, in another email dated April 30, 2001 he acknowledged that Ms. Kovesdi has solved "the hard problem of maintaining association between objects, labels, and the authored content" and admitted that she was responsible for this key idea [referred to hereafter as coincident authoring]. (Exh. B, p. 2). This idea was included in the revised abstract of the proposed patent application, which he sent to her on May 2, 2001. (Exh. B, p. 5-17). The abstract of the application draft was revised to include the following feature contributed by Ms. Kovesdi: "[i]n authoring mode the device supports content authoring to immediately follow object scanning – this enables authored content to be unambiguously bound to the scanned object and thus solving the problem of maintaining correspondence between physical object, object label and the authored content." (Exh. B, p. 5 (Abstract)).

4. Ms. Kovesdi & Mr. Rajasekharan filed provisional application, Ser. No. 60/306,356, on July 18, 2001, the parent of the '597 application. The '356 application included seventy claims.

5. Mr. Rajasekharan described his and Ms. Kovesdi's contributions to the subject matter claimed in the '356 application in an August 31, 2001 email, as follows: "[t]he system patent – the one we already filed. There is no doubt in my mind about who its inventors are – Rozi and Ajit in equal measure." (Exh. C, p. 7 (numeric 1), emphasis added). Mr. Rajasekharan then admitted that Ms. Kovesdi triggered the right ideas in him and vice versa with the result that "[m]ost of the claims in our system [patent] are the results of such

confluences of both our ideas.” (Exh. C, p. 9 (1<sup>st</sup> paragraph) emphasis added). The term ‘system patent’ refers to the ‘356 application, which was the only application jointly filed by Ms. Kovesdi and Mr. Rajasekharan.

6. On November 15, 2001 Mr. Rajasekharan filed the ‘597 application, claiming priority to the ‘356 application and naming himself as the sole inventor. The ‘597 application includes 70 claims, of which 67 are substantially identical to those in the ‘356 application. Ms. Kovesdi filed the ‘952 application on December 26, 2001, also claiming priority of the ‘356 application and naming both herself and Mr. Rajasekharan as the inventors. (Exh. E). The ‘952 application is identical to the ‘356 application.

7. After attempts to reach out to Mr. Rajasekharan failed, on May 13, 2002 Ms. Kovesdi’s filed a petition under 37 C.F.R. § 1.47(a) asking permission to prosecute the ‘952 application on behalf of herself and the non-signing inventor. (Exh. F).

8. On June 4, 2002 Mr. Rajasekharan filed a petition under 37 C.F.R. § 1.182 in the ‘952 application, asking for appointment of a power of attorney by less than all applicants. The petition stated that Mr. Rajasekharan desires his own representation to prosecute the ‘952 application, because he is the sole inventor “of a substantial number of the presented claims including all independent claims,” and that “a portion of the solely conceived claims are being prosecuted in a copending U.S. utility patent application” naming him as the sole inventor. Mr. Rajasekharan’s June 4 petition also requested that both parties be required to sign all subsequent replies under MPEP §402.10, stating that “this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources.” (Exh. G, p. 2).

9. The Patent Office dismissed Mr. Rajasekharan’s June 4 petition in the ‘952 application because the declaration filed along with this petition omitted Ms. Kovesdi as an inventor. In the same document the Patent Office invited Mr. Rajasekharan to consider filing his own application in case he believed the inventorship of the ‘952 application to be in error. (Exh. H, p. 1).

10. On September 17, 2002, the Patent Office granted Mr. Rajasekharan’s second 37 C.F.R. § 1.182 petition, which included a newly executed declaration, listing both himself and Ms. Kovesdi as co-inventors of the ‘952 application, dismissed Ms. Kovesdi’s 37 C.F.R.

§ 1.47(a) petition, and imposed a requirement that all further correspondence be signed by representatives of both parties. (Exh. I).

11. On February 6, 2003 the '597 application was published. (Exh. D). This was the first time that Ms. Kovesdi gained access to the content of the '597 application.

12. The Patent Office mailed on March 18, 2003 an Office Action rejecting all of the pending claims in the '597 application. (Exh. J). The first Office Action in the '952 application, also issued on March 18, 2003, (Exh. K), rejecting 67 of the 70 pending claims provisionally for statutory double patenting, in view of the pending claims in the '597 application. (Exh. K, p. 3).

13. In response to the Office Action in the '952 application, on May 21, 2003, Mr. Rajasekharan proposed to cancel all pending claims except dependent claims 43 and 44 and to include a statement that the canceled claims are pursued in the '597 application, listing Mr. Rajasekharan as the sole inventor. (Exh. L, p. 1 & 3). This draft response is the first time Mr. Rajasekharan stated his specific contentions concerning the inventorship of the claims in the '952 application, and included no support for these contentions.

14. In the '597 application, Mr. Rajasekharan filed a response on June 11, 2003. The response indicated that there is an inventorship dispute in the '952 application, but did not provide any evidence to substantiate their position that Ms. Kovesdi is not a co-inventor of the '597 application. The filed response also indicated for the first time that Mr. Rajasekharan joined the '952 application to only pursue two claims. (Exh. S, p.11). This response also did not include Mr. Rajasekharan's admissions of Ms. Kovesdi's contributions to the claimed subject matter. (Exh. S).

15. In response to the Office Action in the '952 application Ms. Kovesdi's representatives drafted a separate substantive response addressing all pending claims and provided this draft response to Mr. Rajasekharan for review and signature. (Exh. M, September 15, 2003).

16. Mr. Rajasekharan rejected the proposed substantive draft response, insisting that his draft of the response canceling all but two claims should be filed. In a letter of September 22, 2003, Mr. Rajasekharan stated that "[a]lthough we find your technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent

with the technical positions that Mr. Rajasekharan has taken in his case, the overall approach of this response is certainly adverse to Mr. Rajasekharan's interests as it continues Ms. Kovesdi's pursuit of claims solely conceived by Mr. Rajasekharan, i.e., renumbered claims 1-42 and 45-70." (Exh. N). Ms. Kovesdi's representatives filed on the same day a supplemental response to the Office Action, including a copy of the September 22 letter, and asked the Patent Office to accept the September 22 letter in lieu of Mr. Rajasekharan's signature.

17. Ms. Kovesdi's representatives drew the attention of Mr. Rajasekharan to the improper inventorship declared in the '597 application in several communications and letters dated September 29, 2003 and October 9, 2003. (Exh. O).

18. In support of his assertion of sole inventorship in the '587 application, Mr. Rajasekharan provided the "key parts of the documentation relating to inventorship" in a letter dated November 13, 2003. The entirety of the provided documentation is included in Exh. P.

19. On December 16, 2003, the Patent Office issued an Office Action in the '952 application, stating that while the September 18 and 22, 2003 reply in the '952 application "appears to be bona fide," it lacked the signatures of both parties. The examiner gave applicants one month to correct. Representatives of Ms. Kovesdi have been unable to obtain Mr. Rajasekharan's signature, despite diligent efforts. In particular, following the December 16, 2003 Office Action, representatives of Ms. Kovesdi unsuccessfully requested Mr. Rajasekharan in letters dated January 6, 2004 and in other communications, to sign the admittedly correct response to the Office Action in the '952 application. (Exh. Q).

20. On January 12, 2004, the Patent Office rejected Ms. Kovesdi's petition to join as a co-inventor in the '597 application. The rejection is on the ground that she is not a "proper party in interest" apparently because she was not listed on the first executed declaration in this application. The Patent Office expressly stated that it did not consider the petition to join as a co-inventor on the merits. (Exh. R).

21. Ms. Kovesdi's representatives again informed Mr. Rajasekharan's representatives in a letter dated April 1, 2004 that Ms. Kovesdi's rights as a co-inventor of the subject matter claimed in the '597 application were being violated. (Exh. T).

22. In a letter of April 8, 2004, Mr. Rajasekharan stated that the options acceptable to them in the '952 application are: (1) to cancel the claims that allegedly are solely Mr. Rajasekharan's contribution; (2) sign a joint petition to suspend the prosecution of the application; and (3) sign a joint request for the filing of a continuation application. The April 8 letter also states that "[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned." (Exh. U).

### **ARGUMENT**

#### **Ms. Kovesdi is a proper party in interest in the '597 application**

The Patent Office did not consider on the merits Ms. Kovesdi's April 21, 2003 petition under 37 C.F.R. 1.182 and 37 C.F.R. 1.48 to join in the prosecution of the '597 application allegedly because she failed to establish that she is a proper party in interest, as she was not a named inventor in the originally filed declaration, or an assignee. (Exh. R). Although under MPEP 2137.01 executors of an oath or declaration under 37 C.F.R. 1.63 are presumed to be the inventors, it is respectfully submitted that this presumption is rebuttable where, as here, the inventorship is in dispute. Furthermore, with reference to 37 C.F.R. 1.47(b) and MPEP 409.03(f), a proper party in interest status need not be limited to the named inventors or assignees, but also includes one "who otherwise shows sufficient proprietary interest in the matter." The following evidence demonstrates that Ms. Kovesdi is a co-inventor of the subject matter claimed in the '597 application and has proprietary interest in the matter at least because the claims of the '597 application derive directly either from her joint work with Mr. Rajasekharan or from her own work.

#### **General admissions as to the claimed subject matter of the '597 application**

The '597 application claims priority from the provisional '356 application, which was filed jointly by Ms. Kovesdi and Mr. Rajasekharan. The '597 application has 70 claims, of which 67 claims are substantially identical to corresponding claims of the provisional '356 application. Here is what Mr. Rajasekharan admitted concerning the inventorship of the claims of the '356 application in an email dated August 31, 2001: "[l]et me get the facts straight . . . . The system patent – the one we already filed [provisional '356 application]. There is no doubt in my mind about who its inventors are – Rozi and Ajit in equal measure." See, Exh. C, p. 7, numeric 1.

Mr. Rajasekharan further conceded that "[i]n fact, even with both our contributions to the system and device patent – there have been several instances where I would say some statement which may not have a direct relevance to a claim but it would trigger the right idea in you and vice versa. Most of the claims in our system [patent] are the results of such confluences of both our ideas – to me it is a futile exercise to dissect them apart and say who contributed what" (emphasis added). See, Exh. C, e.g., p. 9, lines 10-15. (The term 'system patent' refers to the provisional '356 application; the term 'device patent' refers to a later-filed patent application Ser. No. 10/103,777).

Indeed, the Patent Office itself determined that the claims in the '597 application are substantially identical to corresponding claims in the '356 application. In particular, claims in the '952 application, which is identical to the '356 provisional application, were rejected for statutory double patenting in view of corresponding claims in the '597 application. See Exh. K, p. 3.

In summary, Mr. Rajasekharan's clearly and unambiguously has admitted that most of the claims in the '597 application are derived from the joint effort of Mr. Rajasekharan and Ms. Kovesdi, rather than being his sole invention. In view of these admissions, there is simply no basis for Mr. Rajasekharan's continuing insistence that he is the sole inventor of the claimed subject matter in the '597 application and the sole inventor of all but two claims in the '952 application (which are identical to those in the '356 application).

**Mr. Rajasekharan specifically admitted that Ms. Kovesdi contributed 'coincident authoring,' a core feature to claims in the '597 application**

In addition to the general admission concerning inventorship discussed above, Mr. Rajasekharan specifically acknowledged Ms. Kovesdi's conception of a core feature in the claims of the '597 patent - coincident authoring, which refers to the ability to unambiguously associate objects, labels and authored content. In particular, in an email to Ms. Kovesdi dated April 30, 2001, Mr. Rajasekharan stated:

"All the points you mentioned are absolutely right. In fact, I have added to the abstract the key idea you mentioned in your kitchen . . . . That is a very important one – it solves the hard problem of maintaining association between objects, labels, and the authored content." (emphasis added). See, Exh. B, p. 2.

The only sentence added by Mr. Rajasekharan to the abstract reads “[i]n authoring mode the device supports content authoring to immediately follow object scanning – this enables authored content to be unambiguously bound to the scanned object and thus solving the problem of maintaining correspondence between physical object, object label and the authored content” (emphasis added). See, Exh. B, p. 5.

This idea of coincident authoring, as described above is also present in at least claims 1, 13, 16, 31, 36, 39, 57 & 63 of the ‘597 application, which are listed in Exh. S, p. 2-10. For example, claim 1 of the ‘597 application reads as follows:

“A method for authoring information relevant to a physical world, comprising: detecting with an authoring device a first label associated with a first object; and triggering, in response to detecting, a system for authoring content; wherein the content is to be unambiguously bound to the first object and is to be rendered on a playback device during detection of the first label.” Claim 1, ‘597 application, emphasis added.

The underlined claim language virtually tracks the description Mr. Rajasekharan gave of Ms. Kovesdi’s “key idea.” (Exh. B, p. 5). Indeed, the only two steps of claim 1 are directed to coincident authoring - the first step directed to detecting a label and the second step directed to content authoring in response to the detection of the label, the content being unambiguously bound to the object. By his own admission, Mr. Rajasekharan did not conceive the claimed feature and therefore this claim in the ‘597 patent was either derived from Ms. Kovesdi’s work alone, or at the least from the joint efforts of Ms. Kovesdi with himself. Substantially similar limitations are present in the above-listed claims and are subject to substantially similar analysis. Again, in view of the general and specific admissions in various communications from Mr. Rajasekharan, it appears inconceivable that he can claim sole inventorship in the ‘597 application or the substantially similar claims in the ‘952 application.

Yet, this is the position Mr. Rajasekharan has officially taken before the Patent Office. In particular, Mr. Rajasekharan filed the ‘597 application as a sole inventor; he was also allowed to join in the prosecution of the ‘952 application in which he filed a declaration in which he claims to be the sole inventor “of a substantial number of the presented claims including all independent claims.” Exh. G.



In private communications between representatives of both parties, Mr. Rajasekharan has similarly asserted that “overwhelming evidence” shows him to be the sole inventor. In response to repeated requests by Ms. Kovesdi’s representatives for this “overwhelming evidence” of sole conception, Mr. Rajasekharan provided the documents included in Exh. P. Among others, these documents include a credit card receipt for a book with a content playback capability, and several e-mail communications and documents that are apparently not related to any particular claim. Further, the proffered evidence of sole conception by Mr. Rajasekharan actually includes a document entitled “Barcode – compilation of our thoughts” (emphasis added), Exh. P, pp. 10-13. In this document, Mr. Rajasekharan describes the book that “emanates sound” as “[n]ot very smart” and contrasts it with “talkingtreasures” – concededly Ms. Kovesdi’s contribution – as the means to “take this concept to a totally new dimension.” (Exh. P, pp. 12). This document also emphasizes the joint nature of their contribution by using terms such as ‘our,’ ‘us,’ ‘we’ to include Ms. Kovesdi, while never identifying Mr. Rajasekharan as being solely responsible for any particular contribution.

In summary, Mr. Rajasekharan has not provided, either to the Patent Office or to Ms. Kovesdi, any evidence of his asserted sole conception of the claims in either the ‘597 application or with respect to all but two claims in the ‘952 application. While at this procedural point he may not legally be required to provide such evidence, it is important that all the evidence, including his admissions discussed above, be considered before any determination is made as to the allowability of the claims and the issuance of any patent.

#### Miscellaneous considerations

As noted, in the alternative to letting her join in the prosecution of the ‘597 application, Ms. Kovesdi asks the Patent Office to require Mr. Rajasekharan to rebut the supplied evidence in support of her claim as a co-inventor in the ‘597 application, pursuant to 35 U.S.C. §102(f) and MPEP 2137 and in particular that he did not derive the subject matter claimed in the ‘597 application from the collaboration work that resulted in the filing of the provisional ‘356 application.

MPEP 2137 provides that while “derivation will bar the issuance of a patent to the deriver, a disclosure by the deriver . . . will not bar the issuance of a patent to the party from which the subject matter was derived.” Therefore, Ms. Kovesdi’s evidence of derivation by Mr. Rajasekharan also establishes her proprietary interest in the subject matter of the ‘597

application and her right to seek a patent, notwithstanding the filing of the '597 application by Mr. Rajsekharan, i.e., disclosure by him. Until the inventorship issue is resolved, Ms. Kovesdi requests that the Patent Office does not allow any patent to issue from the '597 application.

In particular, in addition to considerations under 35 U.S.C. §102(f), Ms. Kovesdi's interests in the '597 application may be irreparably harmed if the inventorship issue is not resolved by the Patent Office based on a recent Federal Circuit decision that places the enforceability of a patent in question where an inventor has been improperly omitted. Thus, in *Frank's Casing Crew and Rental Tools, Inc. v. PMR Technologies, Ltd.*, 63 USPQ.2d 1065, 1069 (Fed. Cir. 2002) the Federal Circuit held that a patent was unenforceable due to inequitable conduct on part of inventors who filed the underlying patent application and excluded an inventor by not naming him as a co-inventor. The Federal Circuit then emphasized that "if unenforceable due to inequitable conduct, a patent may not be enforced even by innocent co-inventors. One bad apple spoils the entire barrel. Misdeeds of co-inventors, or even a patent attorney, can affect the property rights of an otherwise innocent individual." It is clear that Ms. Kovesdi's rights as a co-inventor may be irreparably harmed in the '597 application and related applications unless the Patent Office takes corrective measures by requiring substantiation of assertions made to it in the '597 application.

In compliance with her duty of disclosure pursuant to 37 C.F.R. 1.56, Ms. Kovesdi wishes to inform the Commissioner that she has separately requested the Patent Office to revisit its decision in the '952 application, and in particular has requested that the joint signature requirement imposed in the case be removed, so that a previously filed response to an Office Action be entered and the application not be allowed to lapse. A copy of the request is attached in Exhibit V (w/o exhibits). In addition, Ms. Kovesdi has also requested that she be considered as a Proper Party in Interest in the U.S. Patent Application No. 10/103,777, which is a continuation-in-part application of the '597 application, to allow consideration of her claim to being a co-inventor on the merits in that application. A copy of this petition is also provided in Exhibit V (w/o exhibits).

### CONCLUSION

Based on the above, Ms. Kovesdi respectfully requests that she be recognized as a proper party in interest in the '597 application. In view of the facts and arguments presented herein, it would be beneficial if the interests of each party, Mr. Rajasekharan and Ms. Kovesdi, were represented by their own respective counsel in the '597 application and both parties or their representatives be required to sign all subsequent replies under MPEP §402.10. Therefore, please accept the attached power of attorney in the '597 application pursuant to 37 C.F.R. § 1.182. In the alternative to letting her join in the '597 application, Ms. Kovesdi respectfully requests that the Patent Office not allow any patent to issue from the '597 application until all the pertinent evidence is considered.

The undersigned declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.

The authorization for payment of the estimated fees for processing this request under 37 CFR §§ 1.182, & 183 and any other required fee is attached on a separate sheet.


Date May 24, 2004


Respectfully submitted,



Ms. Rozsa Kovesdi  
(Applicant/Petitioner)

# JP813214

 Exh\_A.pdf

 05-19-04 02:20



**Subject: Re: Connect Things, Socket Communications**

**Date:** Wed, 14 Mar 2001 20:14:09 -0500

**From:** Ajit Rajasekharan <ajits@home.com>

**To:** rkovesdi@erols.com

Connect things was just started in 1991. It is interesting we converged on this killer idea after just being exposed to this technology for less than three months! I am not commending ourselves, but at least we are thinking right. Actually this brings up an interesting question, barpoint.com's patent - would airclitc be infringing it then? I am not sure that is possible, since any barcode scanning device is in some sense doing a reverse lookup, correct?

Can we still do something in this area then?

Ajit

Rози Kovesdi wrote:

> <http://www.connectthings.com/>  
>  
> >From the article below:  
>  
> Part of the latest round of venture money will pay for subsidies to  
> encourage mass deployment of wireless devices with built-in scanners.  
>  
> Wireless Week, January 22, 2001  
> AirClic Hits Funding, Management Jackpot  
>  
> By Margo McCall  
>  
> Don't leave home without it. That's a message that easily could apply to the  
> wireless scanning technology that AirClic Inc. is marketing, now that it has  
> succeeded in luring high-powered American Express executives and \$290  
> million in additional funding.  
>  
> The Blue Bell, Pa.-based startup is starting off the new year with former  
> American Express CEO Harvey Golub in the chairman's spot and Phillip Reise,  
> former president of American Express' consumer card services group, as its  
> new CEO. AirClic will use their management experience-in addition to \$290  
> million in second-round funding from backers Symbol Technologies, Motorola,  
> Ericsson Business Innovation and a private group led by Goldman Sachs-to  
> begin selling its wireless scanning technology to business users.  
>  
> And as if that isn't enough, the privately held AirClic also is spending an  
> undisclosed amount to buy a Stockholm, Sweden, company called Connect Things  
> to design an advanced database and switching technologies.  
>  
> The level of commitment from Symbol, a Holtsville, N.Y., maker of mobile  
> data transaction systems, and device makers Motorola and Ericsson  
> underscores the excitement being generated by barcode-scanning technology.  
>  
> Such technology could lead to an explosion of mobile commerce activity as  
> consumers and businesses use wireless phones and other handheld devices to  
> link to Web sites and make purchases. Transactions made on mobile devices  
> will become a \$50 billion market by 2005, according to the Yankee Group,  
> which estimates there will be more than 10 million monthly users of the  
> service five years from now.  
>  
> Launched less than a year ago, AirClic hopes to produce its first revenue by  
> selling personal barcode scanners, produced by Symbol, early next quarter.

> The company is beginning talks with major wireless carriers about how  
> carriers could add AirClic's service to their offerings, as well as talking  
> with device makers about integrating scanners into wireless phones and  
> personal digital assistants. "We think it will start to become something  
> like voice mail. At first, voice mail wasn't available on wireless phones,  
> but now it's become necessary," says John Constantine, vice president of  
> marketing for AirClic.

>  
> Golub, who retired from American Express on Dec. 31, will move from an  
> international company with 58,000 employees and quarterly revenue of more  
> than \$5 billion to a startup with 55 employees in Pennsylvania, 30 in  
> Stockholm and no revenue of which to speak as of yet. Golub will continue to  
> serve as American Express' chairman until April. Prior to joining AirClic,  
> Reise was CEO of Optimark, an electronic marketplace company in Jersey City,  
> N.J.

>  
> The company envisions scanners that will work on a dozen different types of  
> barcodes, including AirClic's own miniature Scanlets. AirClic will make  
> money by charging for use of its Scanlets, as well as getting merchants to  
> pay "click-through fees" for Web visitors that are attracted. Rather than  
> getting the technology to work, the big challenge, Constantine says, is in  
> generating a large number of users. Part of the latest round of venture  
> money will pay for subsidies to encourage mass deployment of wireless  
> devices with built-in scanners.

>  
> AirClic is not the only company eyeing barcode scanners as the impetus for  
> an m-commerce explosion. Socket Communications of Newark, Calif., offers  
> barcode scanning on Windows CE devices. A Dallas company called  
> Digital:Convergence uses a product called the CueCat to scan barcodes from  
> television broadcasts or magazines.

>  
> Initially, Motorola, Ericsson and Symbol were to form a \$500 million joint  
> venture with AirClic to market the scanning technology. However, the  
> companies decided it would be less complicated if they were to simply take  
> stakes in AirClic and let the company develop the technology on its own.  
> Despite the change in organizational structure, the core strategy hasn't  
> changed, Constantine says. AirClic's first round of funding amounted to \$15  
> million from Blue Capital Management, Edgewater, private investors and  
> Forrest, Binkley and Brown.

>  
> The company sees consumers eventually being able to point their phone or  
> other wireless device at a barcode in a newspaper, magazine or other  
> periodical. After a quick click, the consumer would be taken to a Web site  
> where they would get more information on a product or service, or even make  
> a purchase. Business uses include cheaper inventory tracking, procurement  
> and sales force automation. AirClic plans to begin deploying its personal  
> barcode scanners to physicians, who will be able to use the devices to order  
> pharmacy supplies.

>  
> "It's very important that we put devices in the hands of users who are going  
> to use it very frequently, because we will earn more revenue when they use  
> devices more," Constantine says.

re: meeting over weekend /

**Subject: Re: meeting over weekend?**

**Date: Thu, 15 Mar 2001 20:45:03 -0500**

**From: Ajit Rajasekharan <ajits@home.com>**

**To: rkovesdi@erols.com**

Rozi,

Let us create a trademark family. Sounds very good. Can individuals own trademark?

I love talking trails and talking cities.

What name do we give for covering the case of individuals leaving "their voices" on a trail

board, mytalk.com(sounds terrible! taken also) or voicetrails.com?

Expanding on the voice trails, could be the "recorder/scanlet generator" combo device with wireless uplink capability. So all I need to do to leave a comment on a "voice trail board"

at a tourist site is to user "record/scanlet" generator combo and just walk away.

This could

be the equivalent of the "comments book" on many locations. So even if user who comes does

not have a device, the site could have one device that is used by all people who come there.

Our site called say voicetrails.com could be just a huge repository of human voices with comments.

And for those who want to have their own devices, they could use our site voicetrail.com to

create a repository of their comments left in various parts of the world. An equivalent of

what you said before

"the voices of the people who walked through a place is recorded for eternity..."

As you can see, you have sent me into a frenzy by your talking treasures idea.

Ajit

Rozsa Kovesdi wrote:

> Ajit

>

> let me know when is the best time to meet

>

> I can bring my laptop

> This time I can do the driving

>

> we need to figure out what application we would do and

> how to make money out of it

>

> write a business plan

>

> Should we create a trademark family ?

>

> TalkingTreasures - museums, antique, education, science centers

> TalkingCities - sight-seeing, tour-guide, hospitality,

> restaurant, theaters, tickets

> TalkingStores - retail applications

> TalkingTrails - Nature Trails, National Parks

>

>

---

>  
> talking is a bit a misnomer, since it won't necessarily talk  
>  
> The sad part is that the market is horrible  
> Getting funding is near impossible  
>  
> Rozi



**Subject:** Notes of all our discussions

**APPENDIX 4**

**Date:** Fri, 16 Mar 2001 01:36:51 -0500


**From:** Ajit Rajasekharan <ajits@home.com>

**To:** "rkovesdi@erols.com" <rkovesdi@erols.com>

I wrote down all discussions so far I could remember. Please add/make any modifications. I did not write down the one we discussed this morning (the neat franchise scheme, please add it).

good night  
Ajit

---

 <u>BarCode-Possibilities.doc</u>	<b>Name:</b> BarCode-Possibilities.doc <b>Type:</b> WINWORD File (application/msword) <b>Encoding:</b> base64
--	---

## **APPENDIX 5**

### **Barcode - compilation of our thoughts**

#### **Background**

Just like hyperlinks enable linking objects to information in the web world, barcodes enables one to unambiguously reference an object in the physical world and perform a wide range of actions. Since its very beginning (apparently on Wrigley chewing gum in the 1970s) barcode usage has been confined to the retail world - not directly in the hands of the consumer itself. With the growing number of bar code scanning devices that work with PDAs ( e.g. HandSpring Visor slot [http://www.symbol.com/products/barcode\\_scanners/barcode\\_scanners.html](http://www.symbol.com/products/barcode_scanners/barcode_scanners.html) , CF card scanner for CE devices from socketcomm <http://www.socketcomm.com/> ), scanning objects and accessing related information is now possible by a customer. If one imagines barcodes as the equivalent of web hyperlinks the potential is immense. It is as though one can walk around and just beam just about any barcoded object and perform a wide range of actions. The confluence of wireless technology and the emergence of scanning devices for consumer use opens a world of opportunities that may be the biggest innovation wave following the internet wave - the difference only being that the physical world is being hyperlinked in this case as opposed to the virtual world. This could very well be the last big wave for a while to come from a technology influence standpoint (of course the biological front is a whole another story!)

#### **Technology background**

##### **The usage sequence**

The process is very simple - one scans a barcode embedded on an object. The barcode is decoded by the scanner PDA into a string of number/characters. This string is used to index the object information. The indexing could be done locally on the PDA or a connection could be made to a web server. For devices that do not have web connectivity, the indexing could be done locally on the PDA or the barcodes could be synced up with a PC to subsequently access information (though this form of access may not be of much use to the applications we are interested in).

##### **Barcode types**

For a quick tutorial please go to [http://www.symbol.com/ade/barcodes\\_form.html](http://www.symbol.com/ade/barcodes_form.html) , fill out the form and access online barcode tutorial) - there are several standards of barcodes, the most popular ones being EAN/UPC (for all retail products), Code 39/128 etc. A new form of barcode called scanlets(trademarked by atclic, <http://www.atclic.com/> ) may be of particular interest to the application opportunities listed below, primarily because of the size of the barcode - they are very small in size and can be placed on any surface.

### Scanning devices

A variety of them exist. Of interest to us are small PDA add-on devices that can both scan and/or connect to the web (current PDAs cannot do this due to the mutually exclusive use of CF slots. Symbol has a device that does both - it has scanning and LAN support (Spectrum 24 - a version of 802.11b). Cellphones may be able to do this naturally, airclic is working with cellphones to enable scanning of barcodes).

### Barcode indexed server databases.

Companies like <http://barpoint.com/> attempts to do the barcode-to-product lookup and give user information such as price comparisons etc. There is also a company called <http://www.connectitbna.com/>, an off-shoot of Erricson that has a barcode product lookup. An interesting usage of this is to lookup Cellen Dion using a barcode value. This company was recently acquired by <http://www.airclic.com/>

### A Sample space of companies working in the barcode space

Companies such as <http://www.airclic.com/> attempt to make money buy leasing scanlets (their term for small barcodes that can be used on any surface and where space is constrained), buy having some click-thru revenues, and by providing an application development platform (not sure if the last one is a revenue source or is free). They just received \$290 million in additional funding on Jan 22. Also lured some top execs from Amex.

A growing list of thers in this arena:

<http://barpoint.com/> - not sure where they make money from.

<http://mybarcode.com/> - this company provides middleware solution for large-scale retailers among other services.

[TBD: Add more]

### Segmenting companies in the barcode usage space

- 1) Device manufacturers- clearly not out our forte, however patents for device concepts may help us gain leverage.
- 2) Client/authoring applications
- 3) Web site services - barcode databases, e-commerce services (price comp etc)
- 4) Vertical service solutions spanning all four.
- 5) Any more?[TBD]

### Opportunities we can pursue.

These are just evolving ideas. We need to look at what makes sense to pursue, or use them just as a sounding board for better ideas.

### Concept 1) Educational purpose - object scanning "toy" and software

A rugged yet cutely designed toy which is nothing but a purpose-built device with capabilities for scanning, audio playback and with an optional display. It has PC connectivity (USB) or alternatively has a card (CF card?) for storage. No internet connectivity.

#### Involves

(1) new hardware (could it be patented?), (2) software for audio, tag association.

#### Background

There are toy books available now that do the following:-

A story is interleaved with a fixed number of graphics. On the side of the book these graphics are listed in the form of buttons. So when a child comes across a graphic while reading the book, he tends to press the corresponding graphic button on the side, which then emanates a sound. Not very smart - but these books are very popular.

Now in our idea, the website for which we would like to christen as talkingtreasures (we grabbed the domain too!), we take this concept to a totally new dimension.

#### Content creator

Let us start with books - any book that is purchased can be augmented by a separate "annotation package" that can be bought separately or custom created separately (we shall explain the latter soon). This annotation package could be audio or text.

Rahul spawned another use of this device. He likes to press buttons to see state change (bulb going off and on, audio starting playing in his toy book). This toy could be used to help children learn the names of objects. If all objects of interest in the house is tagged, this could be a valuable tool for them to learn names of objects. Just like identifying a switch (he actually goes after small specks of dust too showing acute sense of vision in children), they will quickly learn to identify the small "scanlets" and zap them to get audio output. Now a parent can choose to get a package of "sounds with associated audio" or alternatively create one themselves using a simple application we build. All this application does is to assist them in binding "scanlets" with audio snippets, which can be subsequently downloaded to the device. The scanlets are printed on their home printer on post-it style labels (probably available in OfficeMax) The audio-barcode linking file could be a simple XML file.

#### Usage scenario

Scan any tag on objects and get audio/text feedback stored locally on device.

### **Concept 2) Antique and art show guides**

#### **Involves**

PDA and our software (same as in Concept 1). Does not involve any custom hardware, just existing scanning devices with audio/text capability.

If the device does not support wireless connectivity, user would need to download content before visiting the art/antique show.

#### **Background.**

When one goes to these arts or exhibition centers there is a dearth of information when you need it. One way is to have a human guide. In our scheme we can eliminate this person and get authentic information.

#### **Content creator.**

Uses software used in Concept 1 to create association between scanlet and audio/text. The content may be posted on a site for download.

User may choose to access this content using PC connectivity or by wireless connection. On the site, when user scans a tag, he gets information related to that tag. If there is online connectivity then purchase, price comparisons etc. may be options. We may not have to build this. There would be browsers that do this.

So a user can scan the tagged leg of an antique chair, gets some feedback, scan the top to get some other feedback.

If there is online connectivity, then signing the guestbook in an arts center could be done the same way.

#### **Usage scenario**

Scan any tag on objects and get audio/text feedback stored locally on device or from a remote website if device supports wireless connectivity.

Re: notes from today

**Subject:** Re: notes from today

**Date:** Sun, 18 Mar 2001 08:57:55 -0500

**From:** Ajit Rajasekharan <ajits@home.com>

**To:** rkovesdi@erols.com

My god! You worked after we left - amazing stamina. I was very tired. Almost dozed off a few times while driving back. Had a hard time getting home, slept for half-an-hour in my car right in front of my home after getting back!

The prior art compilation is very neat. You mentioned barpoint.com with "cue". Is Cue proprietary to barpoint? I thought it was owned by :Convergence.

I was also thinking that it may be a good idea to separate the patents into two, the device patent and the overall service patent(the service patent includes the guidebook service(the RFID based guide services), feedback/review service, feedback content aggregation). Does that make sense? This way it may be even easier for us to license this patent to device manufacturers who do not care about the service but just the patent.

Ajit

Rozsa Kovesdi wrote:

> I've researched the barcode

>

> Code 128 Subset C looks usable for a demo

>

> Rozi

>

>

> -----  
> Name: Barcode-prior-art.doc

> Barcode-prior-art.doc Type: WINWORD File (application/msword)

> Encoding: base64

May 3 conference call

**Subject:** May 3 conference call

**Date:** Wed, 02 May 2001 11:16:50 -0400

**From:** Rozsa Kovacsdi <rkovacsdi@erols.com>

**To:** "Jarosik, Gary" <JarosikG@alzheimer.com>

**CC:** Ajit Rajasekharan <ajits@home.com>

Garry,

This is to confirm our conference call

date: May 3, 2001, Thursday  
time: 8 AM CST (9 AM EST)

Dial-in number: 1 800 331-7072  
Participant code: 968706

Attached please find two zip files with the patent drafts:

- 1) device patent
- 2) system and method patent + applications

Please let us know how will it effect your fee schedule, for preparing two patent applications vs one

The descriptions are a work in progress,  
(i.e. they need still more drawings, more descriptions, etc)

Could you please provide us with comments and directions on the work so far ?

If it is possible we would prefer written form so that we do not miss any important points

Thank you very much

Regards,

Rozi


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 DevicePatent-5-2-2001.zip	<b>Name:</b> DevicePatent-5-2-2001.zip <b>Type:</b> Zip Compressed Data (application/x-zip-compressed) <b>Encoding:</b> base64
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 systemPatent.zip	<b>Name:</b> systemPatent.zip <b>Type:</b> Zip Compressed Data (application/x-zip-compressed) <b>Encoding:</b> base64
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# JP813214

 Exh\_B.pdf

 05-19-04 02:20





am sorry

Subject: I am sorry

Date: Mon, 30 Apr 2001 07:54:29 -0400

From: Ajit Rajasekharan <ajit@home.com>

To: "rkovesdi@erols.com" <rkovesdi@erols.com>

I wanted to complete. could not. I will do it today. I will also help on the system patent. That is the key patent. I am sorry I have not been of much help for that.

Shall we target to send the patents, regardless of them being complete for Tuesday evening? What is your opinion?

Ajit

Re: Device patent

**Subject:** Re: Device patent  
**Date:** Mon, 30 Apr 2001 23:41:49 -0400  
**From:** Ajit Rajasekharan <ajits@home.com>  
**To:** rkovesdi@erols.com

Rozi,

I am responding to your response only now. All the points you mentioned are absolutely right.

In fact I have added to the abstract the key idea you mentioned in your kitchen (and you also mention below). That is a very important one - it solves the hard problem of maintaining association between objects, labels, and the authored content.

Ajit

Rozsa Kovesdi wrote:

> Ajit,  
>  
> this is beautiful!!! you've done such an incredible job. You are  
> fantastic  
> One can start manufacturing this device today  
>  
> -----  
> I have some comments, - not on the device itself -  
> but more how the device can be used  
> in the order as i've read the paper  
>  
> 1) on the fron page drawing and on FIG. 2  
> items 202 and 204  
> should there be an adjective added  
> "Audio Encoder"  
> "Audio Decoder" ?  
>  
> to distinguish it from the object code decoder  
>  
> 2) on FIG 3  
> should we add an optional step before Label Objects:  
> "Create Label"?  
> although it is not part of the device, it can be part of the process  
> that you have  
> software and printer to make your own barcodes  
>  
> 3) perhaps the description should mention (or the drawing show?) that  
> part of the device kit  
> might be a roll of barcodes (or other codes)  
>  
> Unless the objects have UPC barcodes already printed on them, one  
> either has to make the codes, or get them ready-made  
>  
> 4) we could add more on usage scenarios for the device  
>  
> I suppose, there is a 'system and method' part and there is an  
> 'apparatus' part  
>

> FIG 3 and the different usage scenarios are the 'embodiment' of the  
> 'system and method'  
> as opposed to the 'apparatus' itself which is FIG 4 ?  
>  
> I think the usage scenarios should be in a claim part so that they  
> would be protected.  
> (not only in the description)  
>  
> I am not sure if usage scenarios can be protected???

> Areas of application:

- > - toy
- > - education
- > - sale
- > - product rating
- > - cataloging

>  
> - toy (you mention this one)  
> - cataloging private collectibles  
> ( antique, photographs, DVD or CD record collections, book collections,  
> etc)  
> - cataloging, annotating family pictures  
> - sale of unique items :  
>       antique show dealer,  
>       artist at an Arts & Crafts show selling her own work,  
>       art gallery  
> - consumer marketing focus group - give feedback on a product, rating of  
> products, consumer reports  
>       - wine tasting  
>       - product shows, trade shows  
>  
> - feature description of a larger object :  
>       automobile showroom (you mention a store sales clerk),  
> furniture  
>       - this is the case when you place multiple labels on a  
> larger object  
>  
> - medical student to learn parts of a skeleton  
>  
> - language learning tool  
>  
> Rozi

. more complete versin of device patent

**Subject: A more complete versin of device patent**  
**Date: Wed, 02 May 2001 08:08:02 -0400**  
**From: Ajit Rajasekharan <ajits@home.com>**  
**To: "rkoveedi@erois.com" <rkoveedi@erois.com>**

Rozi,

I have completed figures, specified the skeleton of the detailed description and claims. The detailed description and claims have not been elaborated yet.

Actually now both the patents are in the same state. Let us see what his feedback is. Meanwhile I will attempt to send a more complete one by the end of the day if possible.

We have a release scheduled today at Audible that prevented me from coming home yesterday.


I will work on it this evening.

Could you please send it to him along with the syatem patent.

We should try to keep tomorrows call as concise as possible to avoid him from charging us unecessarily, dont you think. So we should tell him to review it before the meeting and give us his key comments.

Ajit

---

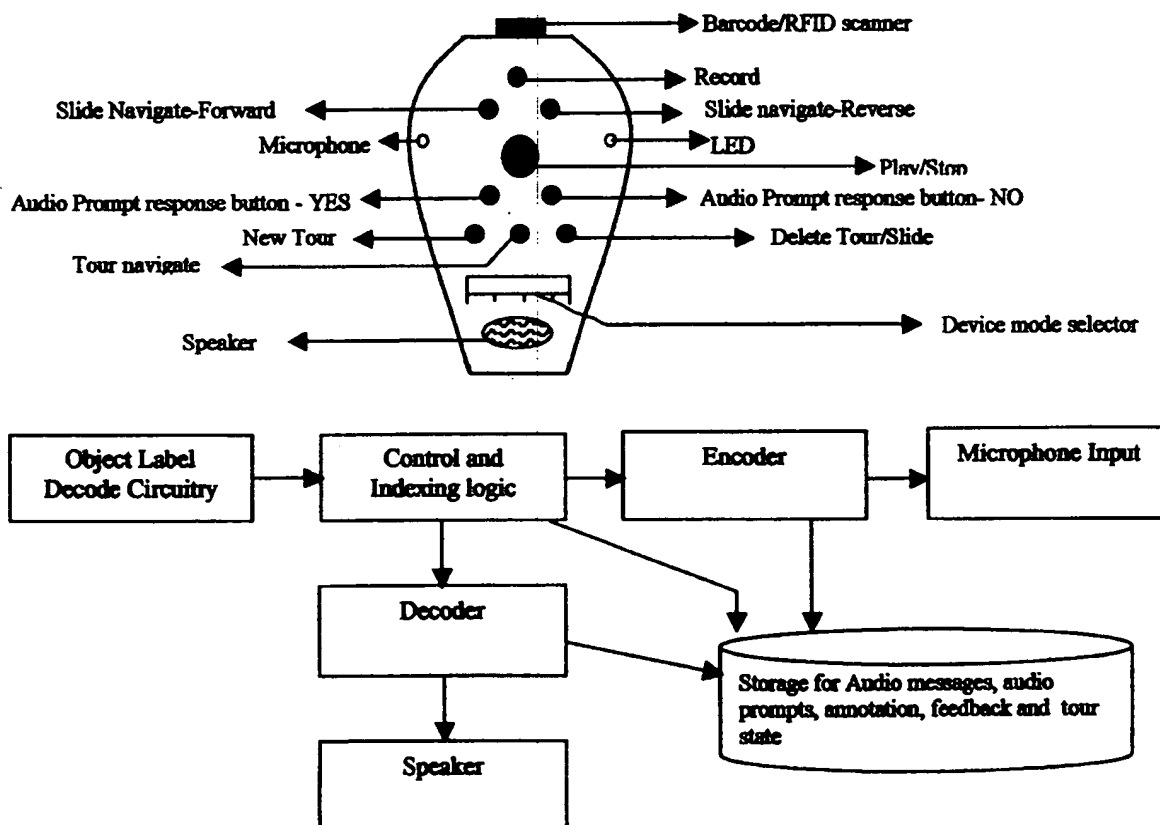
 DevicePatent.doc	<b>Name: DevicePatent.doc</b> <b>Type: Microsoft Word Document (application/msword)</b> <b>Encoding: base64</b>
--	---

**Portable interactive information device with object-based content authoring, object label triggered playback and object-based feedback and annotation capabilities.**

**Abstract**

A information apparatus for (a) reading barcode/RFID labels off objects(or parts of an object) translating them into object codes, (b) performing different actions such as authoring and playback based on the current device mode, the authoring mode permitting new audio/text messages to be recorded that is unambiguously bound to the currently read code, the playback mode triggering playback of the recorded message. In authoring mode, the device supports content authoring to immediately follow object scanning – this enables authored content to be unambiguously bound to the scanned object and thus solving the problem of maintaining correspondence between physical object, object label and the authored content. In playback mode, the device can be programmed to accept/solicit annotations/feedback from the user that is then recorded and unambiguously bound to the object code.

X Claims, 7 Drawing Sheets



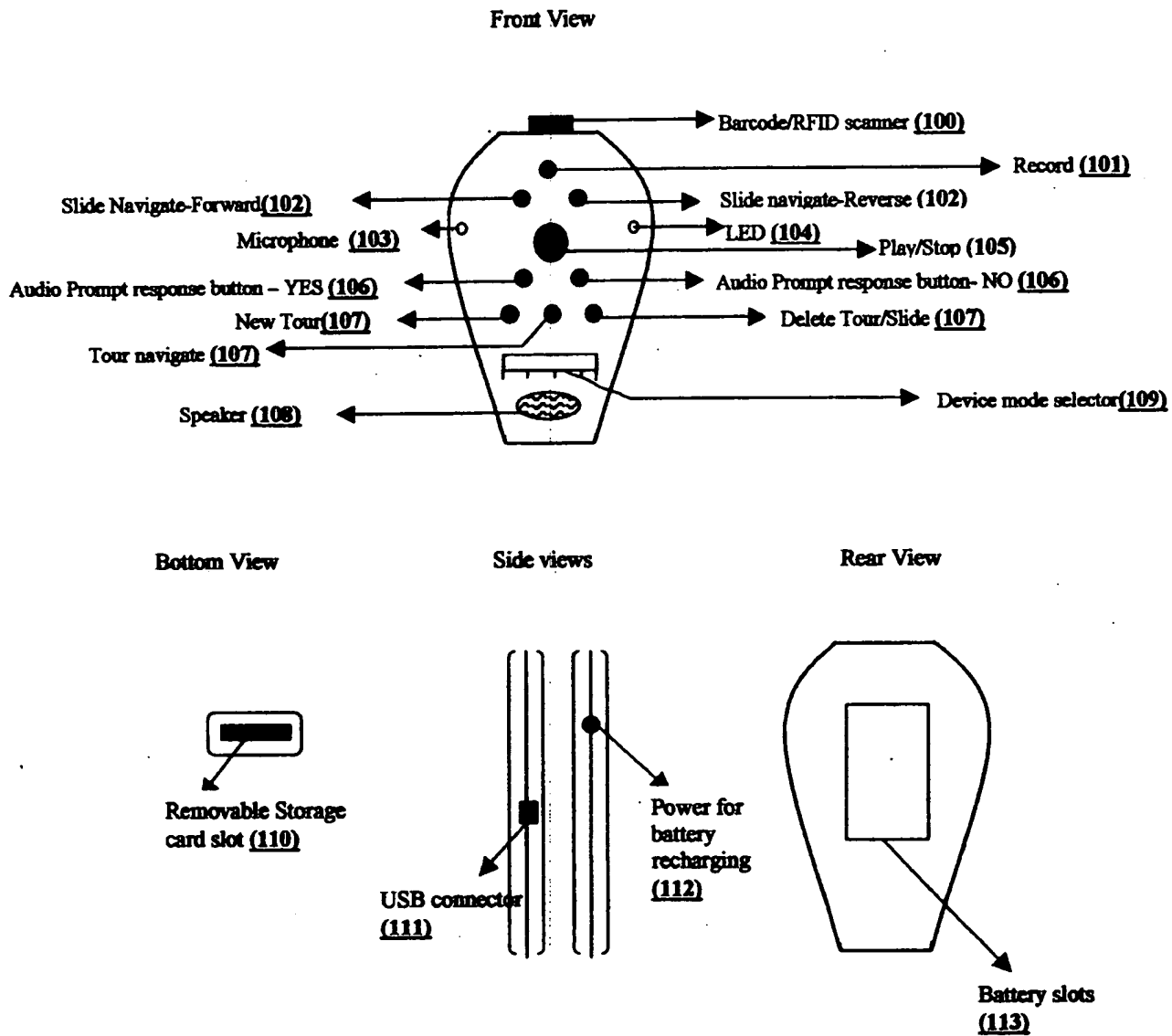


FIG. 1

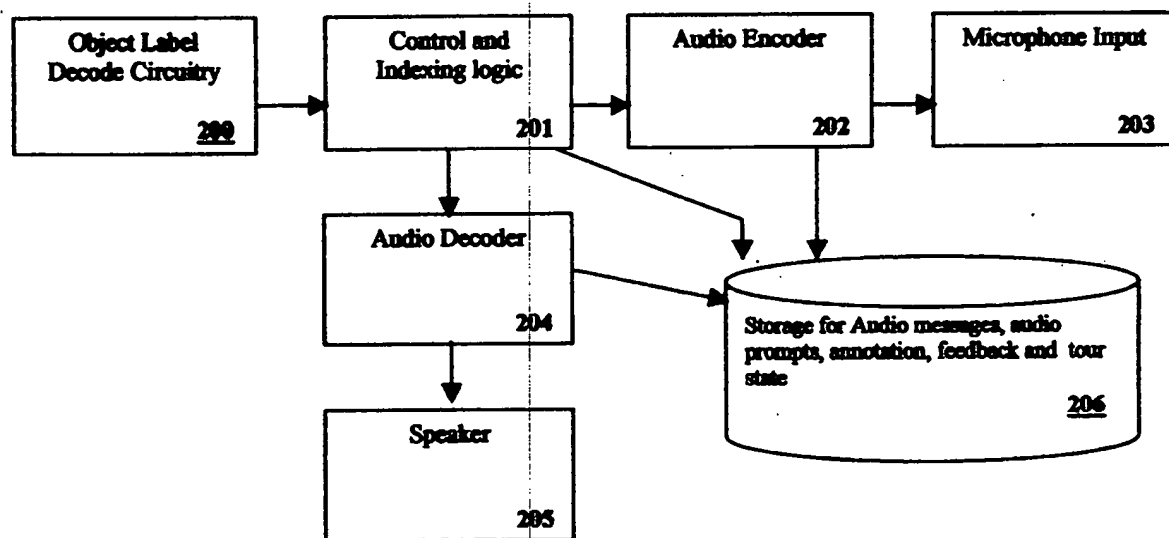


FIG. 2

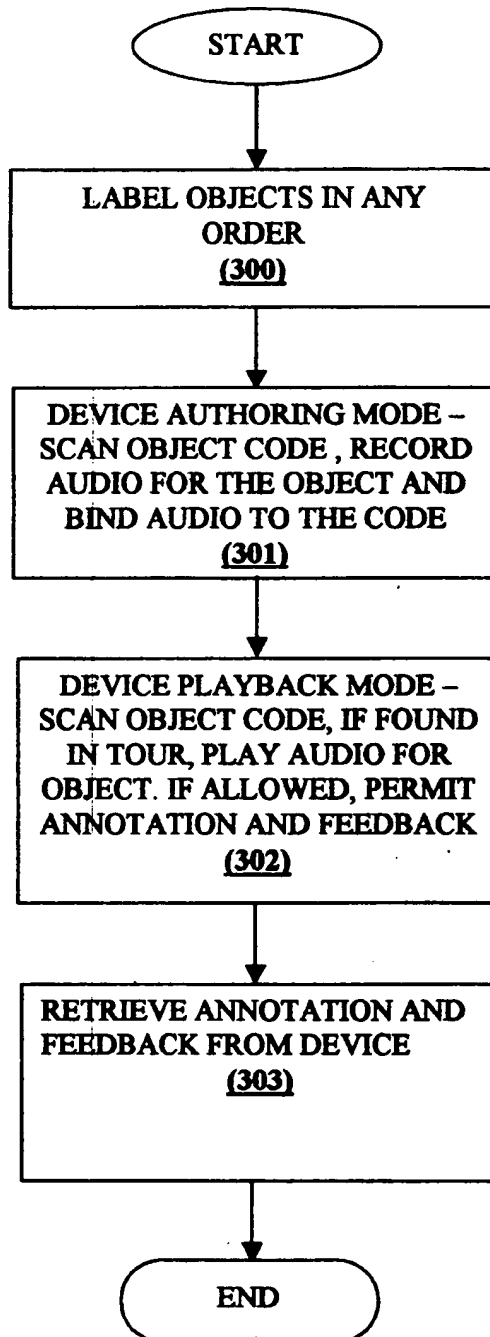
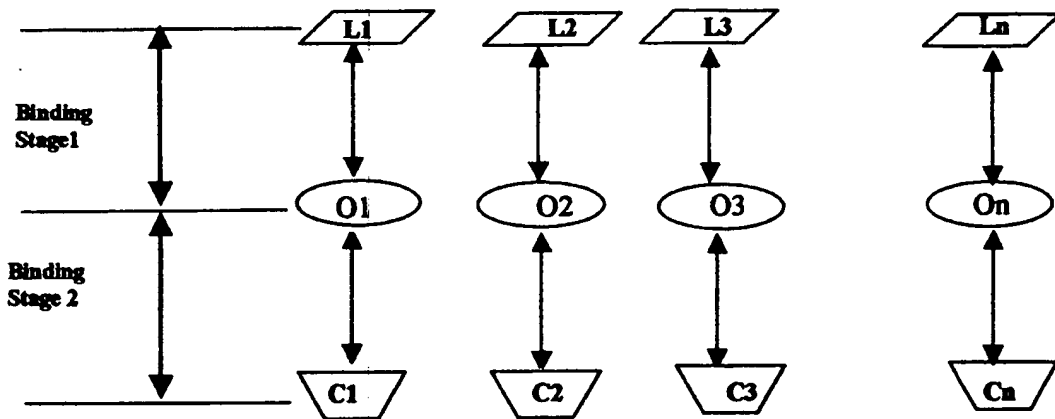


FIG. 3





L1-Ln - Object Labels  
O1-On - Objects  
C1-Cn - Authored content

Binding stage	Object Specific label (e.g. UPC code)		Custom Labeling	
	Labeling/authoring using preferred embodiment	Labeling/authoring without using preferred embodiment	Labeling/authoring using preferred embodiment	Labeling/authoring without using preferred embodiment
Stage 1	Specific labeling	Specific labeling	Any order	Specific labeling
Stage 2	Any order	Specific authoring	Any order	Specific authoring

FIG. 4

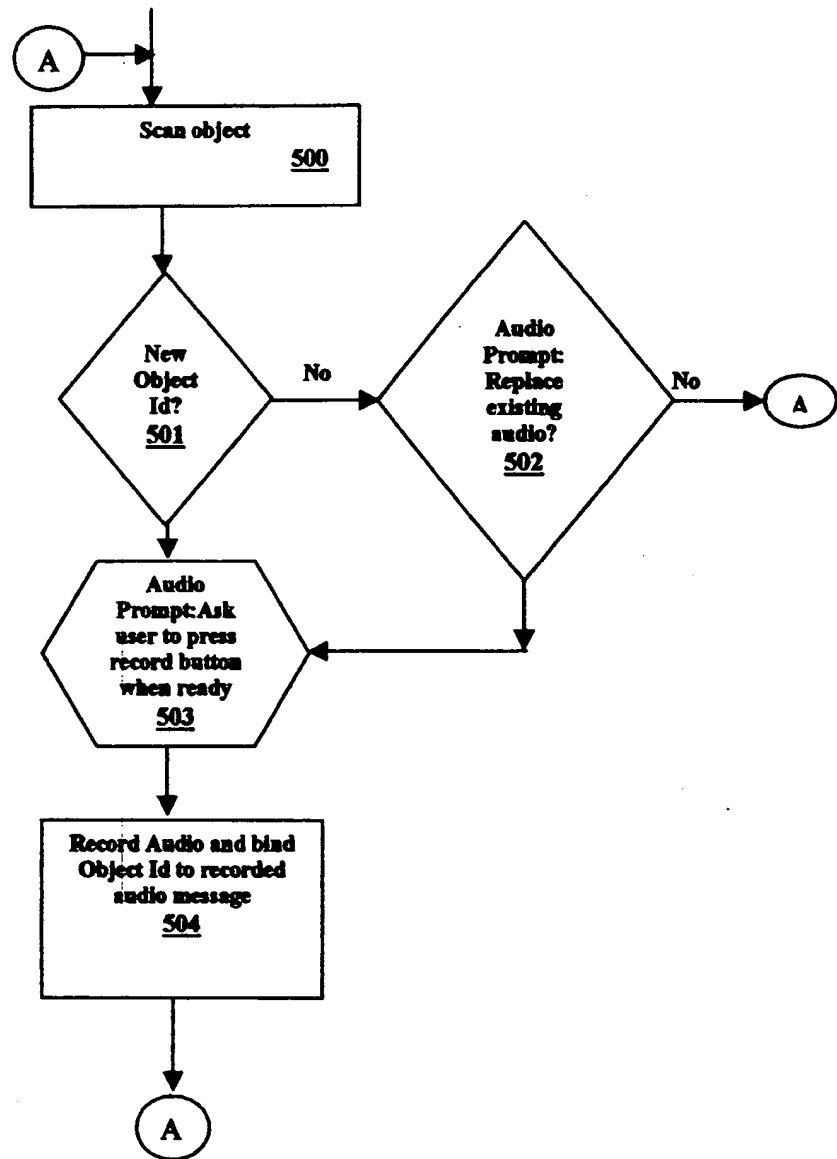


FIG. 5

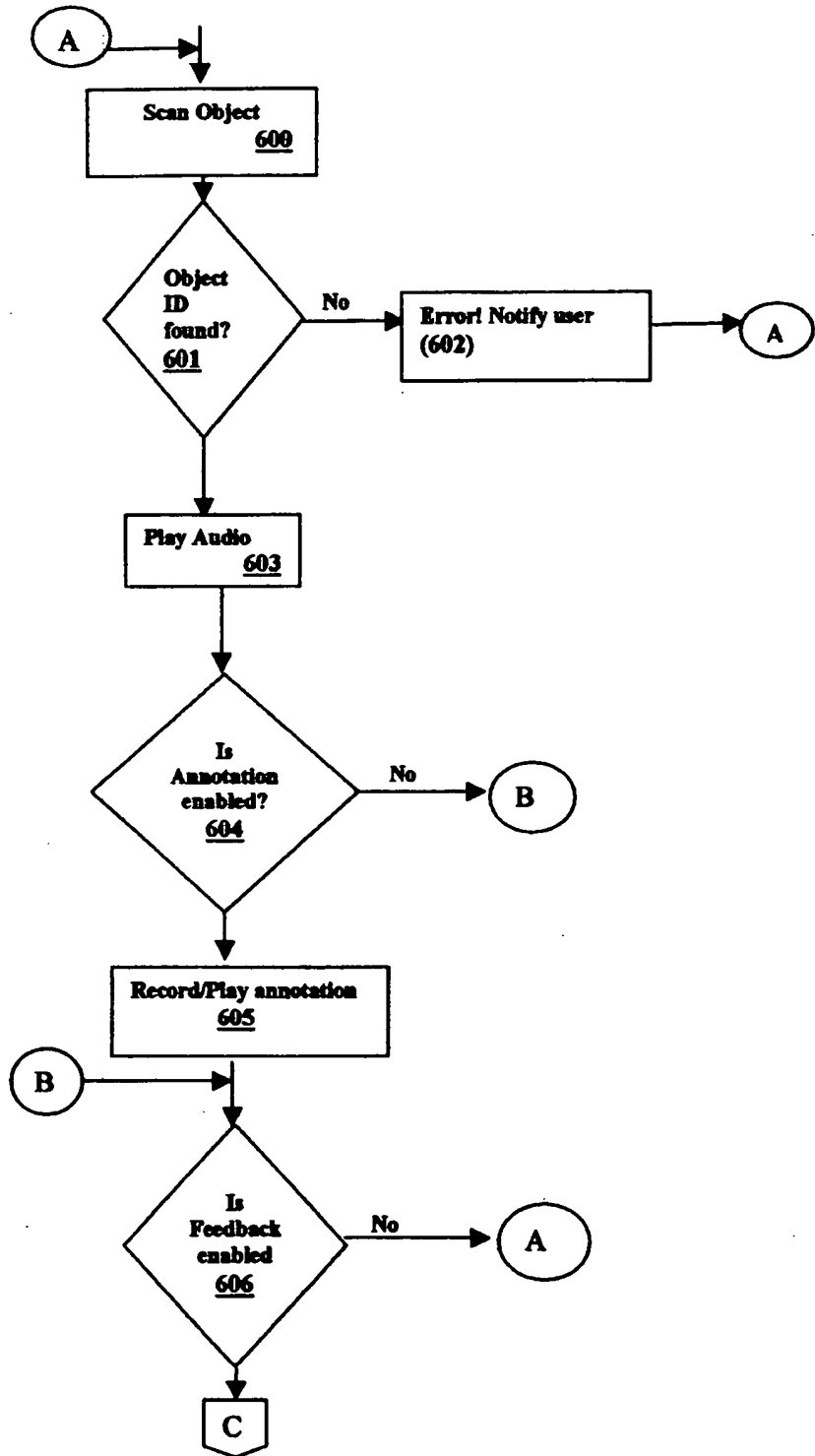


FIG. 5

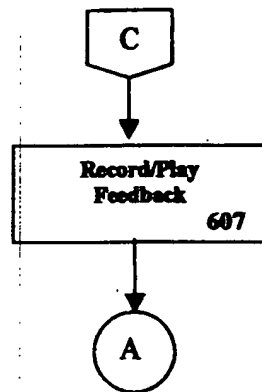
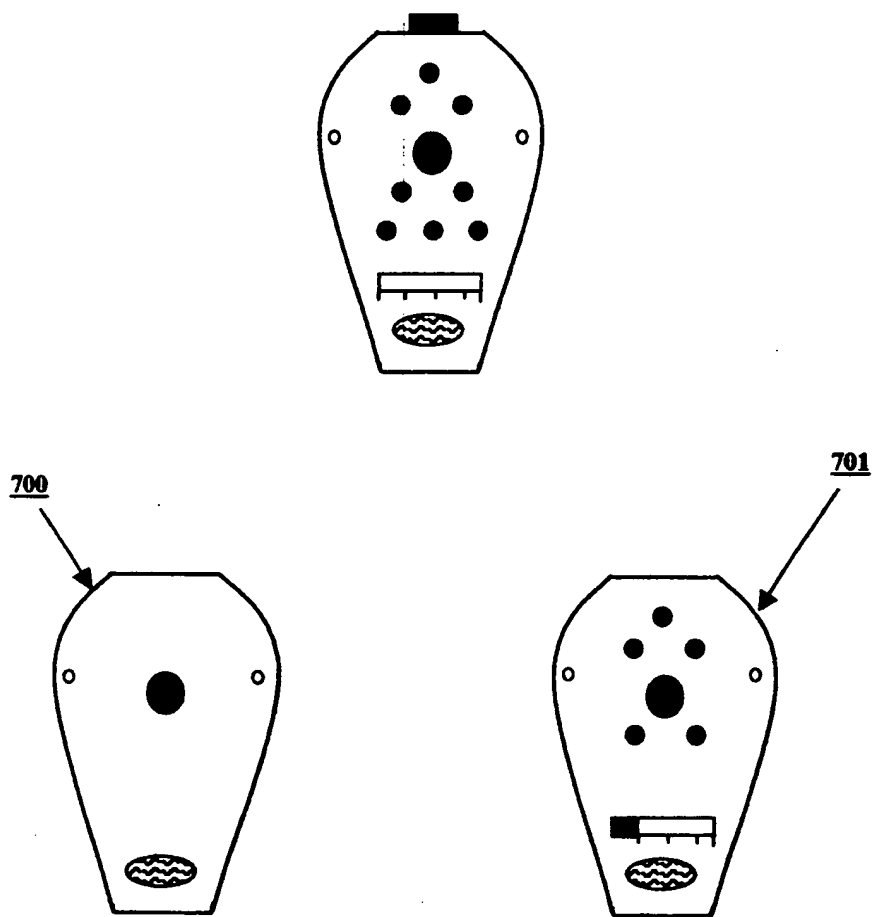


FIG. 6



**FIG. 7**

**Portable interactive information device with object-based content authoring, object label triggered playback and object-based feedback and annotation capabilities.**

**FIELD OF THE INVENTION**

The present invention relates to object-based labeling, digital information recording and playback. In particular, the present invention relates to a device capable of reading labels(codes) off objects, authoring information about that object, playing back authored information about that object on a subsequent rescan. The device is also capable of binding annotation and feedback to the scanned object label(codes).

**BACKGROUND OF THE INVENTION**

With the recent advances in technology it is now possible to use devices to detect labels on physical objects and retrieve information about them. Various forms of those devices exist today. They all solve the single problem of retrieving information on the object whose label is being scanned. This enables a user to browse the world of physical objects quite akin to surfing the internet using a web browser. However there is a vast application space that goes beyond just "object browsing" and requires a rugged, low-cost, special-purpose device that (a) can scan object labels transforming them into machine-readable codes, (b) has the ability to record information about that scanned code and create a binding between the scanned code and the recording, (c) has the ability to identify the code when the object is scanned subsequently and play the recorded content associated with that code, (d) has the capability to record and store annotations/feedback that is also bound to the scanned code (e) has the ability to aggregate the all annotations and feedback provided by a user during a usage session into a single addressable logical entity. An example of such a device usage is a store sales person, who uses the device to scan object objects in the store and record audio information about them. When a user walks through the store he scans objects and retrieves information about that object and can even provide feedback on a particular object of interest. A non-commercial usage of such a device is a mother labeling objects in her home (or even labeling parts of a book) using barcode or RFID labels and recording information in her own voice about those objects. The child then scans the label and listens to the audio message recorded by the mother. Though there have been devices and methods for addressing parts of the above application space none of them completely address all the requirements for the application space mentioned earlier. Also the existing devices and methods known to the inventors have been very specific and constrained in their usage.

U.S. Pat. 6,089,943 issued July 18 2000 to Lo; Wai Shang(Lo) describes a soft toy carrying a barcode scanner for scanning a number of barcodes each individually associated with a visual message in a book. A decoder and audio device in the toy generate an audio message corresponding to that visual message in the book associated with the scanned barcode. One of the biggest drawback of this system is the inability to program the audio messages on the devices itself. This makes it cumbersome for a

content author to author content for the device themselves – they need to resort to a separate means for authoring content. It also makes it harder to maintain the association with the audio messages, object codes and the physical object. Even though the Lo patent claims the device is preprogrammed with audio messages, one can assume that reprogramming could be a natural and obvious extension to make to such a device. Such an extension would still be inadequate since the onus of maintaining the correspondence with the object label, audio recording and the actual physical object lies at the hands of the content author. In our invention the correspondence between the object, the object code, and the audio message is naturally and automatically achieved by on-device scanning and recording - the object label is scanned off the object and the device permits information to be authored right at that very moment on the device, thus providing an immediate binding between the content and object code. Note that in our invention user does not have to keep a correspondence of objects with the label - the labels can be placed on any object. This is a significant advantage when the number of object grows – one can quickly lose track of the correspondence. In the absence of our invention user would need to resort to auxiliary methods to remember the bindings between the three entities - object code, physical object and the audio for the object. This makes authoring of content cumbersome, error-prone and time-consuming. Another noteworthy advantage of our invention is that our device is not limited to its usage as a toy - the form factor and its additional capabilities such as annotation and feedback support, the ability to aggregate user annotation and feedback during a session into a single logical entity that captures the “user experience” makes it attractive for usage in commercial applications.

U.S. Pat. 5,480,306, issued Jan 1996 to Liu; Chih-Yuan et al. (Liu) describes a language learning apparatus and method utilizing optical code as input medium. The system requires an off-the-shelf scanner to be used in conjunction with optical code interpreter and playback device. It also requires one to create a choose a specific barcode and define an assignment between words and sentences to individual values of the chosen code. The disadvantages of this system are the requirement for two separate devices making it quite unwieldy for several usage scenarios, and the cumbersome assignment that needs to be done between digital codes and alphabets, words. In addition to this the Liu patent has the same set of disadvantages the Lo patent cited earlier.

U.S. Pat. 5,314,336, issued May 24 1994 to Diamond;Mark et al. (Mark) describes a toy and method providing audio output representative of message optically sensed by the toy. This device suffers from the same drawbacks as the Lo patent, namely the content authoring deficiency, the inability for usage in commercial contexts, not just as a toy.

U.S. Pat. 4,375,058, issued Feb 22 1983, to Bouma; Herman et al. (Bouma) describes a device for reading a printed code and for converting this code into an audio signal. The key drawback of this system that distinguishes it from our invention is the support for synthesis of audio – it does not support playback of recorded audio. Also the device suffers from the drawbacks as the Lo patent.

## **SUMMARY OF THE INVENTION**

The preferred embodiment of the present invention is a device with the hardware capabilities for barcode or RIFD scanning, audio recording and playback. The software, henceforth called embedded software, resident on the device controls the device

behavior. The device functions in several modes key among them being authoring and playback mode. In authoring mode, objects are scanned and the scanned code is then bound to audio information the author records for that object. The embedded software also helps aggregate authored information on objects into a logical aggregate called a tour. In playback mode, the authored content is played when an object is scanned and whose code matches one of the codes stored within the device memory. The embedded software also enables audio annotation to be recorded and bound to the scanned object. Binding to the scanned object code is also done for any audio feedback provided by the user on the object.

## BRIEF DESCRIPTION OF THE DRAWINGS

The accompanying drawings illustrate the preferred embodiment of the present invention. FIG. 1 illustrates one embodiment of a typical device with scanning, audio recording and playback capability.

FIG. 2 illustrates the a high level block diagram of the internal components of the device that is the preferred embodiment of the present invention.

FIG.3 illustrates the binding problem between physical object, object label, and authored content. It tabulates the specific ordering and authoring steps needed with and without the use of the device. From the table it is apparent that on-device authoring removes specific ordering/authoring requirements in all possible cases.

FIG. 4 illustrates a high level flow diagram for one embodiment of device usage.

FIG. 5 illustrates a high level flow diagram of the authoring mode on a device that is the preferred embodiment of the present invention.

FIG. 6 illustrates a high level flow diagram of the playback mode on a device that is the preferred embodiment of the present invention.

FIG. 7 illustrates a method for selective filtering of device functionality using hardware skins.

## DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

In the following detailed description, numerous details are described in order to provide a thorough understanding of the preferred embodiment of the present invention. However it will be apparent to one of ordinary skill in the art that these specific details need be used in practice to the current invention. In other instances, well-known features have not been described in detail so as not to unnecessarily obscure the present invention.

### Device details

#### Labeling

#### Content authoring

#### Tour experience

#### Alternative embodiments

### TBD:

Describe the labeling, authoring, and playback steps. Mention briefly annotation/feedback upload but defer the feedback, annotation handling to device patent. Specify alternative embodiments



Device – Network connectivity, local bluetooth connectivity (remotely initiating a phone call), display capabilities.

On the fly tour download, live agent connection using bluetooth phone combo.

#### Claims

A means for labeling objects in any order(RFID has the same issues as barcode)

A means for scanning objects in any order

A means for unambiguously binding audio to the scanned object code

A means for playing audio associated with an object by scanning one the objects, scanning of the objects being done in any order.

A means for annotating the object for further personal reference

A means for providing feedback on the object to be reviewed subsequently by the author of the tour.

A means for retrieving the annotation, feedback from the device

A means for making the device usable in different contexts by selective device function filtering.

~~The authored content could reside either in internal non-volatile memory of the device or optionally stored on removable memory.~~

~~The optional removable memory permits pre-authored tour to be played back on device.~~


~~The device may optionally have wired/wireless connectivity for transferring tours to and from the device.~~

~~Embodiment claims:~~

~~Display, network connectivity, on the fly tour download~~

# JP813214

 Exh\_C.pdf

 05-19-04 02:20



Re: Finally a first version of the doc

**Subject:** Re: Finally a first version of the doc

**Date:** Fri, 31 Aug 2001 08:42:47 -0400

**From:** Ajit <ajits@home.com>

**To:** Rozi Kovesdi <r.kovesdi@verizon.net>

A second and final version (I hope) of the doc. All corrections are in red in case you read the first one. Also there is a typo below in the previous email


I have included Imi in the docs cc list , but I am not sending it to \*him\*. I leave it you if you want to.

I think you should send it to him, since he initiated this.

Ajit

Ajit wrote:

> Rozi,  
> I have not read it closely a second time for typos etc. I will read  
> it again tomorrow. But it is pretty close to what I want to say, except  
> for the typos and grammar errors.  
>  
> Please forward it to Imi if you want to. I have included him in the doc,  
> but I am not sending it to you. I leave it you if you want to.  
>  
> Please take your time to read it. We will decide on our meeting time  
> after you read.  
>  
> Good night.  
>  
> Ajit  
>  
> -----  
> Name: XYZAssetsApportioning\_old.doc  
> XYZAssetsApportioning\_old.doc Type: WINWORD File (application/msword)  
> Encoding: base64

 XYZAssetsApportioning.doc	Name: XYZAssetsApportioning.doc Type: Microsoft Word Document (application/msword) Encoding: base64
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**XYZ-Guide assets – an analysis to aid in resolving the difference of opinion regarding the apportioning of equity and the assignment of inventors for one the patents that is being prepared for submission**

To: Rozi  
CC: Imi<sup>1</sup> (since his phone call triggered this note)  
From: Ajit

**Introduction:**

This is to aid us in making an objective analysis of the apportioning of XYZ-Guide's equity and the assignment of inventors to its intellectual property. I am doing this prompted by Imi's update (1) that you did not think Travis should be on the "Touch N Hear" device patent for suggesting the flashlight as a desirable form-factor (2) that you were not happy about the amount apportioned to Travis. The intent of this analysis is for us to carefully reexamine the contributions each person has made and is expected to make so that we feel convinced the apportioning is fair. It is also to aid in organizing our thoughts for our face-to-face meeting tomorrow.

**Apportioning equity and roles – a quick recap of events:**

We did this equity apportioning over the phone on Monday Aug 30, primarily driven by the need to respond to Travis regarding his equity proposal (he gave us the proposal because we asked him to). We did an initial attempt at apportioning and came up with some numbers. After we mutually agreed to the numbers, I informed Travis of his shares. He accepted it. I also informed him after our unanimous consent that we agreed to his proposal to be the Chairman of the Board.

**Rationale for apportioning equity:-**

When we did this over the phone we applied a metric "what has a person contributed so far", and "what is the expected contribution in future". We also applied another key metric "is this person a make or break person", i.e. how critical is this person to the company's survival. In the table below, I have logged the rationale we used for coming up with the numbers. **For two of the those, Imi and Freddy I have added my own afterthoughts to the discussion. In both their cases we had not done a clear analysis of their contributions like the way we did for others (clarification added in the second**

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<sup>1</sup> Imi – I am not including you in the recipient list so that you can be an intermediary. First of all, that would be an insult to both Rozi's and my intellect. We are quite capable of resolving issues on our own. I am only including you since you echoed Rozis concerns to me and I felt you should know of my responses to her concerns. To reiterate, this is to only serve as an update and is not a solicitation for any further responses from you or intermediary role. That said, I am immensely grateful to you for having brought this to my attention before the situation deteriorated beyond repair. I am fairly certain Rozi and I would avert such a situation from happening in future where you would have be forced to play a similar "crisis alert" role.

version of the document).

Name	Past Contributions	Expected Future Contributions	Make or Break? 2	Equity assignment
Ajit (CTO)	Co-Founder(!), patents, technology direction, devices technology logistics lead	CTO – continuing with patents, overall technology direction, device design and analysis, devices technology logistics lead, assisting Rozi in company organization.	Yes	30 <sup>3</sup>
Rozi (CEO)	Co-Founder(!), patents, technology direction, Company organization	CEO- continuing with patents, Company organization, assisting Ajit in overall technology direction, web based technology logistics lead.	Yes	30
Travis (Chairman of Board)	Steering the company in the path with the highest likelihood for success - Evaluation of several proposed application opportunities and picking the one that has the most likelihood of success <sup>4</sup>	Regardless of the application deploying path we take (licensing/separate product development), he will continue to steer us in the chosen path from business standpoint, initiate business relationships relevant to the application path we take (licensing/product development). If we choose a path that needs separate angel seed funding, he would help us in securing that. He will not be involved in any day-to-day operations person; neither will he be our business development person, even though he might do the role of a business development person to bootstrap us into real existence (where we are not draining money from our own pockets)	Yes <sup>5</sup>	15

<sup>2</sup> Make or break – a person whose absence could threaten the existence of the company where redundancy of critical skill sets is currently 0 in the company. A person who satisfies this role is one whose absence can threaten the existence of this company.

<sup>3</sup> We had converged on the split of this equity as 26% each (Rozi and Ajit) founders share and the rest as vesting over time. We had agreed that we will think about and look at it again if need be (added in second version)

<sup>4</sup> We have had two meetings so far ( a third and crucial one is scheduled for this Saturday) – both meetings were chosen by both of us when we came to logical points where we needed Travis's help. This is an important point to bear in mind – we dictated the timing and spread of the meetings- we only needed him at those key steering point. In both those occasions, he came well prepared after reading our material and formulating his thoughts. In our last meeting, he saved us all a lot of time by very succinctly articulating the reason why "My First Words" was not so attractive – he said if you weigh "learning" versus "nostalgia", "learning" is more of a hair-and-on-fire problem. That simple statement when uttered was like an "epiphany" – we lost no further time – I did not even waste time showing the demo I had prepared for that meeting. I quickly steered our meeting by asking him which among the other applications he would like to pursue. He said of all the applications we had listed the child's learning had the most business potential; we took that lead and ran off to elaborate the details of the next application – "Touch'N Hear".

<sup>5</sup> Needless to say, absence of a business development person is a clear path to our demise in a few months. In fact, absence of a good business development person would be a clear path to demise – we only have a

*XYZ-Guide, Inc Confidential*

Name	Past Contributions	Expected Future Contributions	Make or Break? 2	Equity assignment
Imi (Board member)	Helps us creating the company – introducing Charlie, patent lawyers.	Advisor to the board. We need to clearly define what his role is going to be apart from ratifying our ideas. Most importantly setting a high compensation for ratifying ideas alone would set a costly precedent for any other board member we get on board. I look at Rozi to articulate the role she thinks he would play – that should justify the higher compensation he gets compared to new board members we would have even before we get any VC money (e.g. if Harry, VP of Symbol agrees to come on board)	No	2
Shlomo (Treasurer, Advisor)	Helping us with the accounting	Continue the same role until the company becomes a larger entity with more people ( <u>which it might not if we remain an idea licensing company, depending on our third meeting decisions</u> )	No	1
Charlie (Advisor)	Key financial advises on how to set up a shoestring infrastructure before we get external financing	Continue the same role	No	1
Connor (Advisor)	Extremely insightful suggestions on several applications. He is a great technical asset to have.	Continue the same role. He turned down our request for being an advisor – he considered it too much involvement. We should keep the option open to him to become a board member anytime he chooses to, <u>and also make appropriate adjustments to his equity as deemed fit.</u>	No	0.5
Freddy (?????)	No contributions yet	Not sure what it is – look at what Rozi has to say(if it is just designing a logo, we could just give him equity for his work, like the way we plan to handle Ron and the two children who are constantly serving as testers of our device designs)	No	0.5(not fully justified yet)

maximum four month window to survive on our own. I had contemplated approaching Dave and Atif to play Travis's role in case his job with Sony prevents him from working elsewhere. Neither of them were of his caliber(added in second version) nor fitted the experience Travis had, especially his experience with devices and digital distribution of content.

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**Items I want to revisit (we had not finalized the percentage allocation of founders' shares vs restricted stocks)**

- The percentage allocation of founders shares to restricted shares for Ajit and Rozi. I think it is way too much. The reasoning Rozi had given is to keep a significant portion of the company so that we retain control when VC comes in. That logic does not seem right for the following reasons
  - When VC comes in, all values are going to change, so our focus should be, is this apportioning fair with regard to all people on board (clarification added - by board here, I meant the company not the company's board of directors alone) now. Also VC may not even come in for a long time based on the business path we intend to take with Touch'N Hear.
  - Our negotiating power with VCs should not be based on the a silly and obvious "grab all and then give up a bit" strategy. It should be based on solid real strengths that merit such high numbers. We are better off investing time to become worthy of such numbers rather than trying to usurp something we do not appear to deserve in the first place.
  - One of the key things we both strongly felt when we started this company is that we would not take the same avaricious path as other companies we are aware of. I can see us slowly degenerating to that mode, even though our intent to grab all is not driven by greed.
  - The high percentage of founders shares we own relative to the vesting amount also wrongly connotes the fact that our commitment to the company's future is not as much it should be. One could use the meager vesting amount as a measure of our commitment to the company – which I believe is quite untrue – we both, I believe, are some of the few most committed people one can find on this planet!
  - Using a high percentage of shares as a means to direct the future of the company reeks of autocracy – something that is again not what we are. An issue that can only pass through the board of directors because of Ajit and Rosi's "equity brawn power" is an issue worth reexamining for sure – given that we are hand-picking people who we want to be on the board – those who we believe are smart and would help steer the company in the right direction.
  - Both of us are excellent performers – our current work corroborates that. There is no need for us to be worried about not getting our shares because of lack luster performance. If the concern is that we would be forced to



leave, we should address that concern with an appropriate “severance package”.

My proposal is since shares have already been apportioned in different amounts based on certain criteria, have the same percentage of vesting and founders shares for everyone. My number is any value between 25-50% applied uniformly to everyone. If need be we can seek the help of another attorney to confirm the right percentage (If we apply the rules Sagota said, most people would have less a percent of the company!). I am not trying to build an egalitarian society – but our current percentages have “escapist” undertones which I believe was unintentional – it was the fear of the VCs that led to it. Note that I don’t think it is escapist because of the high amount of shares we have (though one could debate that too) – we are going to continue to work to earn it.

*A key open question that may make this entire debate moot is “does the voting power bear a direct correlation to the vested shares or to the total number of share a person owns regardless of it being vested?”. My gut sense is that it may be a direct function of the total shares and not vested shares – if it is so there is all the more reason to make the percentage same for everyone – Rozi’s concern about retaining over 50% control is already satisfied.*

### **Getting to the belly of the beast – the patent issue**

On hindsight I am so glad I came up with the thought I had about adding Travis to “Touch N Hear” device patent. I think it unearthed a lot of smoldering differences that have been accumulating in your mind but were not discussed with me in open even though we worked together on each of those issues.

Now let me get the facts straight since I could see from Imi’s frantic call that at least he did not appear to have the facts straight.

1. The system patent – the one we already filed. There is no doubt in my mind about who its inventors are – Rozi and Ajit in equal measure. Examining the claim points, using Imi’s metric(a person qualifies to be an inventor only if at least one claim point was contributed by the person’s idea), should prove that.
2. The overall device patent – not yet filed, I am supposed to have long completed it and I have not. This is the subsidiary patent to the system patent and shares the same descriptions as the system patent – though Ajit may have a larger contribution in this patent as Rozi herself persistently claims, the evolution of ideas were a consequence of our constant combined thinking. So I would state that there was equal contribution to that too.
3. The Touch N Hear Patent – this focuses only on the Touch N Hear device. This is again a subsidiary patent to the system patent, but has a completely new description since it goes into great detail about one device. It definitely leverages off the system patent but it only describes one device in detail. Since we adopted a divide-and-conquer approach and wanted to do two patents simultaneously, we decided together that I would run with the Touch N Hear device patent and you would run with the Card Patent(described next). But I would think you still had a part in the patent since

we discussed some aspects of the device. So I would state that Ajit and Rozi contributed to the patent, with Ajit's contribution being the major share though I have not written the claim points yet to perform "Imi's test- who did what claims exercise". I am deferring the contribution of the third proposed inventor, Travis, since it incited this elaborate clarification process.

4. The Card Patent – this is completely Rozi's creation. It is a completely new and original idea; I can claim no knowledge of it; or even having thought about it. Given that we have brought ourselves to doing this exercise of who did what (which I think is good and long overdue), and given Imi's warning about falsifying contributions by inventors, I do not want to be a co-inventor to the Card Patent – I have contributed nothing. That is my final word in unequivocal terms – and do not intend to revisit my stance. It is your prerogative how you want to handle its licensing to XYZ-Guide. All finances for application of this patent could be from our common resource pool should you choose to license it to the company – I am explicitly stating this purely to avoid scope for any new ambiguities from creeping in. Of course, you are free to do it on your own if you choose to – fortunately we do not have such restrictions like other companies about implicit ownership of all intellectual property by XYZ-Guide while working for XYZ-Guide. It does not matter that this brings in more complications with respect to licensing, royalties etc. It preserves honesty and clarity which is the safest approach for operating on a long-term basis.

Getting back to the "Touch N Hear" patent and my proposal for the third inventor, Travis:-

Here again, stating facts in chronological order clearly maximizes the chances of coming to the right conclusions:

- Travis has no idea that I even think he should be considered a co-inventor of the Touch N Hear device. I wouldn't be surprised if he does not want to be considered a co-inventor.
- While discussing the device after our second meeting, he mentioned to me that I should take a look at flashlight designs since they have certain attributes that are common to our device – ruggedness and similar form factor. That did not strike to me as a contribution to the invention – it only struck me as a very smart approximation to the device we want to build.
- When I built the first full-scale model of the device with cardboard, taking into account the size of the cheapest available external memory - SmartMedia card (which is 45mm\*37mm\*.76mm), which mandates a minimum device width and the size of two AAA batteries ( we need two- the card needs 3V – my diagram in the Touch N Hear doc is wrong), the first model I built was like a wand. The three children I tried it with had difficulty holding it. The problem was the wand had a longitudinal cross-section like a tapering trapezium, the size of the larger end dictating it to be at least as large as the width of the card, and the children's small hands strained to hold it.
- When I was thinking of improving it, I went back to look at the flashlights and then it struck me. All we need is the shape of the flashlight inverted where there is a trapezoidal cross-section where the card is leading to simple cylindrical end where the batteries are, and ultimately to the pointed part where the scanner is.

- The form factor of the device is the key to making this device a success – if a child cannot hold it comfortably this entire application is useless. Nothing could be more thoughtless, in this case, than saying that shape of the device does not matter. To state that a person cannot be considered an inventor just because he stated a suitable form factor and did not explicitly ask to be an inventor (in this case the man did not even know that he actually triggered my convergence to the most desired form factor – I tried the inverted flashlight design with four children including an eight month old – even he could hold the device, not that we are targeting his age group) is definitely treading on the grey area of honesty and dishonesty. In fact, even with both our contributions to the system and device patent – there have been several instances where I would say some statement which may not have a direct relevance to a claim but it would trigger the right idea in you and vice versa. Most of the claims in our system are the results of such confluences of both our ideas – to me it is a futile exercise to dissect them apart and say who contributed what. So I suspect the extent to which Imi’s “who contributed to which claim” can be truly realized in reality. Leaving that aside, Travis recommending flashlight without really knowing that he was contributing, had exactly the same flavor as our “idea confluences”. To me that would qualify to be part of the patent, regardless of who it was.

### **Revisiting an old issue that I feel is the root cause of all this – Rozi’s comfort level with Travis and doubts about his delivering**

I do know Rozi respects Travis a lot and has no doubts about what he is capable of, but I have sensed that there are certain things that reduce her comfort level. I am making speculative observations below- I am only doing this with an attempt to see if a reasonable “working comfort level” can be accomplished by logical reasoning, or if the feeling is irreconcilable because it is more deep-seated:

- Travis’s commitment to us, would he deliver in light of his joining Sony fulltime – This is an excellent point. The answer to this can only be speculative and based on past performances. He has delivered so far – I don’t think we both doubt that. The only indicator that he would continue to deliver are
  - he made a formal commitment to play an active role by becoming the Chairman of the board. He also stated clearly that he would give it up himself if he feels if cannot deliver what is expected of him(added- we would get rid of him if he does not voluntarily give up – I have done that before despite it being a difficult action). He has also not made any false promises that he can play the role of a full-time business development person.
  - He has made it very clear to Sony that he wishes to work with us. This was one of the elements of employment agreements with them. This is also an indicator of his commitment to us.

- He strongly believes our application has potential. Having worked with him closely, he is one who does not believe in or commit to expending effort on mediocre ideas. A clear indicator to that is the fact that he had planned to propose to me to work with him at Sony, if he had thought the Touch N Hear idea was not a big winner.
- Last but not the least, he enjoys working with me (and I do believe and hope that will be the case when he gets to work with you too), we have enjoyed working together at Audible despite the occasional raucous instances – he derives the same degree of pleasure I get when I work with him and Rozi.
- General working relationship with Travis – any discerning person can see that Rozi does not have the same interaction comfort level with Travis as I do. In fact Rozi is not alone, most people in Audible experienced the same degree of discomfort while interacting with him. This is mainly due to the fact he is very passionate about his work and does tends express his opinions in quite caustic terms. More importantly he is very smart as we are and can extrapolate the logical reasoning we are making and see its conclusion before we articulate it – however he has the deficiency, unlike us, of not waiting patiently until the speaker completes. In Rozi's case the problem is not in a difference of opinion – it is a very trivial communication problem of Travis not having the patience to listen to Rozi when she makes a point in her characteristic rich style. It is as simple as that. I want to differentiate her rich communication style from unfocussed thinking. Her thoughts are extremely organized – many times the purport of her statements would only dawn on me when I am driving the next day, and I would call and exclaim to her what an insightful statement she made the other day, by which she might have even forgotten she made the statement. This simple issue can be trivially addressed by just applying some preprocessing and making the thoughts succinct before articulating it to him – which you do remarkably well when you consciously choose to.
- Rozis fear of being marginalized – I am using the exact term you had used before when you discussed this with me. I remember spending a great deal of time trying to allay this fear. I have probably done more harm than allaying your fear initially by doing a very stupid thing. I strongly opposing to having him sign an NDA. That was clearly thoughtlessness and unprofessional conduct on my part – it was driven not by any comradeship with Travis, I had a stupid notion that I would offend him and lose him if I asked him to sign. I felt very stupid when he actually said he would liked to sign the NDA himself and actually made the XYZ-Guide NDA for us himself! I am not going to repeat all I said again before to allay your fear of being marginalized. I am going to cite an excellent example which – if I had been you, Travis's dismissal of the "First Words" application would be considered a clear indication of marginalization. If I had not been objective about his rationale, however well he may have articulated the reason "My first Words" was not the one to go after, I could think that he was marginalizing me, since the idea was purely a solution to a problem I had as a parent – recording my son's voice easily for preservation. I had a lot of theoretical reasons to feel marginalized; I spent working up to early that morning creating a prototype! I

could make the transition and see through his eyes only because I managed to retain objectivity, and never felt not feel he was trying to marginalize me. Most importantly, I have the same degree of trust and respect for his opinion as I have for you. I am quite sure if I tell you if one of your ideas is not with pursuing – you would not feel marginalized at all. However, you probably will if Travis told you the same thing. This leads us to the final and most important cause for discomfort.

- Trust: - Despite all this objective reasoning, none of us can undermine the power of the subjective force in us. We can take the most elaborate precaution to make sure a person delivers what he is supposed to, but if we a lingering gut sense that the person would dupe us or not deliver, then it is impossible to work with him<sup>6</sup>. If this is the problem Rozi has with Travis, then this is indeed a very serious problem since I do not know of anyone who can play the role Travis is playing and is expected to play, let alone being as good as him in doing that. I cannot put it in more succinct terms – I feel if we had lost Travis at this point because of the Sony job it would have been the death knell to our success – minimally it would have been the death knell to my unabated optimism that we will make it. This is the case even if we manage to get money from a venture capital company – we need a person who has a good track record, who can steer us in the right direction and can make our idea a success from a business standpoint.

## Conclusion

Needless to say, I have made an earnest attempt to elaborate all the issues that are of concern to you, only because I do want to make XYZ-Guide really happen, as much as you do too. I would be very sad if we had to abort a common endeavor we have both been working together on, for reasons that could be addressed by collective analysis and thinking. Also, differences of opinion is a healthy sign, no matter how long it takes to resolve issues. At the same time, I think the “Travis related issues” have been in the back burner for long and keep popping up. We should put an end to that – no matter how we accomplish that. To underscore its importance, it comes down to one simple statement – Travis is as important to the success of XYZ-Guide as Rozi and Ajit are.


---

<sup>6</sup> I still recall firing a consultant whom I hired within the first week of his work at Audible. The reason was not that he was technically up to the expected level – I could accept that and knew I could quickly get him to speed. I fired him because I found him to be insincere. I did not want to waste time always checking on him, so just let him go. It was purely the lack of a reasonable comfort level.

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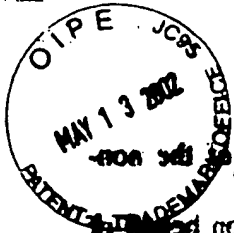


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(4)

The undersigned hereby certifies that the inventor named herein is the true and lawful inventor of the invention herein described.

Applicant: Kovcedi et al.

Examiner: Not yet assigned

Serial No.: 10/035,952

Filed: December 26, 2001

Title: System And Method For

Information Relevant To A

### PETITION UNDER 37 CFR 1.47(a)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In accordance with 37 CFR 1.47(a), the inventor Rozsa Kovcedi hereby petitions to make application for patent on behalf of herself and the named inventor Ajit Rajasekharan. The fee set forth in 37 CFR 1.17(i) is enclosed herewith.

A diligent effort has been made to obtain the signed Declaration of Mr. Rajasekharan. This effort included the sending of mail to the attorney for Mr. Rajasekharan, namely, Roger Tate of Brobeck, Phleger & Harrison at 1333 H. Street, N.W. Suite 800, Washington, DC 20005. Efforts were not made to contact Mr. Rajasekharan directly owing to his representation by counsel in this matter. Despite this effort, as evidenced by the attached letter which was mailed to the attorney for Mr. Rajasekharan and the certified mail, restricted delivery, return receipt, Mr. Rajasekharan has not responded to the request to secure his signature on the accompanying Declaration.

5/15/2002 MGBREN1 00000076 011156 10035952

2 FC:122

130.00 CH



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Kovesdi et al.	)	
		)	Examiner: Not yet assigned
Serial No.:	10/035,952	)	
		)	Art Unit: Not yet assigned
Filed:	December 26, 2001	)	
		)	Atty Docket: 66566.01US2
Title:	System And Method For	)	
	Authoring And Providing	)	
	Information Relevant To A	)	
	Physical World	)	

**PETITION UNDER 37 CFR 1.47(a)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In accordance with 37 CFR 1.47(a), the inventor Rozsa Kovesdi hereby petitions to make application for patent on behalf of herself and the named inventor Ajit Rajasekharan. The fee set forth in 37 CFR 1.17(i) is enclosed herewith.

A diligent effort has been made to obtain the signed Declaration of Mr. Rajasekharan. This effort included the sending of mail to the attorney for Mr. Rajasekharan, namely, Roger Tate of Brobeck, Phleger & Harrison at 1333 H. Street, N.W. Suite 800, Washington, DC 20005. Efforts were not made to contact Mr. Rajasekharan directly owing to his representation by counsel in this matter. Despite this effort, as evidenced by the attached letter which was mailed to the attorney for Mr. Rajasekharan and the certified mail, restricted delivery, return receipt, Mr. Rajasekharan has not responded to the request to secure his signature on the accompanying Declaration.

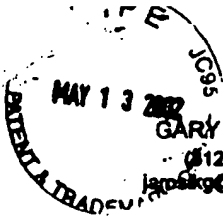
The signing of the Declaration by Ms. Kovesdi with the signature block of the non-signing inventor left blank is to be treated as having been signed by Ms. Kovesdi on behalf of Mr. Rajasekharan.

The undersigned further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.

Respectfully submitted,

Date: MAY 1, 2002

By: R. Kovesdi  
Rozsa Kovesdi



GARY R. JAROSIK  
(312) 715-4522  
jarosikg@althemer.com

LAW OFFICES

**ALTHIMER  
& GRAY**

10 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606-7482

TEL: (312) 715-4000  
FAX: (312) 715-4800

April 22, 2002

**Via Certified Mail  
Return Receipt Requested**

Rodger Tate, Esq.  
Brobeck, Phleger & Harrison LLP  
1333 H Street, N.W.  
Suite 800  
Washington, DC 20005

**Re: U.S. Patent Application Serial No. 10/035,952  
Title: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING  
INFORMATION RELEVANT TO A PHYSICAL WORLD  
Our File No.: 66566.01US2**

Dear Mr. Tate:

Enclosed please find a copy of the above-referenced patent application and a copy of the Combined Declaration for the signature of Mr. Ajit Rajasekharan. Once Mr. Rajasekharan has signed the Declaration, I kindly ask that the Declaration be returned to my attention for filing with the United States Patent Office.

The subject patent application was filed on December 26, 2001 and claims priority to U.S. provisional patent application Serial No. 60/306,356. As you are aware, the provisional patent application correctly names both Rozsa Kovesdi and Ajit Rajasekharan as inventors.

It is our understanding that Mr. Rajasekharan has filed a patent application that also claims priority to this provisional patent application. It is our further understanding that Mr. Rajasekharan has represented to the United States Patent Office that he is the "sole" inventor of the subject matter recited in the claims of said patent application. However, we call your attention to the fact that Mr. Rajasekharan has admitted on several occasions that Ms. Kovesdi must be considered to be an inventor of the subject matter that is recited in the claims of the provisional patent application. For example, in a correspondence dated August 31, 2001, Mr. Rajasekharan stated:

ALTHEIMER  
& GRAY

Mr. Rodger Tate  
April 22, 2002  
Page 2

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"The system patent - the one we already filed. There is no doubt in my mind about who its inventors are - Rozi and Ajit in equal measure."

"The overall device patent - not yet filed, I am supposed to have long completed it and I have not. This is the subsidiary patent to the system patent and shares the same descriptions as the system patent - though Ajit may have a larger contribution in this patent as Rozi herself persistently claims, the evolution of ideas were a consequence of our constant combined thinking. So I would state that there was equal contribution to that too."

"In fact, even with both our contributions to the system and device patent - there have been several instances where I would say some statement which may not have a direct relevance to a claim but it would trigger the right idea in you and vice versa. Most of the claims in our system are the results of such confluences of both our ideas - to me it is a futile exercise to dissect them apart and say who contributed what."

Since you have informed us that the claims set forth in the patent application filed by Mr. Rajasekharan are identical to those found in the provisional patent application and, as such, identical to those in the subject patent application, we request that Mr. Rajasekharan either: 1) add Rozsa Kovesdi as an inventor in the patent application that he has filed; or 2) withdraw his previously filed patent application in favor of the subject patent application.

We believe that these corrective measures are required to protect the property interests of Ms. Kovesdi and Mr. Rajasekharan under the Patent Law while also providing an amicable resolution to this matter.

If you have any questions, please call me.

Very truly yours;

  
Gary R. Jarosik

GNM  
Enclosures

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**3. Article Addressed to:**

Rodger Tate, Esq.  
Baker, Pkeger & Harrison LLP  
1333 H. Street, N.W., #800  
Washington, D.C. 20005

**4a. Article Number**

7001-0340 0001 2277 3148

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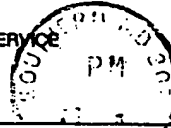
X *Rodger Tate*

**8. Addressee's Address (Only if requested and fee is paid)**

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**Sent To**

*Rodger Tate, Esq.*

**Street, Apt. No., or PO Box No.**

1333 H. Street, N.W.

**City, State, ZIP+4**

Washington, D.C. 20005

PS Form 3800, January 2001

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PTO/SB/21 (08-00)

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number 10/035,952

Filing Date 12/26/2001

First Named Inventor Kovesdi et al.

Group Art Unit 2876

Examiner Name unassigned

Total Number of Pages in This Submission

9

Attorney Docket Number 66566.01US2

## ENCLOSURES (check all that apply)

☒ Fee Transmittal Form

☐ Fee Attached

☐ Amendment / Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☒ Response to Missing Parts/  
Incomplete Application

☒ Response to Missing Parts  
under 37 CFR 1.52 or 1.53

☐ Assignment Papers  
(for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☒ Petition

☐ Petition to Convert to a  
Provisional Application

☒ Power of Attorney, Revocation  
Change of Correspondence  
Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) \_\_\_\_\_

☐ After Allowance Communication  
to Group

☐ Appeal Communication to Board  
of Appeals and Interferences

☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please  
identify below):

- Copy of Missing Parts  
Notice

- return postcard

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm  
or  
Individual name

Customer No. 25541

By: Gary R. Jarosik

Signature

Date

May 3, 2002

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 05/03/2002

Typed or printed name Lisa Lyle



Signature

Date 05/03/2002

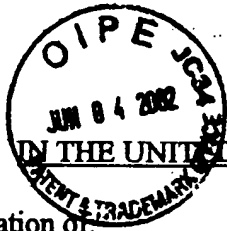
Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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PATENT  
ATTORNEY DOCKET: 66566.01US2

#6

In re Application of:

Ajit RAJASEKHARAN, et al.

Application Number: 10/035,952

Filed: December 26, 2001

For: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING INFORMATION  
RELEVANT TO A PHYSICAL WORLD

)  
)  
) Group Art Unit: To Be Assigned

)  
) Examiner: To Be Assigned  
)

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**PETITION UNDER 37 C.F.R. § 1.182 FOR APPOINTMENT OF  
A POWER OF ATTORNEY BY LESS THAN ALL APPLICANTS**

OFFICE OF PETITIONS

Attention: Office of Petitions  
U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

Mr. Ajit Rajasekharan ("Applicant") petitions the Commissioner under 37 C.F.R. § 1.182 to accept Applicant's appointment of representation included in the Declaration and Power of Attorney document concurrently submitted herewith in the above-captioned patent application. Particularly, Applicant requests that the U.S. Patent & Trademark Office (PTO) accept Applicant's power of attorney, which is signed by only one of the two applicants of the present application for the reasons provided below.

Applicant submits that his rights to the claimed subject matter of the present application are better served by the appointment of representatives other than those appointed by joint applicant, Ms. Rozsa Kovesdi. Particularly, Applicant desires his own representation to prosecute the present application on his behalf and to formally join the prosecution under the provisions of MPEP § 402.10. Because Applicant maintains that he is the sole inventor of a substantial number of the presented claims including all independent claims<sup>1</sup>, allowing Ms. Kovesdi's appointed representative(s) to prosecute the application on the behalf of both Applicants will misrepresent and possibly irreparably harm Mr. Rajasekharan's exclusive rights to the claimed subject matter solely conceived by him.

<sup>1</sup> A portion of the solely conceived claims are being pursued in a copending U.S. utility patent application naming Applicant as the sole inventor.

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FC:122



Acceptance of Applicant's power of attorney will result in two parties prosecuting the present application at the same time. Accordingly, Applicant respectfully requests that the Commissioner require both parties to sign all subsequent replies submitted to the PTO in accordance with MPEP § 402.10. Applicant contends that this requirement will encourage the parties to work out a jointly submitted Amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources.

Check No. 1931 in the amount of \$130.00 is enclosed to cover the petition fee set forth in 37 C.F.R. § 1.17(h). In the event that any variance exists between the amount enclosed and the amount determined by the PTO to consider the present Petition, the Commissioner of Patents is hereby authorized to charge or credit such variance to the undersigned's Deposit Account No. 50-1640.

Respectfully submitted,


BROBECK, PHLEGER & HARRISON LLP

June 4, 2002

Brobeck, Phleger & Harrison LLP  
Intellectual Property Department  
1333 H Street, N.W., Suite 800  
Washington, D.C. 20005  
Tel: (202) 220-6000  
Fax: (202) 220-5200

TC:cdh

By:

  
Trevor Coddington, Patent Agent  
Registration No. 46,633

2876  
PATENT  
ATTORNEY DOCKET: 66566.01US2

0410  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Re Application of:

Ajit RAJASEKHARAN, et al.

Application Number: 10/035,952

Filed: December 26, 2001

For: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING INFORMATION  
RELEVANT TO A PHYSICAL WORLD

)  
)  
) Group Art Unit: To Be Assigned  
)  
) Examiner: To Be Assigned  
)  
)

**RESPONSE TO NOTICE TO FILE MISSING  
PARTS OF NONPROVISIONAL APPLICATION**

Attention: Box Missing Parts  
U.S. Patent and Trademark Office  
Washington, D.C. 20231

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TC 2800 MAIL ROOM

Sir:

In response to the attached Notice To File Missing Parts of Nonprovisional Application mailed April 4, 2002, Mr. Ajit Rajasekharan submits herewith an executed Declaration and Power of Attorney for the above-captioned patent application. Payment of the late filing surcharge and Ms. Rozsa Kovessi's Declaration should be provided with a separate Response to Notice to File Missing Parts filed on Ms. Rozsa Kovessi's behalf.

Respectfully submitted,

BROBECK, PHLEGER & HARRISON LLP

June 4, 2002

Brobeck, Phleger & Harrison LLP  
Intellectual Property Department  
1333 H Street, N.W., Suite 800  
Washington, D.C. 20005  
Tel: (202) 220-6000  
Fax: (202) 220-5200

TC:cdh

By:

Trevor Coddington, Patent Agent  
Registration No. 46,633

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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APPLICATION NUMBER	FILING RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/035,952	12/26/2001	Ajit Rajasekharan	66566.01US2

25641  
ALTHEIMER & GRAY  
TEN SOUTH WACKER DRIVE, SUITE 4000  
CHICAGO, IL 60606-7482

CONFIRMATION NO. 3522

FORMALITIES LETTER



\*OC000000007794785\*

Date Mailed: 04/04/2002

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION


FILED UNDER 37 CFR 1.53(b)

## Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(f) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 65.

*A copy of this notice **MUST** be returned with the reply.*

  
Customer Service Center  
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

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Attorney Docket No.: 033393.0005

## DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As the below named inventor, I hereby declare that:

My residence, post office address and citizenship is as stated below next to my name;

I believe that I am an original, first, and joint inventor of the subject matter to which at least one claim is directed and for which a patent is sought on the invention entitled:

### SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD

the specification of which: ☐ is attached hereto.  
☒ was filed on: December 26, 2001  
as Application No.: 10/035,952  
and was amended on: \_\_\_\_\_ (if applicable).

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56.

#### Prior Foreign Application(s)

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below any foreign application(s) for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Country	Application Number	Date of Filing (day, month, year)	Date of Issue (day, month, year)	Priority Claimed	
				Yes <input type="checkbox"/>	No <input type="checkbox"/>
				Yes <input type="checkbox"/>	No <input type="checkbox"/>

#### Prior Provisional Application(s)

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below:

Application Number	Date of Filing (day, month, year)
60/306,356	July 18, 2001

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**Prior United States Application(s)**

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s), or § 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Application Number	Date of Filing (day, month, year)	Status - Patented, Pending, Abandoned

And I hereby appoint Rodger L. Tate, Registration No. 27,399; Anthony W. Shaw, Registration No. 30,104; Cono A. Carrano, Registration No. 39,623; Laurence H. Posorske, Registration No. 34,698; Robert A. King, Registration No. 42,738; and Craig L. Puckett, Reg. No. 43,023, as my attorneys; and Trevor Q. Coddington, Registration No. 46,633, as my patent agent; of BROBECK, PHLEGER & HARRISON LLP, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

All correspondence and telephone communications should be addressed to:

**BROBECK, PHLEGER & HARRISON LLP**  
Intellectual Property Department  
1333 H Street, N.W.; Suite 800  
Washington, DC 20005  
telephone number (202) 220-8000  
facsimile number (202) 220-5200,

which is also the address, telephone and facsimile numbers of each of the above listed attorneys and agent.

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JUN 1 8 2002

OFFICE OF PETITIONS

**BROBECK, PHLEGER & HARRISON LLP**  
Intellectual Property Department  
1333 H Street, N.W.  
Suite 800  
Washington, D.C. 20005  
(202) 220-8000 (telephone); (202) 220-5200 (facsimile)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature



Date 05/24/02

Full Name of  
First Inventor:RAJASEKHARAN  
(Family Name)Ajit  
(First Given Name)V.  
(Second Given Name)

Citizenship:

India

Residence:

137 Windsong Circle, East Brunswick, New Jersey 08816


Post Office  
Address:

137 Windsong Circle, East Brunswick, New Jersey 08816

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**OFFICE OF PETITIONS**

In re Application of  
Kovesdi and Rajasekharan  
Application No. 10/035,952  
Filed: 26 December, 2001  
Attorney Docket No. 66566.01US2

:  
:  
:  
:  
:  
:

ON PETITION

This is a decision on the petition filed on 4 June, 2002, under 37 CFR 1.182, requesting acceptance of a power of attorney made on behalf of less than all the named inventors.

The petition under 37 CFR 1.182 is **DISMISSED AS MOOT**.

The petition is dismissed as moot because applicant Rajasekharan does not appear to have joined in the filing of the above-identified application. 37 CFR 1.41(a)(1) now defines the inventorship of a non-provisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63. On 13 May, 2002, a declaration was filed naming Rozsa Kovesdi and Ajit Rajasekharan as joint inventors. As the declaration filed with the present petition lists Rajasekharan as the sole inventor, that declaration does not list the proper inventive entity, and therefore does not comply with 37 CFR 1.63.

If applicant Rajasekharan believes the inventorship of the above-identified application is in error, he may wish to consider filing his own application.

All parties are reminded that dual correspondence will not be undertaken by the USPTO. A courtesy copy of this decision is being forwarded to the address listed on the petition. All future correspondence, however, will be mailed solely to the address of record.



Application No. 10/035,952

2

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.




Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination

cc: Trevor Coddington  
Brobeck, Phleger & Harrison, LLP  
1333 H Street, N.W., Suite 800  
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CHICAGO IL 60606-7482

Paper No. 12  
**COPY MAILED**

SEP 17 2002

OFFICE OF PETITIONS

In re Application of	: DECISION NOTING JOINDER OF
Kovesdi and Rajasekharan	: INVENTOR AND PETITION UNDER
Application No. 10/035,952	: 37 CFR 1.47(a) MOOT
Filed: 26 December, 2001	: AND DECISION GRANTING
Attorney Docket No. 66566.01US2	: PETITION UNDER 37 CFR 1.182

This is a decision on the renewed petition under 37 CFR 1.47(a) and 1.182 filed on 23 August, 2002.

The petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

The petition under 37 CFR 1.182 is **GRANTED**.

Papers filed on 23 August, 2002, in response to the Decision Under 37 CFR 1.47(a) and 1.182 mailed on 16 August, 2002, included a Declaration signed by the previously non-signing inventor, Rajasekharan, in compliance with 37 CFR 1.63.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is moot; this application does not have any rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this office for any further consideration under 37 CFR 1.47(a).

Petitioners should note that the order of inventors' names was established by the declaration filed on 13 May, 2002.

The declaration under 37 CFR 1.63 filed on 13 May, 2002, naming Rosza Kovesdi and Ajit Rajasekharan as joint inventors was signed by joint inventor Kovesdi and gave power of attorney to, *inter alia*, Robert E. Browne (Browne et al.) Of Altheimer & Gray, 10 South Wacker Drive, Suite 4000, Chicago, IL 60606-7482, as the correspondence address of record.

Petitioner Ajit Rahasekharan by way of Trevor Q. Coddington, Rodger L. Tate, Anthony W. Shaw, Cono A. Carrano, Laurence H. Posorske, Robert A. King, and Craig L. Puckett (Coddington et al.) of Brobeck, Phleger & Harrison LLP, 1333 H Street, NW, Suite 800, Washington, DC 20005, assert that a dispute has arisen between Rajasekharan and Kovesdi and seeks to require that all

correspondence filed in this application be signed by representatives of both joint inventors.

In accordance with MPEP 402.10, to assure that all interests are properly and effectively represented, all further correspondence to the U.S. Patent and Trademark Office (USPTO) must be signed by petitioner's representative (Coddington et al.) as named in the declaration and power of attorney submitted on 23 August, 2002, and likewise signed by Browne et al. who remain Kovasdi's representative. Each attorney signing subsequent papers must indicate whom he or she represents.


All parties are reminded that dual correspondence is not permitted and will not be undertaken by the USPTO.

The USPTO will continue to conduct correspondence with the attorneys first named in the application, i.e., Browne et al., at the correspondence address of record noted above, who will also be responsible for coordinating replies or submissions to the USPTO.<sup>1</sup>

It is noted that, notwithstanding this decision, the inventors may still jointly appoint or revoke a power of attorney.

The application is being forwarded to Technology Center 2800 for examination in due course.

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

  
Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

cc: Brobeck, Phleger & Harrison LLP  
Intellectual Property Department  
1333 H Street, N.W., Suite 800  
Washington, D.C. 20005

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<sup>1</sup>See MPEP 402.10.





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,597	11/15/2001	Ajit V. Rajasekharan	Ajit-1	7385

26118 7590 03/18/2003

**BROBECK, PHLEGER & HARRISON, LLP**  
ATTN: INTELLECTUAL PROPERTY DEPARTMENT  
1333 H STREET, N.W. SUITE 800  
WASHINGTON, DC 20005

EXAMINER

KOYAMA, KUMIKO C

ART UNIT PAPER NUMBER

2876

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/987,597	RAJASEKHARAN, AJIT V.	
	Examiner	Art Unit	
	Kumiko C. Koyama	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                         | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 | 6) <input type="checkbox"/> Other:  |



Application/Control Number: 09/087,597  
Art Unit: 2876

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## DETAILED ACTION

### *Claim Objections*

1. Claim 47-50 is objected to because of the following informalities:

Re claim 47-50: "The tour" has not been introduced in claim 38.

"the tour" should be changed to --a tour--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 18, 19, 21, 22, 31, 34, 38, 52 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (US 5,480,306, as cited by the Applicant).

Liu teaches a method and apparatus for providing information relevant to a physical world by reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored and the sound applied to a loud speaker system (col 2 lines 35+). Liu teaches that the bar code is printed on visible media, such as paper and plastic slides. The conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed



above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 19: Liu teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

Re claim 52: Liu teaches that the memory control means 5 may properly retrieve the desired digital speed data of the word from the memory means 6, which inherently shows that there is not pattern or sequential order for accessing, therefore it is randomly accessible.

Re claim 56: The apparatus is a purpose build device targeted to read bar code.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 9, 13, 16, 29, 30, 39-42, 57, 58, 61-63, 65-66 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US 5,480,306) in view of Savchenko et al (US 6,111,567).

Liu teaches a method and apparatus for reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored, converted to an analog signal, and the sound applied to a loud speaker system (col 2 lines 35+). The apparatus 10 is considered to be a circuitry. Liu teaches that the bar code is printed on visible media, such as paper and

plastic slides. Liu teaches that the apparatus having a memory and a speaker means for outputting the sound (col 6 lines 22-59).

Liu fails to teach a method for authoring information and a system for authoring the content.

Savchenko teaches methods of authoring multimedia titles (col 1 lines 8-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to create a well organized system so that minimal memory is utilized, but at the same time provide a good quality sound and maintain the flow of the music or sound produced.

Re claim 2 and 3: Liu fails to teach that the system for authoring content is resident in the apparatus.

Savchenko teaches that the execution instructions for the authoring tool are contained in the memory (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide a multifunctional apparatus so that the user may author and playback the sound according to his/her preference utilizing only one apparatus, which avoids complicated connections between multiple devices.

Re claim 9: Liu fails to teach that the step of storing the content in non-volatile memory resident in the apparatus.

Savchenko teaches that a computer application 42 is stored in the non-volatile memory 34 (col 4 lines 37-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to safely store the content so that the content is not easily changed or modified by others.

Re claim 13: Savchenko further teaches a computer readable storage media having instructions for authoring information (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to speed up the process by storing all the instruction in the memory and have the processor access and execute the instructions instead of loading or inputting the instructions one-by-one by the user.

Re claim 16, 29 and 30: In addition to Liu as modified by Savchenko discussed above, the conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 42: Liu teaches that rendering digital multimedia as a function of output capabilities of the apparatus (col 6 lines 50-58).

Liu fails to teach programming that renders digital multimedia as a function of output capabilities.

Savchenko teaches a computer application 42 that executes instructions (col 4 lines 36-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide the proper sound signal that matches the output characteristics of the apparatus so that the user can listen to a good quality sound with less background noise and interruption.

Re claim 61: Liu teaches that a keyboard for inputting information (col 1 lines 13-25).

6. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 above and Liu as applied to claim 18, and further in view of Cave (US 5,958,014). Liu as modified by Savchenko and Liu have been discussed above.

Liu as modified by Savchenko and Liu fail to teach that the content is a link to a live agent.

Cave teaches device having audio capabilities and can be connected to a live agent (col 1 lines 65+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cave to the teachings of Liu as modified by Savchenko in order to provide a two-way audio or text exchange to communicate with each other without remembering or dialing numbers, which also makes the process faster.

7. Claims 7, 14, 36, 37, 47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 38, and further in view of Conley, Jr. et al (US 6,434,745).

Liu teaches receiving a plurality of optical codes (col 7 line 45).

Therefore, it would have been obvious to utilize the steps of Liu as modified by Savchenko and repeat steps for as many coded labels necessary because it is a mere duplication of process.

Liu as modified by Savchenko fails to teach aggregating the content into a single logical entity called a tour.

Conley teaches that a tour component of the browser 8 allows the end-user to identify one or more URLs and save them into a group called a tour and to create one or more such tours, and to save each tour to a searchable local tour database on the end-user computer 14 similar to the searchable local image database.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Conley to the teachings of Liu as modified by Savchenko in order to organize the data so that related data are grouped in the same group. Such modification helps and speeds up the searching process when the data needs to be retrieved because the data are

8. Claims 8, 15, 32, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 31 above, and further in view of Brooks et al (US 4,963,719).

Liu as modified by Savchenko fails to teach detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can be rendered during detection of either the first or second label in the playback mode.

Brooks teaches two labels associated with the same object, two labels attached to an object and detecting two of the labels (Fig 2, col 2 lines 26+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Brooks to the teachings of Liu as modified by Savchenko so that plurality of bar code labels having the same sound or data may be provided on different or multiple appliances for duplication or convenience purposes.

9. Claim 10, 11, 12, 20, 25, 43-45 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1, 40 and 63 above and over Liu as applied to claim 18 above, and further in view of Cluts (US 5,616,876). Liu as modified by Savchenko and Liu have been discussed above.

Re claim 10, 20, 43 and 64: Liu as modified by Savchenko and Liu fail to teach a step of uploading and downloading the content to a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

Re claim 11 and 45: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wireless network.

Cluts teaches a communication link is wireless (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by

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Savchenko because it does not require wired connection, therefore provides mobility and convenience.

Re claim 12 and 44: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wired network.

Cluts teaches a communication link is wired (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because the possibility of data loss or corruption in transferred data decreases, therefore the modification provides a more accurate transmission of the data.

Re claim 25: Liu fails to teach that the step of rendering the content comprises streaming the content from a remote server.

Savchenko teaches rendering the content comprise streaming the content (col 1 lines 28-31).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to transmit the sound file through communication links using industry standards, such as MPEG standards.

Liu as modified by Savchenko fails to teach a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by

Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

10. Claims 17, 60 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claims 16, 57 and 63 above, and further in view of Bridgelall (US 6,264,106). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fail to disclose that the instructions allow a plurality of different label types to be normalized to one object identifier.

Bridgelall teaches a combination bar code scanner/RFID circuit for reading bar code or RFID (col 2 lines 20+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bridgelall to the teachings of Liu as modified by Savchenko because bar code and RFID tags are commonly known forms of identification and combining those two functions into one device will provide the flexibility of reading different types of codes.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Fan et al (US 6,324,165). Liu has been discussed above.

Liu fails to teach determining the current time and comparing the current time to the timestamp before rendering the content.

Fan teaches a timer issuing a current time and a comparator for comparing the queue timestamp to the current time (col 27 lines 7-12).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Fan to the teachings of Liu in order to



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provide a data that corresponds to the current time by checking to see if the current time and timestamp corresponds to each other.

12. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Boulton et al (US 5,566,291). Liu has been discussed above.

Liu further teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

Liu fails to teach that the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.

Boulton teaches an object identifier field 200 that stores an object identifier which references an object the user may be referencing with his or her feedback information. In Boulton's feedback system, objects can be used to further define the context when the feedback is provided (col 25 lines 55+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Boulton to the teachings of Liu in order to enhance the content and provide a better quality sound, image, etc. to the user by editing or making additional comments to the content.

13. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Boulton as applied to claim 26 above, and further in view of Cluts.

Liu as modified by Boulton fails to disclose the step of storing the annotations/feedback in a remote memory.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Boulton because a remote server may provide more memory or storage space, which allows more data and information to be stored.

14. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko and Cluts as applied to claim 45 above, and further in view of Aguirre et al (US 6,195,531). Liu/Savchenko/Cluts have been discussed above.

Liu/Savchenko/Cluts fails to teach that the wireless network comprises a cellular telephone network.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

15. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Cole et al (US 6,359,711). Liu have been discussed above.

Liu fails to disclose that the apparatus accesses the tour via the internet and a voice portal.

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Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

16. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Aguirre and Cole.

Liu fails to teach that the apparatus accesses the tour via a cellular telephone voice mailbox.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

17. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Krueger (US 5,598,540). Liu has been discussed above.

Liu fails to teach that the digital multimedia is accessible by the apparatus in a sequential order.

Krueger teaches accessing the stored data only in sequential order (Abstract).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Krueger to the teachings of Liu in case presentation of the digital multimedia must be in a certain order for the user to understand certain topics before achieving the next data so that the next data makes more sense to the user.

18. Claims 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Ramachandran (US 6,315,195). Liu has been discussed above.

Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

Ramachandran teaches a portable terminal 14 that reads bar codes and also may be integrated into a carrier 62, which may be a personal digital assistant or a cellular phone (col 8 lines 23-26, col 9 lines 35-42).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Ramachandran to the teachings of Liu because both personal digital assistant and cellular phones have the capability of storing information and also wirelessly transmitting information through internet and other communication methods, which enhances the voice data and play back as well.

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19. Claims 59 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 57 and 63 above, and further in view of Chen et al (US 5,869,820). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach that the circuitry comprises an IR tag reader.

Chen teaches an infrared tag reader (col 8 line 5).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Chen to the teachings of Liu as modified by Savchenko because IR tags are readily available tags that are also used for identification purposes and it utilizes wireless communication, which provides mobility and faster process.

20. Claim 68 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 63 above, and further in view of Bertram et al (US 5,613,137). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach a circuitry determining a coordinate location.

Bertram teaches a coordinate determining circuitry 302 configured to determine corresponding locations of the touch on the coordinate sensor (col 15 lines 20-28).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bertram to the teachings of Liu as modified by Savchenko in order to determine the location of the touch pad sensor input that provides the information regarding the identification of the content to be retrieved and played back.

***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Savchenko et al., U.S. Patent No. 6,343,298, discloses a seamless multimedia branching.

Swartz et al., U.S. Patent No. 6,095,418, discloses an apparatus for processing symbol encoded document information.

Kikuda, U.S. Patent No 4,952,785, discloses a bar code generating apparatus for image communication terminal device.

Raistrick et al., U.S. Patent No. 5,971,279, discloses a hand held scanner for the visually impaired.

Citron et al., U.S. Patent No. 5,288,976, discloses a bar code use in information, transactional and other system and service applications.

Kunizawa et al., U.S. Patent No. 4,964,167, discloses an apparatus for generating synthesized voice from text.

Knowles discloses a hand-held portable www access terminal with visual display panel an gui-based www browser program integrated with bar code symbol reader in a hand-supportable housing.

Hoda et al., U.S. Patent No. 4,831,610, discloses method and apparatus for interactive control of a data recording medium playback apparatus using bar code access.

Barton et al., U.S. Patent No. 5,998,752, discloses a sorting system.

Dyko et al, U.S. Patent No. 5,956,708, discloses an integration of link generation cross-author user navigation, and reuse identification in authoring process.

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Wilz, Sr. et al., U.S Patent No. 5,992,752, discloses an internet-based system for enabling information-related transactions over the internet using java-enabled internet terminals provided with reading java-applet encoded bar code symbols.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 703-305-5425. The examiner can normally be reached on Monday-Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

kck  
March 7, 2003

*Diane I. Lee*  
Diane I. Lee  
Primary Examiner  
GAU 2876

<b>Notice of References Cited</b>	Application/Contrc 09/987,597	Applicant(s)/Patent Under Reexamination RAJASEKHARAN, AJIT V.	
	Examiner Kumiko C. Koyama	Art Unit 2876	Page 1 of 2

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,480,306	01-1996	Liu, Chih-Yuan	434/156
	B	US-6,111,567	08-2000	Savchenko et al.	715/500.1
	C	US-5,958,014	09-1999	Cave, Ellis K.	709/229
	D	US-6,434,745	08-2002	Conley et al.	717/177
	E	US-4,963,719	10-1990	Brooks et al.	235/462.12
	F	US-5,616,876	04-1997	Cluts, Jonathan C.	84/609
	G	US-6,264,106	07-2001	Bridgelall, Raj	235/462.46
	H	US-6,324,165	11-2001	Fan et al.	370/232
	I	US-5,566,291	10-1996	Boulton et al.	345/709
	J	US-6,195,531	02-2001	Aguirre et al.	455/11.1
	K	US-6,359,711	03-2002	Cole et al.	359/118
	L	US-5,598,540	01-1997	Krueger, Steven D.	710/104
	M	US-6,315,195	11-2001	Ramachandran, Natarajan	235/380

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



<b>Notice of References Cited</b>	Application/Contrc 09/987,597	Applicant(s)/Patent Under Reexamination RAJASEKHARAN, AJIT V.	
	Examiner Kumiko C. Koyama	Art Unit 2876	Page 2 of 2

#### U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,869,820	02-1999	Chen et al.	235/376
	B	US-5,613,137	03-1997	Bertram et al.	710/1
	C	US-6,343,298	01-2002	Savchenko et al.	707/104.1
	D	US-6,095,418	08-2000	Swartz et al.	235/462.01
	E	US-4,952,785	08-1990	Kikuda, Yukio	235/432
	F	US-5,971,279	10-1999	Raistrick et al.	235/472.01
	G	US-5,288,976	02-1994	Citron et al.	235/375
	H	US-4,964,167	10-1990	Kunizawa et al.	704/260
	I	US-5,905,251	05-1999	Knowles, Carl Harry	235/472.01
	J	US-4,831,610	05-1989	Hoda et al.	369/47.23
	K	US-5,998,752	12-1999	Barton et al.	209/583
	L	US-5,956,708	09-1999	Dyko et al.	707/3
	M	US-5,992,752	11-1999	Witz et al.	235/472.01

#### FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
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	Q					
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	S					
	T					


#### NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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	X	

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Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,952	12/26/2001	Rozsa Kovacs	66566.01US2	3522

25541 7590 03/18/2003

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EXAMINER

KOYAMA, KUMIKO C

ART UNIT PAPER NUMBER

2876

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

1-20

**Office Action Summary**

Application No.

10/035,952

Applicant(s)

KOVESDI ET AL.

Examiner

Kumiko C. Koyama

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 23, 24, 25...69, 70, 71 have been renumbered 22, 23, 24...68, 69, 70 respectively.

### *Double Patenting*

2. A rejection is based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-31, 33-42 and 45-70 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-70 of copending Application No. 09/987597. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 18, 19, 21, 22, 31, 34, 38, 54 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (US 5,480,306, as cited by the Applicant).

Liu teaches a method and apparatus for providing information relevant to a physical world by reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored and the sound applied to a loud speaker system (col 2 lines 35+). Liu teaches that the bar code is printed on visible media, such as paper and plastic slides. The conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 19: Liu teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

Re claim 54: Liu teaches that the memory control means 5 may properly retrieve the desired digital speed data of the word from the memory means 6, which inherently shows that there is not pattern or sequential order for accessing, therefore it is randomly accessible.

Re claim 58: The apparatus is a purpose build device targeted to read bar code.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 9, 13, 16, 29, 30, 39-42, 59, 60, 63-64 and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US 5,480,306) in view of Savchenko et al (US 6,111,567).

Liu teaches a method and apparatus for reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored, converted to an analog signal, and the sound applied to a loud speaker system (col 2 lines 35+). The apparatus 10 is considered to be a circuitry. Liu teaches that the bar code is printed on visible media, such as paper and plastic slides. Liu teaches that the apparatus having a memory and a speaker means for outputting the sound (col 6 lines 22-59).

Liu fails to teach a method for authoring information and a system for authoring the content.

Savchenko teaches methods of authoring multimedia titles (col 1 lines 8-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order

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to create a well organized system so that minimal memory is utilized, but at the same time provide a good quality sound and maintain the flow of the music or sound produced.

Re claim 2 and 3: Liu fails to teach that the system for authoring content is resident in the apparatus.

Savchenko teaches that the execution instructions for the authoring tool are contained in the memory (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide a multifunctional apparatus so that the user may author and playback the sound according to his/her preference utilizing only one apparatus, which avoids complicated connections between multiple devices.

Re claim 9: Liu fails to teach that the step of storing the content in non-volatile memory resident in the apparatus.

Savchenko teaches that a computer application 42 is stored in the non-volatile memory 34 (col 4 lines 37-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to safely store the content so that the content is not easily changed or modified by others.

Re claim 13: Savchenko further teaches a computer readable storage media having instructions for authoring information (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order



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to speed up the process by storing all the instruction in the memory and have the processor access and execute the instructions instead of loading or inputting the instructions one-by-one by the user.

Re claim 16, 29 and 30: In addition to Liu as modified by Savchenko discussed above, the conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 42: Liu teaches that rendering digital multimedia as a function of output capabilities of the apparatus (col 6 lines 50-58).

Liu fails to teach programming that renders digital multimedia as a function of output capabilities.

Savchenko teaches a computer application 42 that executes instructions (col 4 lines 36-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide the proper sound signal that matches the output characteristics of the apparatus so that the user can listen to a good quality sound with less background noise and interruption.

Re claim 63: Liu teaches that a keyboard for inputting information (col 1 lines 13-25).

8. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 above and Liu as applied to claim 18, and further in

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view of Cave (US 5,958,014). Liu as modified by Savchenko and Liu have been discussed above.

Liu as modified by Savchenko and Liu fail to teach that the content is a link to a live agent.

Cave teaches device having audio capabilities and can be connected to a live agent (col 1 lines 65+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cave to the teachings of Liu as modified by Savchenko in order to provide a two-way audio or text exchange to communicate with each other without remembering or dialing numbers, which also makes the process faster.

9. Claims 7, 14, 36, 37, 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 38, and further in view of Conley, Jr. et al (US 6,434,745).

Liu teaches receiving a plurality of optical codes (col 7 line 45).

Therefore, it would have been obvious to utilize the steps of Liu as modified by Savchenko and repeat steps for as many coded labels necessary because it is a mere duplication of process.

Liu as modified by Savchenko fails to teach aggregating the content into a single logical entity called a tour.

Conley teaches that a tour component of the browser 8 allows the end-user to identify one or more URLs and save them into a group called a tour and to create one or more such tours, and

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to save each tour to a searchable local tour database on the end-user computer 14 similar to the searchable local image database.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Conley to the teachings of Liu as modified by Savchenko in order to organize the data so that related data are grouped in the same group. Such modification helps and speeds up the searching process when the data needs to be retrieved because the data are

10. Claims 8, 15, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 31 above, and further in view of Brooks et al (US 4,963,719).

Liu as modified by Savchenko fails to teach detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can be rendered during detection of either the first or second label in the playback mode.

Brooks teaches two labels associated with the same object, two labels attached to an object and detecting two of the labels (Fig 2, col 2 lines 26+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Brooks to the teachings of Liu as modified by Savchenko so that plurality of bar code labels having the same sound or data may be provided on different or multiple appliances for duplication or convenience purposes.

11. Claim 10, 11, 12, 20, 25, 45-47 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 64 above and over

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Liu as applied to claim 18, 38 above, and further in view of Cluts (US 5,616,876). Liu as modified by Savchenko and Liu have been discussed above.

Re claim 10, 20, 45 and 65: Liu as modified by Savchenko and Liu fail to teach a step of uploading and downloading the content to a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

Re claim 11 and 47: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wireless network.

Cluts teaches a communication link is wireless (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because it does not require wired connection, therefore provides mobility and convenience.

Re claim 12 and 46: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wired network.

Cluts teaches a communication link is wired (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by

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Savchenko because the possibility of data loss or corruption in transferred data decreases, therefore the modification provides a more accurate transmission of the data.

Re claim 25: Liu fails to teach that the step of rendering the content comprises streaming the content from a remote server.

Savchenko teaches rendering the content comprise streaming the content (col 1 lines 28-31).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to transmit the sound file through communication links using industry standards, such as MPEG standards.

Liu as modified by Savchenko fails to teach a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

12. Claims 17, 62 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claims 16, 59 and 64 above, and further in view of Bridgelall (US 6,264,106). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fail to disclose that the instructions allow a plurality of different label types to be normalized to one object identifier.

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Bridgelall teaches a combination bar code scanner/RFID circuit for reading bar code or RFID (col 2 lines 20+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bridgelall to the teachings of Liu as modified by Savchenko because bar code and RFID tags are commonly known forms of identification and combining those two functions into one device will provide the flexibility of reading different types of codes.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Fan et al (US 6,324,165). Liu has been discussed above.

Liu fails to teach determining the current time and comparing the current time to the timestamp before rendering the content.

Fan teaches a timer issuing a current time and a comparator for comparing the queue timestamp to the current time (col 27 lines 7-12).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Fan to the teachings of Liu in order to provide a data that corresponds to the current time by checking to see if the current time and timestamp corresponds to each other.

14. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Boulton et al (US 5,566,291). Liu has been discussed above.

Liu further teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

Liu fails to teach that the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.

Boulton teaches an object identifier field 200 that stores an object identifier which references an object the user may be referencing with his or her feedback information. In Boulton's feedback system, objects can be used to further define the context when the feedback is provided (col 25 lines 55+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Boulton to the teachings of Liu in order to enhance the content and provide a better quality sound, image, etc. to the user by editing or making additional comments to the content.

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Boulton as applied to claim 26 above, and further in view of Cluts.

Liu as modified by Boulton fails to disclose the step of storing the annotations/feedback in a remote memory.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Boulton because a remote server may provide more memory or storage space, which allows more data and information to be stored.

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16. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 31 above, and further in view of Swartz et al (US 6,095,418). Liu has been discussed above.

Liu fails to teach that at least one of the plurality of labels is custom created.

Swartz teaches translating the MIDI code to a symbol data and to music print data. The printer 26 then prints the symbol data as symbol 14.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Swartz to the teachings of Liu in order to provide custom created bar code so that information regarding the content's location within the database or other information may be encoded according to the program or application that is used for the system.

17. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 38 above, and further in view of Hollander (US 4,037,302) and Blum (US 4,654,727). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fail to teach that the physical world comprises labeled locations containing labeled mobile objects and the labeled locations are used to determine proximity of the labeled mobile objects.

Holland teaches labeled locations, such as labeled bin or labeled shelf (col 4 lines 48-51).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Holland to the teachings of Liu as modified by Savchenko in order to identify the purpose, use or the physical description of the location of the labeled location so that the locations can easily and quickly identified.



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Blum teaches that a bar code label on the cassette is read by a bar code reader in order to enable a computer control system to determine the location of the cassette and control the subsequent transport of cassettes to the tape transports (col 1 lines 40-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Blum to the teachings of Liu as modified by Savchenko in order to quickly and easily determine the location of the object by using the bar code label as a tracking method, which also avoids the object from getting lost.

18. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko and Cluts as applied to claim 47 above, and further in view of Aguirre et al (US 6,195,531). Liu/Savchenko/Cluts have been discussed above.

Liu/Savchenko/Cluts fails to teach that the wireless network comprises a cellular telephone network.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

19. Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Cole et al (US 6,359,711). Liu have been discussed above.

Liu fails to disclose that the apparatus accesses the tour via the internet and a voice portal.

Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

20. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Aguirre and Cole.

Liu fails to teach that the apparatus accesses the tour via a cellular telephone voice mailbox.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

Art Unit: 2876

21. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Krueger (US 5,598,540). Liu has been discussed above.

Liu fails to teach that the digital multimedia is accessible by the apparatus in a sequential order.

Krueger teaches accessing the stored data only in sequential order (Abstract).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Krueger to the teachings of Liu in case presentation of the digital multimedia must be in a certain order for the user to understand certain topics before achieving the next data so that the next data makes more sense to the user.

22. Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Ramachandran (US 6,315,195). Liu has been discussed above.

Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

Ramachandran teaches a portable terminal 14 that reads bar codes and also may be integrated into a carrier 62, which may be a personal digital assistant or a cellular phone (col 8 lines 23-26, col 9 lines 35-42).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Ramachandran to the teachings of Liu because both personal digital assistant and cellular phones have the capability of storing information and also wirelessly transmitting information through internet and other communication methods, which enhances the voice data and play back as well.

Art Unit: 2876

23. Claims 61 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 59 and 64 above, and further in view of Chen et al (US 5,869,820). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach that the circuitry comprises an IR tag reader.

Chen teaches an infrared tag reader (col 8 line 5).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Chen to the teachings of Liu as modified by Savchenko because IR tags are readily available tags that are also used for identification purposes and it utilizes wireless communication, which provides mobility and faster process.

24. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 64 above, and further in view of Bertram et al (US 5,613,137). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach a circuitry determining a coordinate location.

Bertram teaches a coordinate determining circuitry 302 configured to determine corresponding locations of the touch on the coordinate sensor (col 15 lines 20-28).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bertram to the teachings of Liu as modified by Savchenko in order to determine the location of the touch pad sensor input that provides the information regarding the identification of the content to be retrieved and played back.

***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Savchenko et al., U.S. Patent No. 6,343,298, discloses a seamless multimedia branching.

Kikuda, U.S. Patent No 4,952,785, discloses a bar code generating apparatus for image communication terminal device.

Raistrick et al., U.S. Patent No. 5,971,279, discloses a hand held scanner for the visually impaired.

Citron et al., U.S. Patent No. 5,288,976, discloses a bar code use in information, transactional and other system and service applications.

Kunizawa et al., U.S. Patent No. 4,964,167, discloses an apparatus for generating synthesized voice from text.

Knowles discloses a hand-held portable www access terminal with visual display panel an gui-based www browser program integrated with bar code symbol reader in a hand-supportable housing.

Hoda et al., U.S. Patent No. 4,831,610, discloses method and apparatus for interactive control of a data recording medium playback apparatus using bar code access.

Barton et al., U.S. Patent No. 5,998,752, discloses a sorting system.

Dyko et al, U.S. Patent No. 5,956,708, discloses an integration of link generation cross-author user navigation, and reuse identification in authoring process.

Art Unit: 2876

Wilz, Sr. et al., U.S Patent No. 5,992,752, discloses an internet-based system for enabling information-related transactions over the internet using java-enabled internet terminals provided with reading java-applet encoded bar code symbols.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 703-305-5425. The examiner can normally be reached on Monday-Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


kck  
March 7, 2003

*Diane I. Lee*  
Diane I. Lee  
Primary Examiner  
GAU 2876

**Burden Hour Statement:** This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.**

# JP813214

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RODGER L. TATE  
DIRECT DIAL: 202-419-2069  
EMAIL: rtate@hunton.com

FILE NO: 63044.5

May 21, 2003

Rattan Nath  
Pennie & Edmonds LLP  
1155 Avenue of the Americas  
New York, N.Y. 10036-2711

Re: U.S. Patent Application No. 10/035,952 ("the '952 application")  
Filed: December 26, 2001  
Entitled: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING  
INFORMATION RELEVANT TO A PHYSICAL WORLD  
Your Ref.: 11326-003  
Our Ref.: 63044.5

---

Dear Mr. Nath:

In order to maintain a clear line of demarcation between the '952 application and related U.S. Patent No. 09/987,587 ("the '587 application"), all claims solely conceived by Mr. Rajasekharan in the '952 application, *i.e.*, renumbered claims 1-42 and 45-70, need to be cancelled in the next response. Enclosed is a Response that we have prepared. The Response cancels claims 1-42 and 45-70 and provides arguments for overcoming the outstanding rejection of the remaining claims. We request that you sign this Response as required under MPEP § 402.10 and return it to us for filing with the United States Patent & Trademark Office.

Sincerely,

Rodger L. Tate

RLT/TQC:mia  
Enclosures



HUNTON & WILLIAMS LLP  
1900 K STREET, N.W.  
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RODGER L. TATE  
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FILE NO: 63044.2

May 21, 2003

Rattan Nath  
Pennie & Edmonds LLP  
1155 Avenue of the Americas  
New York, N.Y. 10036-2711

Re: U.S. Patent Application No. 09/987,587 ("the '587 application")  
Filed: November 15, 2001  
Entitled: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING  
INFORMATION RELEVANT TO A PHYSICAL WORLD  
Inventor: Ajit Rajasekharan  
Our Ref.: 63044.2

---

Dear Mr. Nath:

In response to your correspondence dated April 21, 2003, Mr. Rajasekharan maintains that the inventorship set forth in his original declaration is correct and legally proper in view of the subject matter presented in the claims of the above-identified application. Therefore, it would be improper for him to execute a new declaration stating otherwise as you request.

We wish to remind you that the '587 application does not include any claims that were conceived in part by Ms. Kovesdi. The only claims of U.S. Provisional Application No. 60/306,356 that Ms. Kovesdi arguably made a conceptual contribution to are claims 44 and 45, which are not being pursued in the '587 application. Due to the absence of these claims, the claims of the '587 application vis-à-vis those in U.S. Patent Application No. 10/035,952 are not substantially identical as you state in your Petition under 37 C.F.R. § 1.182.

Because prosecution of the '587 application is conducted *ex parte*, we find no reason at this time to substantively respond to the merits of your improper Petition.

Sincerely,

Rodger L. Tate

RLT/TQC:mia

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:	)	
	)	
Rozsa KOVESDI and Ajit RAJASEKHARAN	)	Group Art Unit: 2876
	)	
Application Number: 10/035,952	)	Examiner Kumiko C. KOYAMA
	)	
Filed: December 26, 2001	)	Confirmation No. 3522
	)	
For: SYSTEM AND METHOD FOR	)	
AUTHORING AND PROVIDING	)	
INFORMATION RELEVANT TO A	)	
PHYSICAL WORLD	)	

REPLY TO NON-FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.111

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed on March 18, 2003, Applicants respectfully request entry of the following amendments.

IN THE CLAIMS:

Please enter the claim amendments as provided on the following pages and in the simplified amendment format as set forth by the Deputy Commissioner. See Pre-OG Notice, January 31, 2003 (discussing the PTO's proposed revision to and waiver of current 37 C.F.R. § 1.121). No new matter has been added by these amendments as they are fully supported by the original claims.

*Claims 43 and 44 are amended as follows.<sup>1</sup>*

*Claims 1-42 and 45-70 have been cancelled.*

*Claims 43 and 44 are currently pending.*

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<sup>1</sup> Due to the absence of claim 22 in the application as originally filed, claims 23-71 have been renumbered to claims 22-70, respectively. See Office Action, page 2.

Claims 1-42. (Cancelled)

43. (Currently Amended) [The system as recited in claim 39] A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising:  
a plurality of machine readable labels relevant to the physical world;  
an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and  
a digital multimedia library accessible by the apparatus storing content indexed by the object identifiers.

wherein the physical world comprises labeled locations containing labeled mobile objects.

44. (Currently Amended) The system as recited in claim [44] 43, wherein the labeled locations are used to determine proximity of the labeled mobile objects.

45-70. (Cancelled)

REMARKS

Claims 43 and 44 are pending. Applicants respectfully request that the Examiner reconsider all rejections in the outstanding Office Action in view of the foregoing amendments and the following remarks.

1. Claims 1-42 and 45-70

Claims 1-42 and 45-70 have been cancelled. Accordingly, all rejections in the instant application with respect to these claims are rendered moot.

Applicants note that these claims are solely conceived by Mr. Ajit Rajasekharan and are therefore being pursued in related U.S. Patent Application No. 09/987,597, which correctly identifies Mr. Rajasekharan as the sole inventor.

2. 35 U.S.C. § 103

Claims 43 and 44 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered unpatentable over U.S. Patent No. 5,480,306 to Liu in view of U.S. Patent No. 6,111,567 to Savchenko, and further in view of U.S. Patent No. 4,037,302 to Hollander and U.S. Patent No. 4,654,727 to Blum. Office Action, page 13. The Examiner concludes that Liu as modified by Savchenko fails to teach that the physical world comprises labeled locations containing labeled mobile objects and the labeled locations are used to determined proximity of the labeled mobile objects. *Id.* In an attempt to cure such a deficiency, Holland is introduced as teaching labeled locations, such as a labeled bin or labeled shelf.<sup>2</sup> *Id.* Applicants respectfully traverse this rejection on the following grounds.

In order to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (citations omitted). In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453,

---

<sup>2</sup> It appears that the Office Action does not rely on Blum with respect to claim 43.

1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the combination of multiple references, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

There is no showing of any objective teaching to combine Liu, Savchenko, and Hollander as applied to claim 43. The Office action merely states: “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the teachings of Holland to the teachings of Liu as modified by Savchenko in order to identify the purpose, use or the physical description of the location of the labeled location so that the locations can easily and quickly [be] identified.” This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these three references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination. Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness.

Even assuming, *arguendo*, that a *prima facie* case of obviousness has been established, Liu, either taken alone or in combination with the secondary references, fails to teach or suggest all the limitations of claim 43.

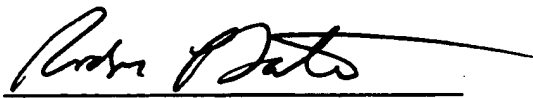
For at least the reasons set forth above, Applicants respectfully submit that the instant rejection is improper and therefore, request that the Examiner withdraw the rejection of claims 43 and 44.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. No fee is believed to be required for the entry of this response. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Response or to maintain the present application as pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,



Dated: 5/21/03

By:   
Rodger L. Tate  
Registration No. 27,399  
(Representative for Mr. Rajasekharan)  
Hunton & Williams LLP  
Intellectual Property Department  
1900 K Street, N.W., Suite 1200  
Washington, DC 20006-1109

Dated: \_\_\_\_\_

By: \_\_\_\_\_  
Ognjan V. Shentov  
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# JP813214

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September 15, 2003

Via Facsimile and Federal Express

(202) 778-2201

11326-003

Rodger L. Tate  
HUNTON & WILLIAMS  
1900 K Street, N.W., Suite 1200  
Washington, D.C. 20006-1109

Re: United States Patent Application Serial No. 10/035,952  
Filed: December 26, 2001  
For: SYSTEM AND METHOD FOR AUTHORIZING  
AND PROVIDING INFORMATION RELEVANT  
TO A PHYSICAL WORLD  
By: Kovesdi et al.

Dear Mr. Tate:

Enclosed is a copy of a response to the Office Action dated March 18, 2003 in the above mentioned application. We acknowledge receipt of your letters dated May 21, 2003 suggesting cancellation of several claims. The enclosed response takes into account Ms. Kovesdi's status as a coinventor in both the abovementioned patent application and the copending application that has been filed with insufficient authority to prosecute.

Please sign and return the enclosed response for filing with the Patent and Trademark Office without delay. Should you have any specific questions or suggestions, please do not hesitate in timely contacting us. In the event we do not hear from you, we will file the response with the Patent and Trademark Office to meet the response deadline.

Sincerely,

A handwritten signature in black ink, appearing to read 'Rattan Nath'.

Rattan Nath

Enclosure

c: Ognjan Shentov, Esq.

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**FROM**  
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**URGENT**

**TO: HUNTON & WILLIAMS**  
1900 K Street, N. W., Suite 1200  
Washington, D.C. 20006-1109

**Attention: Rodger L. Tate**

**FAX NO.: 1-202-778-2201**

**FROM: Rattan Nath**

**PAGES: 23**

**DATE: September 15, 2003**

**Application of: Kovesdi et al.**

**Serial No. 10/035,952**

**Filed: December 26, 2001**

**Transmitted herewith is the response to the Office Action of March 18, 2003**

**If you have any problem with your reception, please telephone the sender  
at (212) 790-6536.**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:	Kovesdi et al.	Confirmation No.:	3522
Serial No.:	10/035,952	Art Unit:	2876
Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	11326-0003-999

**RESPONSE AND AMENDMENT UNDER 37 C.F.R. § 1.111**

Commissioner for Patents  
PO BOX 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed March 18, 2003, and in accordance with the Rules of Practice, please enter the following amendments and consider the following remarks:

#### IN THE CLAIMS:

Applicants present all of the pending claims as indicated by the Office Action below. Claims 71-109 timely submitted in a preliminary amendment are not addressed by the Office Action, and are also not listed below. In addition, listed claims that were renumbered by the Examiner (presumably including adjusting the respective dependencies) to correct a mistake in the numbering have been identified as being previously amended to solely indicate this fact. Applicants thank Examiner Koyama for the corrections.

Please amend claims 1, 8, 13, 15-16, 31, 36, and 59 with insertions indicated by underlined text and deletions by strikethroughs, to read as follows:

1. (Currently amended) A method for authoring information relevant to a physical world, comprising:
  - detecting with an authoring device a first label associated with a first object;
  - and triggering, in response to detecting, a system for authoring content;
  - wherein the content is to be unambiguously bound to the first object and is to be rendered on a playback device during in response to detection of the first label.
2. (Original) The method as recited in claim 1, wherein the system for authoring content is resident on the authoring device.
3. (Original) The method as recited in claim 1, wherein the authoring device and the playback device are integrated within a single apparatus.
4. (Original) The method as recited in claim 1, wherein the label is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, a text string, and a speech to text string.
5. (Original) The method as recited in claim 1, wherein the content is selected from a group consisting of audio, text, image, and video.
6. (Original) The method as recited in claim 1, wherein the content is a link to a live agent.
7. (Original) The method as recited in claim 1, further comprising the steps of detecting a second label associated with a second object; triggering, in response to detecting, the system for authoring content which is unambiguously bound to the

second object; and aggregating the content bound to the first object and the second object into a tour.

8. (Currently amended) The method as recited in claim 1, further comprising the step of detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can rendered during in response to detection of either the first or second label in the playback mode.
9. (Original) The method as recited in claim 1, further comprising the step of storing the content in non-volatile memory resident in the apparatus.
10. (Original) The method as recited in claim 1, further comprising the step of uploading the content to a remote server.
11. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wireless network.
12. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wired network.
13. (Currently amended) A computer-readable media having instructions for authoring information relevant to a physical world, the instructions performing steps comprising:
  - detecting a first label associated with a first object; and
  - triggering, in response to detecting, a system for authoring content to be unambiguously bound to the first object; wherein the content is to be rendered during in response to detection of the first label by a device in a playback mode.
14. (Original) The computer-readable media as recited in claim 13, wherein the instructions perform the further steps of detecting a second label associated with a second object; triggering, in response to detecting, a system for authoring content to be unambiguously bound to the second object; and aggregating the content bound to the first object and the second object into a tour.
15. (Currently amended) The computer-readable media as recited in claim 14, wherein the instructions perform the further step of detecting a second label associated with the first object and normalizing the first label and the second label

such that the content can rendered during in response to detection of either the first or second label by the device in the playback mode.

16. (Currently amended) A computer-readable media having instructions for authoring content to be associated with objects in a physical world, the instructions performing steps comprising:
  - normalizing a read object label associated with an object into an object identifier;
  - placing the object identifier into a database;
  - accepting content to be rendered when in response to the object label is being read in a playback mode; and
  - binding the content to the object identifier in the database.
17. (Original) The computer-readable media as recited in claim 16, wherein the instructions allow a plurality of different label types to be normalized to one object identifier.
18. (Original) A method for providing information relevant to a physical world, comprising: detecting with a device a label associated with an object; normalizing information contained in the detected label into an object identifier; using the object identifier to search a database to find content bound to the object identifier; and rendering the content.
19. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from local memory in the apparatus.
20. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from a remote server.
21. (Original) The method as recited in claim 18, wherein the content is selected from a group consisting of audio, text, image, and video.
22. (Previously amended) The method as recited in claim 18, wherein the label is selected from a group consisting of a barcode, a coordinate, an IR tag, a RFID tag, a timestamp, a text string, and a speech to text string.
23. (Previously amended) The method as recited in claim 18, wherein the content is a connection to a live agent.

24. (Previously amended) The method as recited in claim 18, further comprising the step of determining the current time and comparing the current time to the timestamp before rendering the content.
25. (Previously amended) The method as recited in claim 18, wherein the step of rendering the content comprises streaming the content from a remote server.
26. (Previously amended) The method as recited in claim 18, further comprising the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.
27. (Previously amended) The method as recited in claim 26, further comprising the step of storing the annotations/feedback in local memory.
28. (Previously amended) The method as recited in claim 26, further comprising the step of storing the annotations/feedback in a remote memory.
29. (Previously amended) A computer-readable media having instructions for providing information relevant to a physical world, the instructions performing steps comprising:
  - detecting a label associated with an object;
  - normalizing information contained in the detected label into an object identifier;
  - using the object identifier to search a database to find content bound to the object identifier; and
  - rendering the content.
30. (Previously amended) The computer-readable media as recited in claim 29, wherein the content is selected from a group consisting of audio, text, and video.
31. (Currently amended) A method for providing information relevant to a physical world, comprising:
  - storing an object identifier indicative of a plurality of read labels associated with an object into a database; and
  - using the database to bind content to the object identifier and, accordingly, the object; whereby the content is renderable when in response to any one of the plurality of labels is being detected in a playback mode.

32. (Previously amended) The method as recited in claim 31, wherein at least one of the plurality of labels is custom created.
33. (Previously amended) The method as recited in claim 31, further comprising the step of attaching at least one of the plurality of labels to the object.
34. (Previously amended) The method as recited in claim 31, wherein the plurality of labels is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, and a text string.
35. (Previously amended) The method as recited in claim 31, further comprising the steps of detecting the plurality of labels.
36. (Currently amended) A method for providing information relevant to a physical world, comprising:
- associating one or more labels with each of a plurality of objects in a tour;
  - storing an object identifier indicative of the one or more labels associated with each of the plurality of object in the tour in a database;
  - authoring content relevant to each of the plurality of objects in the tour; and
  - binding the content to an object identifier in the database which corresponds to the relevant one of the plurality of objects in the tour whereby the content is renderable ~~when~~ in response to the label is being detected by a playback device without regard to the order in which the content was authored.
37. (Previously amended) The method as recited in claim 36, wherein the labels are selected from a group consisting of coordinates, barcode labels, RFID tags, IR tags, timestamps, and text.
38. (Previously amended) A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising:
- a plurality of machine readable labels relevant to the physical world;
  - an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and
  - a digital multimedia library accessible by the apparatus storing content indexed by the object identifiers.



39. (Previously amended) The system as recited in claim 38, wherein the apparatus further comprises a system for authoring digital multimedia in response to detecting one of the plurality of labels which is to be stored within the digital multimedia library and unambiguously bound to the object identifier.
40. (Previously amended) The system as recited in claim 39, wherein the apparatus further comprises a system for rendering digital multimedia in response to detecting one of the plurality of labels, the digital multimedia rendered being the content unambiguously bound to the object identifier associated with a detected label.
41. (Previously amended) The system as recited in claim 40, wherein the digital multimedia library includes one or more of audio files, visual image files, text files, video files, XML files, hyperlink references, live agent connection links, programming code files, and configuration information files.
42. (Previously amended) The system as recited in claim 40, wherein the apparatus comprises programming that renders digital multimedia as a function of output capabilities of the apparatus.
43. (Previously amended) The system as recited in claim 38, wherein the physical world comprises labeled locations containing labeled mobile objects.
44. (Previously amended) The system as recited in claim 43, wherein the labeled locations are used to determine proximity of the labeled mobile objects.
45. (Previously amended) The system as recited in claim 38, wherein the digital multimedia library is stored on one or more computer servers external to the apparatus.
46. (Previously amended) The system as recited in claim 45, wherein the digital multimedia library and the apparatus communicate via a wired network.
47. (Previously amended) The system as recited in claim 45, wherein the digital multimedia library and the apparatus communicate via a wireless network.
48. (Previously amended) The system as recited in claim 47, wherein the wireless network comprises a cellular telephone network.
49. (Previously amended) The system as recited in claim 38, wherein the digital multimedia library resides on the apparatus.

50. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via the Internet.
51. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via a voice portal.
52. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via a cellular telephone voice mailbox.
53. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is aggregated into a tour.
54. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is randomly accessible by the apparatus.
55. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is accessible by the apparatus in a sequential order.
56. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises a personal digital assistant.
57. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises a cellular telephone.
58. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises purpose built devices targeted to a specific application.
59. (Currently amended) An apparatus for authoring information relevant to a physical world, comprising:
  - circuitry for detecting a label associated with an object; and
  - a system for authoring content to be unambiguously bound to the object as represented by the detected label which content is to be rendered during in response to detection of the label in a playback mode.
60. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a barcode reader.
61. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises an IR tag reader.

62. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a RFID tag reader.
63. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a keyboard for inputting textual information.
64. (Previously amended) An apparatus for authoring and providing information relevant to a physical world, comprising:
- circuitry for detecting a label associated with an object, and programming for normalizing information contained in the detected label into an object identifier;
  - a system for authoring content in an authoring mode which content is to be unambiguously bound to the object identifier; and
  - a system for rendering content in a playback mode, the content rendered being the content unambiguously bound to the object identifier associated with a detected label.
65. (Previously amended) The apparatus as recited in claim 64, further comprising a communications link for downloading authored content to a remote location and for retrieving content from the remote location for rendering.
66. (Previously amended) The apparatus as recited in claim 64, further comprising a memory for storing the content.
67. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry comprises a barcode reader.
68. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry comprises an IR tag reader.
69. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry determines a coordinate location.
70. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry is a RFID tag reader.

## REMARKS

Applicants apologize for the mistake in numbering of the claims. The correction by the Examiner is gratefully acknowledged.

Applicants note that a preliminary amendment was filed on January 15, 2002 in this application, and the return postcard indicated it was received by the Patent and Trademark Office on February 27, 2002. This amendment submitted claims numbered as 72-110, which in view of the objections to the numbering should be 71-109. Thus, given the early date at which the preliminary amendment was filed, there should be claims 1-109 pending in the case instead of merely claims 1-70.

The Office Action has rejected all of the pending claims in the above-referenced application under 35 U.S.C. §§ 102(b) and 103(a). In addition, the Office Action has made a statutory type provisional double patenting rejection of claims 1-31, 33-42, and 45-70 claim the same invention as claims 1-70 of the copending patent application 09/987,597 ("the copending application").

The rejections under 35 U.S.C. §§ 102(b) and 103(a) are based on United States Patent No. 5,480,306 issued to Chih-Yuan Liu ("Liu") either alone or in combination with other United States Patents. These other patents include: U.S. Patent No. 6,111,567 issued to Savchenko et al. ("Savchenko"); U.S. Patent No. 5,958,014 issued to Ellis K. Cave ("Cave"); U.S. Patent No. 6,434,745 issued to Conley et al. ("Conley"); U.S. Patent No. 4,963,719 issued to Brooks et al. ("Brooks"); U.S. Patent No. 5,616,876 issued to Jonathan C. Cluts ("Cluts"); U.S. Patent No. 6,264,106 issued to Raj Bridgelall ("Bridgelall"); U.S. Patent No. 6,324,165 issued to Fan et al. ("Fan"); U.S. Patent No. 5,566,291 issued to Boulton ("Boulton"); U.S. Patent No. 6,195,531 issued to Aguirre ("Aguirre"); U.S. Patent No. 6,359,711 issued to Cole ("Cole"); U.S. Patent No. 5,598,540 issued to Steven D. Krueger ("Krueger"); U.S. Patent No. 6,315,195 issued to Natarajan Ramachandran ("Ramachandran"), U.S. Patent No. 5,869,820 issued to Chen et al. ("Chen"), U.S. Patent No. 6,095,418 issued to Schwartz et al. ("Schwartz"), U.S. Patent No. 4,037,302 issued to Hollander ("Hollander"), U.S. Patent No. 4,654,727 issued to Blum ("Blum") and U.S. Patent No. 5,613,137 issued to Bertram et al. ("Bertram").

Applicants respectfully disagree with the rejections for reasons set forth below. Applicants note that in the course of making the various rejections, the Office Action has also conceded that the cited references do not teach many of the claimed

features, which are discussed further. These missing features render the relied upon combinations of references insufficient, and when evaluated together with the lack of motivation insufficient for making obvious the claimed invention. Therefore, it is respectfully requested that all of the rejections be withdrawn and the application allowed to issue without delay.

## **PROVISIONAL STATUTORY DOUBLE PATENTING REJECTIONS**

The Office Action states that claims 1-31, 33-42, and 45-70 of this application claim the same invention as claims 1-70 of the copending application. Applicants wish to alert the Examiner that a petition has been filed by one of the co-inventors in this case (by inventor Kovesdi on April 21, 2003) claiming co-inventorship in the copending application and requesting relief including change in inventorship in the copending application. An information disclosure statement filed in the copending application on April 21, 2003 also points out that there is insufficient authority to prosecute the copending application due to its failure to name the true inventors.

Applicants have amended independent claim 1 to distinguish it from the invention claimed in the copending application. Pending claim 1 following the entry of the amendment to claim 1 is distinct from the corresponding claim 1 since it no longer requires rendering of content "during" detection of the label and instead recites that the rendering of content is "in response to" the detection of the label. Thus, the rendering is necessarily after the detection of the label. Support for the amendment to claim 1 is found, for instance, in Figure 9. The description corresponding to the illustrative Figure 9 in paragraph 99 of the present application reads "cellular-phone 902 . . . decodes the GPS coordinates [] and sends the coordinates . . . to a remote server platform 918 [, which] . . . transforms the location coordinates into an object identifier, looks up the content associated with the object identifier, and sends back the information . . . to phone handset 902." Thus, even the object identifier is deduced prior to sending back of the information rather than while the label is being detected.

Applicants submit the amended claim 1 and all claims dependent upon it do not claim the invention of the corresponding claim 1 in the copending application, and respectfully request that the provisional double patenting rejection with respect to claim 1 and claims 2-12 dependent upon it be withdrawn.

Applicants have made similar amendments in independent claims 13, 16, 31, 36 and 59, which likewise do not claim the same invention as any of the corresponding claims in the copending application. Accordingly, applicants respectfully request that the provisional double patenting rejection of claims 8, 13-17, 31, 33-37, and 59-63 be withdrawn. In addition, applicants request that the

provisional rejections of the remaining claims be addressed upon allowance of the claims.

Applicants further note that notwithstanding these amendments, the subject matter of the originally filed claims may be pursued by the applicants in subsequent proceedings. In other words, the amendments are without prejudice.

### **OVERCOMING REJECTIONS UNDER 35 U.S.C. 102(B)**

The Office Action has rejected claims 18, 19, 21, 22, 31, 34, 38, 54, and 58 under 35 U.S.C. § 102(b) for allegedly being anticipated by the Liu patent, which was cited by the applicants themselves. Of these rejected claims, claims 18, 31 and 38 are independent. For the sake of economy, Applicants have discussed only the rejections of the independent claims in detail since the limitations present in the independent claims (and missing from the disclosure of Liu) are also necessarily present in their respective dependent claims.

As to claim 18, Liu does not teach the detection of a label 'associated with an object' as is required and instead discloses detection of a label associated with content such as sounds. Not surprisingly, there is no teaching, disclosure or suggestion of using its content rendering identifiers to label objects such as the slides cited by the Office Action. Thus, the subsequent rendering of content bound to the object or an object identifier described in claim 18 is not disclosed or suggested by Liu.

The Office Action suggests that the printing of codes on slides or visible media provides the required object. However, the printed code of Liu in no way labels the object, and is instead only labeling the rendering of content according to Liu itself. Typically, multiple labels would be required for representing arbitrary content, with the number and nature of labels dependent upon the particular content to be rendered rather than the object. Liu does not even suggest that the code is useful for identifying the object it is printed upon. Nor is such a function inherent since the code is by its very design unrelated to the particular object it is printed upon. See figures 2-4 of Liu. Indeed, the distinct recitation of content and object in claim 18 are meaningless in the context of Liu, since Liu only discloses content rendering identifiers rather than object identifiers, and thus teaches away from the claimed invention. This distinction is also noted in the specification of the present application in paragraph 12, which explains that Liu requires defining an assignment between codes and words and sentences (instead of physical objects/locations/events and the like). Therefore, the rejection of claim 18 and claims 19, 21, 22 dependent upon it should be withdrawn.

The reasons set forth above with respect to claim 18 also apply to independent claim 31, which clearly recites "using the database to bind content to the object identifier." There is no such association or database in Liu nor are there any object



identifiers. Therefore, the rejection of claims 31 and 34 (dependent upon claim 31) should be withdrawn.

Claim 38 recites "a plurality of machine readable labels relevant to the physical world" in describing the association between physical objects, locations, and/or temporal events and object identifiers. Clearly, in light of the prior discussion, Liu fails to disclose or suggest such an association. Therefore, the rejection of claim 38 and claims 54, and 58 (dependent upon claim 38) should be withdrawn.

### **OVERCOMING REJECTIONS UNDER 35 U.S.C. 103(a)**

All of the obviousness based rejections rely upon at least the Liu reference, which is already shown to be insufficient to anticipate any of the pending claims. In addition to the limitations discussed previously, the Office Action itself makes the several observations regarding the deficiencies in the prior art in the course of its exhaustive and thorough examination. At least the following features of the claimed invention are also not disclosed according to the Office Action in the various combinations of the references:

1. Liu fails to teach a method for authoring information and a system for authoring the content.
2. Liu, even as modified by Savchenko, still fails to teach content is a link to a live agent.
3. Liu, even as modified by Savchenko, still fails to teach aggregating content into a single entity – the ‘tour.’
4. Liu, even as modified by Savchenko, still fails to teach detecting a second label associated with the first object and normalizing the first and second label such that content bound to the first object can be rendered during (or in response to) detection of either the first or second label in the playback mode.
5. Liu, even as modified by Savchenko, still fails to teach a step of uploading and downloading content to a remote server.
6. Liu, even as modified by Savchenko, still fails to teach that uploading is performed via a wireless network.
7. Liu fails to teach that rendering the content comprises streaming the content from a remote server.
8. Liu, even as modified by Savchenko, fails to teach a remote server
9. Liu, even as modified by Savchenko, still fails to teach that instructions allow a plurality of different label types to be normalized to one object identifier.
10. Liu fails to teach determining current time and comparing current time to the time stamp prior to rendering content.
11. Liu fails to teach accepting annotations/feedback after rendering of the content and binding the annotations/feedback to the object identifier.
12. Liu, even as modified by Boulton, fails to teach storing the annotations/feedback in a remote memory.
13. Liu fails to teach that at least one of the labels is custom created.
14. Liu, even as modified by Savchenko, still fails to teach that the physical world comprises labeled locations containing labeled objects, proximity of which may be determined by the labeled locations.
15. Liu, in combination with Savchenko and Cluts, still fails to teach that the wireless network comprises cellular telephone network.
16. Liu fails to disclose that the apparatus accesses the tour via the Internet and a voice portal.
17. Liu fails to teach accessing the tour via a cellular telephone voice mailbox.
18. Liu fails to teach that digital multimedia is accessible by the apparatus in a sequential order.
19. Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

20. Liu, even as modified by Savchenko, still fails to teach that the circuitry comprises an IR tag reader.
21. Liu, even as modified by Savchenko, still fails to teach a circuitry for determining a coordinate location.

These conclusions of the Office Action are in addition to the demonstration by applicants that Liu does not teach or suggest associating physical objects, events, locations and the like with labels, and instead associates labels with content alone. Since all of the independent claims recite labels associated with an object (rather than content), this additional drawback of Liu is relevant to the rejection of all of the claims. Thus, Liu is wholly unsuitable for rejecting any of the claims. Because this deficiency of Liu is not only not cured by any of the other cited references, it also removes the motivation, if any, for combining the various references with Liu. Such a motivation is required for making and maintaining an obviousness based rejection for each and every one of the eighteen different obviousness based rejections (paragraphs 5 and 7-24) in the Office Action.

As is well established, the motivation to combine should be found within the record and care needs to be exercised to avoid combinations of references that are based on hindsight. The absence of object identifiers in Liu, and in Savchenko is inconsistent with the proffered motivation for generating the various combinations.

For instance, in the context of the pending claim 1, and in light of the prior discussion, Liu does not disclose unambiguous binding of content to an object by the very nature of Liu's disclosure. This is so since it is the content that is labeled in Liu, see, e.g., column 2, lines 25-35, rather than the object. As a result, at best Liu discloses content rendering identifiers at best instead of object identifiers.

Savchenko does not provide the missing object identifiers either. Therefore all rejections based on the combination of at least Liu with Savchenko should be withdrawn. Accordingly, the rejections of claims 1-5, 9, 13, 16, 29, 30, 39-42, 59, 60, 63-64, and 66-67 should be withdrawn.

Similarly, Cave also fails to provide a motivation to combine it with Liu and Savchenko. Therefore the rejection of claims 6 and 23 should be withdrawn.

Since Liu and Savchenko do not disclose object identifiers, there is no motivation to combine them with Conley. Therefore, the rejection of claims 7, 14, 36, 37, 49, and 53 should be withdrawn.

The failure of Liu and Savchenko to use object identifiers makes their combination with Brooks artificial and driven by pure hindsight. Therefore, the rejection of claims 8, 15, 33, and 35 should be withdrawn.

Since neither Liu and Savchenko, alone or in combination, use object identifiers, nor does Cluts provide object identifiers and a motivation to combine them, the rejection of claims 10, 11, 12, 20, 25, 45-47 and 65 should be withdrawn. The failure of Boulton to provide the necessary motivation further requires that the rejection of claims 26-28 be withdrawn. In addition, the teaching of a cellular telephone network by Aguirre is insufficient to provide the required motivation. Therefore, the rejection of claim 48 should also be withdrawn.

Similarly, Bridgelall also is insufficient to provide a motivation to combine it with Liu and/or Savchenko. Therefore, the rejection of claims 17, 62, and 70 should be withdrawn.

The teaching of a timer by Fan is also insufficient to provide the necessary motivation to combine it with Liu. Therefore, the rejection of claim 24 should be withdrawn.

Not only do Liu and Savchenko fail to teach that the physical world comprises labeled locations containing labeled objects, they do not use object identifiers. Therefore, there is no motivation to combine them with Hollander and/or Blum. Therefore, the rejection of claims 43 and 44 should be withdrawn.

Likewise, Cole's teaching of voice mail and Internet fails to provide the motivation to combine it with Liu. Cole is also insufficient to provide the motivation to combine Aguirre with Liu. Thus, the rejection of claims 50-52 should be withdrawn.

The sequential storage of data taught by Krueger is insufficient motivation to combine it with Liu. Therefore, the rejection of claim 55 should be withdrawn. The portable terminal of Ramachandran that reads bar codes is also not sufficient to maintain the rejection of claim 56 and 57.

Chen's teaching of an infrared tag reader is similarly insufficient to provide the motivation to combine it with Liu and/or Savchenko, thus requiring the withdrawal of the rejection of claims 61 and 68.

The touchpad location determining circuitry of Bertram is likewise insufficient to provide the motivation to combine Bertram with Liu and/or Savchenko. Therefore, the rejection of claim 69 should be withdrawn.

There is no motivation to combine Schwartz with Liu since Liu lacks any teaching of object identifiers. Therefore, the rejection of claim 32 should be withdrawn as well.

Taken together, in view of the preceding discussion, all of the obviousness based rejections of claims 1-17, 20, 23-30, 32, 33, 35-37, 39-53, 55-57, and 59-70 under 35 U.S.C. § 103(a) should be withdrawn.

### **MISCELLANEOUS MATTERS**

Applicants note that claims, filed numbered as 72-110, were submitted in a preliminary amendment filed on January 15, 2002, which have not been examined or entered.

Receipt of the January 15, 2002 preliminary amendment by the Patent Office is acknowledged by the PTO stamp on the self addressed postcard, a copy of which is attached. For the Examiner's convenience, applicants are attaching a copy of the preliminary amendment along with proof of its receipt by the PTO. In view of this, it is respectfully requested that the previously submitted claims also be entered and examined and that applicants be given a chance to respond to a first Office Action relating to them. Applicants note that the numbering of the claims needs to be corrected as being 71-109. Applicants will provide a more complete list of the renumbered pending claims upon the entry of the preliminary amendment.

### CONCLUSION

Following the entry of this response and claim amendments herein all of the pending claims 1-109 are placed in form for allowance, although only claims 1-70 have been subject to examination. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No fee is estimated to be required for this submission other than the fee for the accompanying Petition for Extension of Time of three (3) months. Please charge any required fee to Deposit Account No. 16-1150.

Date September 15, 2003

Respectfully submitted,

\_\_\_\_\_  
Ognjan V. Shentov (Reg. No.) 38,051  
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Date September \_\_, 2003

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Rodger L. Tate (Reg. No.) 27,399  
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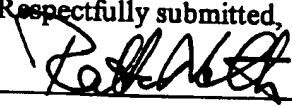
### CONCLUSION

Following the entry of this response and claim amendments herein all of the pending claims 1-109 are placed in form for allowance, although only claims 1-70 have been subject to examination. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No fee is estimated to be required for this submission other than the fee for the accompanying Petition for Extension of Time of three (3) months. Please charge any required fee to Deposit Account No. 16-1150.

Date September 15, 2003

Respectfully submitted,

  
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September 22, 2003

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VIA FACSIMILE AND FED EX

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FILE NO: 63044.5

Rattan Nath  
Pennie & Edmonds LLP  
1155 Avenue of the Americas  
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Re: U.S. Patent Application No. 10/035,952  
Filed: December 26, 2001  
Entitled: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING  
INFORMATION RELEVANT TO A PHYSICAL WORLD  
Your Ref.: 11326-003  
Our Ref.: 63044.5

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Dear Mr. Nath:

We acknowledge receipt today of your facsimile in the evening of September 17, 2003, requesting us to countersign and return your proposed response to the United States Patent & Trademark Office's first Office Action in the above-referenced patent application. As you probably know, our office was closed on Thursday and Friday of last week due to hurricane Isabel. Your letter misstates the nature of our observations about your proposed response. Although we find your technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case, the overall approach of this response is certainly adverse to Mr. Rajasekharan's interests as it continues Ms. Kovesdi's pursuit of claims solely conceived by Mr. Rajasekharan, i.e., renumbered claims 1-42 and 45-70. As you are certainly aware by now, these claims are being pursued in U.S. Patent Application No. 09/987,587, which based on the support provided to us by Mr. Rajasekharan correctly names himself as a sole inventor.

As we discussed via telephone earlier that same day, Mr. Rajasekharan believes that at this late stage there is only one acceptable option that preserves both parties rights in the uncontested jointly conceived subject matter, i.e., submitting our proposed response sent to you on May 21, 2003. The parties can then meet to jointly analyze inventorship claim by claim in view of each side's support for the conception of the claimed invention. You agreed that such a resolution attempt was a good idea. We strongly encourage you to follow this course of action and are concerned that if you proceed to file your response without our signature, as you indicated you were inclined to do, that this will result in the application being held abandoned, which is not our client's intention.

**HUNTON &  
WILLIAMS**

Ratan Nath  
September 22, 2003  
Page 2

We note that due to the United States Patent & Trademark Office's closure this past Thursday and Friday because of Hurricane Isabel, a response filed today will be considered timely in view of the original statutory deadline of September 18, 2003.

Sincerely,



Rodger L. Tate

RLT/TQC

Express Mail No.: EL 564 220 161 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Kovesdi et al.	Confirmation No.:	3522
Serial No.:	10/035,952	Art Unit:	2876
Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	11326-0003-999

**SUPPLEMENTAL RESPONSE UNDER 37 C.F.R. § 1.111**

Commissioner for Patents  
PO BOX 1450  
Alexandria, VA 22313-1450

Sir:

In the above-captioned case, the two representatives of the each of the two inventors are required to sign communications to the US Patent Office in accordance with the decision on Noting Joinder of Inventors (Paper No. 12) dated September 12, 2002. In response to the Office Action mailed March 18, 2003 in the above captioned case on September 18, 2003, applicants filed an amendment ("the substantive September 18 response") that was not countersigned by a representative of inventor Ajit Rajasekharan.

Enclosed in this supplemental response is a communication from Mr. Tate, an attorney for inventor Rajasekharan, confirming that the substantive September 18 response is neither incorrect nor inconsistent with positions taken by inventor Rajasekharan in application No. 09/987,597 (naming only Mr. Rajasekharan as an inventor). The enclosed communication further confirms that Mr. Rajasekharan also does not intend the present application to go abandoned. However, having Mr. Tate countersign the response has continued to be challenge in view of his insistence on canceling 68 out of 70 pending claims of the present application, instead of filing the substantive September 18 response. It is believed that the withholding of formal assent from the admittedly technically correct and consistent response is a violation of the duty to cooperate imposed by the Decision in Paper 12.

The Examiner is respectfully requested to accept the enclosed communication as a substitute assent by inventor Rajasekharan to the filing of the substantive September 18 response. This supplemental response is timely because the US Patent Office was closed from September 18 to 21 due to Federal holidays and a intervening weekend.

Following the entry of the substantive September 18 response, all of the pending claims are placed in form for allowance. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No additional fee is estimated to be required for this supplemental response. Please charge any required fee to Deposit Account No. 16-1150.

Date September 22, 2003



Respectfully submitted,



Rattan Nath (Reg. No. 43,827)  
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Ognjan V. Shentov (Reg. No. 38,051)  
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**Pennie & Edmonds LLP**  
ATTORNEYS-AT-LAW

September 29, 2003

**Via Facsimile and Federal Express**

**(202) 778-2201**

11326-003

Rodger L. Tate  
HUNTON & WILLIAMS  
1900 K Street, N.W., Suite 1200  
Washington, D.C. 20006-1109

Re: United States Patent Application Serial No. 10/035,952  
Filed: December 26, 2001;  
United States Patent Application Serial No. 09/987,597  
Filed: November 15, 2001;  
United States Patent Application Serial No. 10/103,777  
Filed: March 25, 2002; and  
Patent Application, under the Patent Cooperation Treaty,  
Serial No. PCT/US03/08839  
filed March 24, 2003

Dear Mr. Tate:

I was encouraged by our conversation on September 25, 2003 regarding prosecution of claims covering the invention described in, for instance, the above-captioned patent applications. As I indicated to you, in order to address business issues, it is imperative to first acknowledge and include Ms. Kovesdi as a co-inventor. Thus, a preliminary requirement for addressing business matters is the immediate correction of inventorship in all applications with improper inventorship. We are aware of at least three such applications, which are included in the applications captioned above. We expect you to appraise us of any additional applications filed without the requisite authority.

Please provide us with copies of all of the papers in the respective files of these three cases. From your representations we understand that you filed a response in the 09/587,597 application on or before June 27, 2003. We again request that you provide us with a copy of the filed response. We need these documents to adequately protect Ms. Kovesdi's interests. Failure to do so is only going to impede further discussions. 987

Your repeated assertions to me of 'overwhelming evidence' of sole conception and reduction to practice by Mr. Rajasekharan of the invention in substantially all of the filed claims in the 09/987,587 application are in direct conflict with the past statements made by Mr. 19

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WRITER'S DIRECT DIAL:  
(212) 790-6536  
INTERNET ADDRESS:  
NATHR@PENNIE.COM

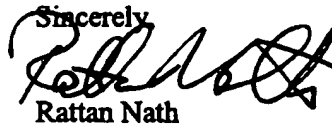
Rodger Tate.  
September 29, 2003  
Page 2

Rajasekharan himself, who, for instance, in an August 31, 2001 message to Ms. Kovesdi declared:

In fact, even with both our contributions to the system and device patent – there have been several instances where I would say some statement which may not have a direct relevance to a claim but it would trigger the right idea in you and vice versa. Most of the claims in our system are the results of such confluences of both our ideas – to me it is a futile exercise to dissect them apart and say who contributed what.  
(Emphasis added)

Thus, as late as August 31, 2001, well after the filing of the underlying common provisional application (60/306,356 filed July 18, 2001), Mr. Rajasekharan was unable to separate his contribution from that of Ms. Kovesdi. Frankly, we are curious as to the nature of this 'overwhelming evidence' provided to you by Mr. Rajasekharan that resulted in 'most of the claims' being distilled to two (2) out of seventy (70) claims in the 10/035,952 application and none (0) out of the seventy (70) claims in the 09/987,597 application. Since you have already reviewed this evidence, we request that you provide it to us without delay to initiate substantive discussions. Failure to do so will be further evidence of your client(s) willfully using Ms. Kovesdi's intellectual property without authorization and over her protests.

As you are well aware, a failure to correctly name inventors with deceptive intent in a patent is not the type of error that is correctable under 35 U.S.C. § 256. Accordingly, it is in the interest of your clients to correct the inventorship without delay. Failure to do so will only result in undermining any patent rights they seek. Even if Ms. Kovesdi so desired, she cannot bestow inventorship on your client(s) for what they actually did not invent. Accordingly, we invite Mr. Ajit V. Rajasekharan and Mr. Jonathan Travis Millman to step up to the plate and do the right thing-- starting with the correction of inventorship.

Sincerely  
  
Rattan Nath

c: Ognjan Shentov, Esq.  
Dr. Trevor Coddington





October 9, 2003

Via Facsimile

(202) 778-2201

11326-003

Rodger L. Tate  
HUNTON & WILLIAMS  
1900 K Street, N.W., Suite 1200  
Washington, D.C. 20006-1109

Re: United States Patent Application Serial No. 10/035,952  
Filed: December 26, 2001;  
United States Patent Application Serial No. 09/987,597  
Filed: November 15, 2001;  
United States Patent Application Serial No. 10/103,777  
Filed: March 25, 2002; and  
Patent Application, under the Patent Cooperation Treaty,  
Serial No. PCT/US03/08839  
filed March 24, 2003  
Patent Application, under the Patent Cooperation Treaty,  
Serial No. PCT/US02/36740  
filed November 15, 2002

Dear Mr. Tate:

This acknowledges receipt of your letter dated September 30, 2003. We learnt of yet another improperly filed patent application, which we have added to the list of cases in dispute. We request that you be forthcoming regarding such unauthorized filings by bringing them to our attention yourself in view of the disputed inventorship.

Per your request, with respect to the claims of the 09/987,597 application, Ms. Kovesdi's consistent position has been that she is at least co-inventor of the originally filed claims. This position is fully supported by Mr. Rajasekharan's admissions in his August 31, 2001 communication to her, a portion of which was cited in our September 29 letter. It is also supported in a number of additional communications between the inventors, including e-mail. In fact, we are not aware of any information suggesting that Ms. Kovesdi's contribution was limited to the subject matter of specific claims.

Accordingly, should there be any dispute concerning the inventorship of the originally filed claims in the '597 application, it may only be based on information in your possession. We understand that the documentation that supports your position has already been provided by Mr.

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Rodger Tate, Esq.  
October 9, 2003  
Page 2

Rajasekharan. As you characterized on the phone this supporting evidence as "overwhelming" we expect that it should not present a problem for you to share it with us, as promised in your letter of September 30, 2003. In addition, to save cost, we ask that you send us the (publicly available) information on the pending application.

We are looking forward to your factually substantiated response.


Sincerely,  
  
Rattan Nath

P.S. I enclose a copy of your letter to us that was filed with the PTO with the supplemental response, and was inadvertently omitted in our communication to you.

c: Rozsa Kovesdi,  
Ognjan Shentov, Esq.

# JP813214

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 05-19-04 02:26





HUNTON & WILLIAMS LLP  
1900 K STREET, N.W.  
WASHINGTON, D.C. 20006-1109

TEL 202 • 955 • 1500  
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RODGER L. TATE  
DIRECT DIAL: 202-419-2069  
EMAIL: rtate@hunton.com

FILE NO: 63044.000081

November 13, 2003

Rattan Nath  
Pennie & Edmonds LLP  
1155 Avenue of the Americas  
New York, N.Y. 10036-2711

Dear Rattan:

As I indicated in my email on Tuesday, I am sending you some key parts of the documentation relating to inventorship of the inventions disclosed and claimed in our sole case (U.S. Serial No. 09/987,597). Please treat this letter and attachments as **CONFIDENTIAL** Information, which can be shared with Rozi, but not with any other third party without written permission from Ajit.

The context, explanation, and support for our position on inventorship is as follows:

- (1) In late February or early March 2001, Ajit thought of the concept of an educational toy/learning aid that employed tagging physical world objects with object-associated audio content and the use of coincident authoring of this content. Bar coding was one tagging mechanism he thought of about at this time. The genesis of these ideas was his son Rahul's curiosity and the desire to teach him the names of household objects. On March 10<sup>th</sup> Ajit bought a book at Borders that had content playback capability while researching his Rahul-inspired idea. (Credit card receipt - (Appendix 1)).
- (2) Around March 10-12, 2001, Ajit told Rozi about his idea in a phone conversation. She replied in email of March 12, 2001, that she thought the idea was novel and should be patented (Appendix 2). In an email on March 14, 2001, Rozi stated "...you should be proud. Your idea is valued at 500 million dollars!!!" (Appendix 3).
- (3) Ajit and Rozi had been discussing a completely different technology prior to March 10-12, 2001. This involved the implementation of a triangulation technique into a PDA.
- (4) In an email transmission on March 16, 2001 (Appendix 4), Ajit sent Rozi a write up (BarCode-Possibilities1.doc) of the Rahul-inspired idea that he had

Rattan Nath  
November 13, 2003  
Page 2

described to Rozi. (Appendix 5). This document authored by Ajit contains a clear and unequivocal description of the core concepts and attributes their origin to Rahul's inspiration. (See page 3, paragraph 6). While this document contains some thoughts from Rozi (including her research into related background technologies and some possible applications not claimed - e.g., tagging headstones in cemeteries), the core concepts described by Ajit are based on his Rahul-inspired idea.

- (5) Ajit is not a lawyer and his comments in the "XYZAssetsApportioning" document (sent to Rozi on August 31, 2001) do not represent legal admissions of joint inventorship. To put these comments in context you need to understand the following:
- At the time, Ajit was attempting to bring Travis Millman into the business venture that he and Rozi were contemplating.
  - Ajit had suggested that Travis might be included on a patent under consideration because he had thought of a device configuration ("form factor").
  - In response to the possibility of adding Travis, Rozi's brother, Imi, had lectured Ajit on legal consequences of being joint inventors - i.e., that (absent agreement to the contrary) a joint inventor of even one claim was a joint owner "in equal measure" of the patent.
  - Ajit saw the possibility of poor chemistry between Travis and Rozi breaking up the prospective company. He drafted the "XYZAssetsApportioning" document with the express purpose of trying to hold the group together by proposing concessions on ownership of equity, patent ownership and inventorship. We subsequently advised Ajit that the facts of "who did what" rather than statements of desired outcomes, proposed as conciliatory concessions, should be determinative of inventorship.
- (6) An objective review of the facts as evidenced by his recollections and records led Ajit to the position that only a few claims of the original provisional were jointly conceived with Rozi.
- (7) After filing the sole U.S. regular patent application claiming priority to the provisional we sent Rozi's attorney information on December 4, 2001, and

**HUNTON &  
WILLIAMS**

Rattan Nath  
November 13, 2003  
Page 3

suggested that a discussion/resolution of all issues was appropriate (Appendix 6). Our efforts were not successful in getting the parties to talk.

Sincerely,

*Luan Colding*, Patent Agent  
for Rodger L. Tate

RLT:mia  
Enclosures

**citi**

• • • • •

indoors

## APPENDIX 2

Subject: indoors

Date: Mon, 12 Mar 2001 07:43:52 -0500

From: Rouse Kovesdi <rkovesdi@erols.com>

To: Ajit Rajasekharan <ajit@home.com>

we have to patent the barcode scanning idea

buy the exclusive rights to display content on wireless devices **INSIDE**  
top  
NYC tourist attractions, or any other cities top attractions

Metropolitan Museum  
Rose Planetary,  
Empire State Building  
Statue of Liberty,  
Circle Line  
Intrepid  
Guggenheim, etc

in addition to the textual Guide, there could be pay-per-view video  
streaming  
(allowing to download content, 'ePostcard', eExhibition Catalog, can be  
another source of revenue)  
- mobile multimedia / video tours of an exhibition

e-commerce revenue opportunity  
'click here to buy a reproduction of this painting'

Rosi



Re: Indors

Or we can try to write up something separately and compare notes

BTW

Scott (the guy you met at the interview) was asking about you  
He really liked you.

Rosi

- >
- >
- > Ajit
- >
- > Rosza Kovesdi wrote:
- >
- > > we have to patent the barcode scanning idea
- > >
- > > buy the exclusive rights to display content on wireless devices INSIDE
- > > top
- > > NYC tourist attractions, or any other cities top attractions
- > >
- > > Metropolitan Museum
- > > Rose Planetarium,
- > > Empire State Building
- > > Statue of Liberty,
- > > Circle Line
- > > Intrepid
- > > Guggenheim, etc
- > >
- > > in addition to the textual Guide, there could be pay-per-view video
- > > streaming
- > > (allowing to download content, 'ePostcard', exhibition Catalog, can be
- > > another source of revenue)
- > > - mobile multimedia / video tours of an exhibition
- > >
- > > e-commerce revenue opportunity
- > > 'click here to buy a reproduction of this painting'
- > >
- > > Rosi

Re: indoors

Subject: Re: indoors

Date: Mon, 12 Mar 2001 23:30:33 -0500

From: Rozsa Kovesdi <rkovesdi@erols.com>

To: Ajit Rajasekharan <ajits@home.com>

Ajit Rajasekharan wrote:

> Can we patent it? That will be neat if we can.

i think it is a novel use of the barcode  
Have to write it up and ask a patent attorney

I've been thinking today -  
in the museum we need to ask people to label paintings.  
However we could start at places where the barcode is already in place  
such as supermarkets and department stores  
What do you think?

Symbol is very much pushing the scanner  
I've read it today, they are installing wireless networks in K-Mart stores

Maybe Bluetooth is more suitable than 802.11?  
Bluetooth has less power consumption than 802.11  
it is cheaper and smaller

Ericsson is doing Bluetooth for retail shops  
It can read from 10 m distance  
But the normal barcode in use today is optical

The most ubiquitous device is Palm  
So the winner is Palm with Bluetooth???

> Also how does one buy the  
> exclusive rights for content display inside top tourist attractions?

I thought it should be possible  
Everything is for sale.  
This is what Vindigo did, bought content  
Also, this is what Audible did  
First we need financing  
Buying content right would make it harder a competitor to enter?

what do you think about Vindigo?  
Have you looked at it?  
<http://www.vindigo.com>

it is almost identical to your idea  
and they are doing very well  
One needs to download the file at home, exactly as you envisioned it  
I was surprised that they can fit whole NYC on the Palm  
Conor uses the service and loves it  
Otherwise Conor is not interested in joining us  
It is not his area  
Vindigo is in Manhattan  
They are hiring (according to their web site)  
Want to apply just for the fun of it?

you are right - we need to work on this  
It would be an interesting exercise to try to write a business plan  
We could meet tomorrow after work - although this is a short notice

there is still space to do things

**Subject:** there is still space to do things  
**Date:** Wed, 14 Mar 2001 21:16:21 -0500  
**From:** Rozsa Kovcsdi <rkovcsdi@erols.com>  
**To:** Ajit Rajasekharan <ajits@home.com>

### **APPENDIX 3**

Hi Ajit:

I completely agree with you  
Yesterday I was a bit down after seeing Barpoint

But now seeing AirClic, you should feel proud  
Your idea is valued at \$500 million dollars!!!

Actually it is interesting that AirClic did not get the price comparison  
idea  
That part BarPoint did better

I had the exact same idea as you, that one can develop apps riding on  
this momentum for AirClic  
However I would be cautious with them -  
it seems to me they want to use people work for free

it sounds they are telling:  
i.e. just send me your ideas, I will take care of them

I've been looking for devices to buy for a demo

The Symbol CS 1504 Consumer Memory scanner has USB port and maybe can  
connect to a PDA?

Also, the Socket Communications products are good looking

A killer product would be a low-cost wireless (802.11 or CDPD) +  
scanner + PDA (Visor?) combo  
The same as Symbol has, but much cheaper  
SPT 1700 functionality

Maybe one could get some of that 200+ million dollars from AirClic to  
bring to market such a product.

There are many web sites that provide price comparison  
mySimon, etc to connect to

Rozsi

Notes of all our discussions

Subject: Notes of all our discussions

APPENDIX 4


Date: Fri, 16 Mar 2001 01:36:51 -0500

From: Ajit Rajasaktharan <ajits@home.com>

To: "rkovesdi@erols.com" <rkovesdi@erols.com>

I wrote down all discussions so far I could remember. Please add/make any modifications. I did not write down the one we discussed this morning (the neat franchise scheme, please add it).

good night  
Ajit

 BarCode-Possibilities.doc	Name: BarCode-Possibilities.doc Type: WINWORD File (application/msword) Encoding: base64
---	--

## **APPENDIX 5**

### **Barcode – compilation of our thoughts**

#### **Background**

Just like hyperlinks enable linking objects to information in the web world, barcodes enables one to unambiguously reference an object in the physical world and perform a wide range of actions. Since its very beginning (apparently on Wrigley chewing gum in the 1970s) barcode usage has been confined to the retail world – not directly in the hands of the consumer itself. With the growing number of bar code scanning devices that work with PDAs ( e.g. HandSpring Visor slot [http://www.symbol.com/products/barcode\\_scanners/barcode\\_scanners.html](http://www.symbol.com/products/barcode_scanners/barcode_scanners.html) , CF card scanner for CE devices from socketcomm <http://www.socketcomm.com/> ), scanning objects and accessing related information is now possible by a customer. If one imagines barcodes as the equivalent of web hyperlinks the potential is immense. It is as though one can walk around and just beam just about any barcoded object and perform a wide range of actions. The confluence of wireless technology and the emergence of scanning devices for consumer use opens a world of opportunities that may be the biggest innovation wave following the internet wave – the difference only being that the physical world is being hyperlinked in this case as opposed to the virtual world. This could very well be the last big wave for a while to come from a technology influence standpoint (of course the biological front is a whole another story!)

#### **Technology background**

##### **The usage sequence**

The process is very simple – one scans a barcode embedded on an object. The barcode is decoded by the scanner PDA into a string of number/characters. This string is used to index the object information. The indexing could be done locally on the PDA or a connection could be made to a web server. For devices that do not have web connectivity, the indexing could be done locally on the PDA or the barcodes could be synced up with a PC to subsequently access information (though this form of access may not be of much use to the applications we are interested in).

##### **Barcode types**

For a quick tutorial please go to [http://www.symbol.com/ade/barcodes\\_form.html](http://www.symbol.com/ade/barcodes_form.html) , fill out the form and access online barcode tutorial) – there are several standards of barcodes, the most popular ones being EAN/UPC (for all retail products), Code 39/128 etc. A new form of barcode called scanlets(trademarked by airclik, <http://www.airclik.com/> ) may be of particular interest to the application opportunities listed below, primarily because of the size of the barcode – they are very small in size and can be placed on any surface.

### **Scanning devices**

A variety of them exist. Of interest to us are small PDA add-on devices that can both scan and/or connect to the web (current PDAs cannot do this due to the mutually exclusive use of CF slots. Symbol has a device that does both - it has scanning and LAN support (Spectrum 24 - a version of 802.11b). Cellphones may be able to do this naturally, airclic is working with cellphones to enable scanning of barcodes).

### **Barcode indexed server databases.**

Companies like <http://barcode.com/> attempts to do the barcode-to-product lookup and give user information such as price comparisons etc. There is also a company called <http://www.connectitings.com/>, an off-shoot of Erricson that has a barcode product lookup. An interesting usage of this is to lookup Cullen Dion using a barcode value. This company was recently acquired by <http://www.airclic.com/>

### **A Sample space of companies working in the barcode space**

Companies such as <http://www.airclic.com/> attempt to make money buy leasing scanlets (their term for small barcodes that can be used on any surface and where space is constrained), buy having some click-thru revenues, and by providing an application development platform (not sure if the last one is a revenue source or is free). They just received \$290 million in additional funding on Jan 22. Also lured some top execs from Amex.

A growing list of thers in this arena:

<http://barcode.com/> - not sure where they make money from.

<http://unibarcodes.com/> - this company provides middleware solution for large-scale retailers among other services.

[TBD: Add more]

### **Segmenting companies in the barcode usage space**

- 1) Device manufacturers- clearly not out our forte, however patents for device concepts may help us gain leverage.
- 2) Client/authoring applications
- 3) Web site services - barcode databases, e-commerce services (price comp etc)
- 4) Vertical service solutions spanning all four.
- 5) Any more?[TBD]

### **Opportunities we can pursue.**

These are just evolving ideas. We need to look at what makes sense to pursue, or use them just as a sounding board for better ideas.

### **Concept 1) Educational purpose - object scanning "toy" and software**

A rugged yet cutely designed toy which is nothing but a purpose-built device with capabilities for scanning, audio playback and with an optional display. It has PC connectivity (USB) or alternatively has a card (CF card?) for storage. No internet connectivity.

#### **Involves**

(1) new hardware (could it be patented?), (2) software for audio, tag association.

#### **Background.**

There are toy books available now that do the following:-

A story is interleaved with a fixed number of graphics. On the side of the book these graphics are listed in the form of buttons. So when a child comes across a graphic while reading the book, he tends to press the corresponding graphic button on the side, which then emanates a sound. Not very smart - but these books are very popular.

Now in our idea, the website for which we would like to christen as talkingtreasures (we grabbed the domain too!), we take this concept to a totally new dimension.

#### **Content creator**

Let us start with books - any book that is purchased can be augmented by a separate "annotation package" that can be bought separately or custom created separately (we shall explain the latter soon). This annotation package could be audio or text.

Rahul spawned another use of this device. He likes to press buttons to see state change (bulb going off and on, audio starting playing in his toy book). This toy could be used to help children learn the names of objects. If all objects of interest in the house is tagged, this could be a valuable tool for them to learn names of objects. Just like identifying a switch (he actually goes after small specks of dust too showing acute sense of vision in children), they will quickly learn to identify the small "scanlets" and zap them to get audio output. Now a parent can choose to get a package of "sounds with associated audio" or alternatively create one themselves using a simple application we build. All this application does is to assist them in binding "scanlets" with audio snippets, which can be subsequently downloaded to the device. The scanlets are printed on their home printer on post-it style labels (probably available in OfficeMax) The audio-barcode linking file could be a simple XML file.

#### **Usage scenario**

Scan any tag on objects and get audio/text feedback stored locally on device.

## **Concept 2) Antique and art show guides**

### **Involves**

PDA and our software (same as in Concept 1). Does not involve any custom hardware, just existing scanning devices with audio/text capability.

If the device does not support wireless connectivity, user would need to download content before visiting the art/antique show.

### **Background.**

When one goes to these arts or exhibition centers there is a dearth of information when you need it. One way is to have a human guide. In our scheme we can eliminate this person and get authentic information.

### **Content creator.**

Uses software used in Concept 1 to create association between scanlet and audio/text. The content may be posted on a site for download.

User may choose to access this content using PC connectivity or by wireless connection. On the site, when user scans a tag, he gets information related to that tag. If there is online connectivity then purchase, price comparisons etc. may be options. We may not have to build this. There would be browsers that do this.

So a user can scan the tagged leg of an antique chair, gets some feedback, scan the top to get some other feedback.

If there is online connectivity, then signing the guestbook in an arts center could be done the same way.

### **Usage scenario**

Scan any tag on objects and get audio/text feedback stored locally on device or from a remote website if device supports wireless connectivity.



## APPENDIX 6

December 4, 2001

Brobeck, Phleger & Harrison LLP  
1333 H Street N.W.  
Suite 800  
Washington, D.C. 20005  
DIRECT 202.220.5225  
FAX 202.220.5200  
rtate@brobeck.com  
www.brobeck.com

### VIA U.S. MAIL

Mark R. Galis, Esq.  
Altheimer & Gray  
10 South Wacker Drive  
Suite 4000  
Chicago, IL 60606-7482

COPY

Re: Potential Intellectual Property Dispute  
Between Rozsa Kovedi and Ajit Rajasekharan

Dear Mr. Galis:

As you may know, we are now representing Mr. Ajit Rajasekharan in the above-referenced matter. We are writing to inform you of our recent action and our response to the proposal advanced in your email of October 8, 2001, on behalf of Ms. Rozsa Kovedi.

We recently filed a U.S. Patent Application claiming priority to U.S. Provisional Application No. 60/306,356 ("Provisional Application"). This Provisional Application was filed on July 18, 2001, and named Mr. Rajasekharan and Ms. Kovedi as inventors. Mr. Rajasekharan is designated as the sole inventor on the new utility application because this application only discloses and claims the concept(s) conceived by him. The basis for sole inventorship is well substantiated by the chronology of events and documented communications between Ms. Kovedi and Mr. Rajasekharan prior to the filing of the Provisional Application. Material appearing in the Provisional Application, which allegedly was conceived by Ms. Kovedi, is not disclosed nor claimed in the new utility application.

Please be advised that should Ms. Kovedi file a utility application directed to the subject matter of the Provisional Application with joint-inventorship declared, Mr. Rajasekharan intends to move to formally join in the prosecution of the converted application under the provisions of MPEP § 402.10. In the event that Mr. Rajasekharan's inventive subject matter is claimed and Ms. Kovedi is declared as the sole inventor, an interference proceeding will be initiated under 35 U.S.C. §102(g) between the two conflicting utility applications. In this regard, please advise what if any action Ms. Kovedi has taken with respect to the Provisional Application, and provide us with a copy of any application that she has filed containing subject matter disclosed in the Provisional Application or otherwise relating to Mr. Rajasekharan's inventions.

Mark R. Galia, Esq.  
May 29, 2002  
Page 2

**Brobeck**  
ATTORNEYS AT LAW

In response to your communication to Mr. Rajasekharan, your proposed resolution granting Ms. Kovesdi a royalty percentage and certain exclusive rights to practice Mr. Rajasekharan's invention is hereby rejected in full. Your client's proposal is flatly inconsistent with Mr. Rajasekharan's rights in and to the inventions and reflects, in our client's view, a mistaken assessment of Ms. Kovesdi's role in the conception of the inventions.

We are interested in resolving this matter amicably to the extent possible and will consider a reasonable proposal for such resolution. We remain available to discuss this matter with you and your client.

This letter contains only a partial description of the claims that may be raised by Mr. Rajasekharan with respect to the subject matter hereof and Mr. Rajasekharan reserves all rights and remedies available to him in connection with this matter. No statement in this letter shall be considered an admission of any fact in controversy.

Very truly yours,


/s/


Rodger L. Tate

RLT/TQC

JP813214

# JP813214

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 05-19-04 02:27



# JONES DAY

222 EAST 41ST STREET • NEW YORK, NEW YORK 10017-6702  
TELEPHONE: 212-326-3939 • FACSIMILE: 212-755-7306

January 6, 2004

**Via Federal Express**

**(202) 778-2201**

11326-003

Rodger L. Tate  
HUNTON & WILLIAMS  
1900 K Street, N.W., Suite 1200  
Washington, D.C. 20006-1109

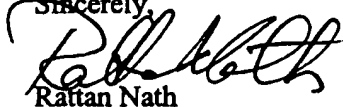
WRITER'S DIRECT DIAL:  
(212) 790-6536  
INTERNET ADDRESS:  
NATHR@PENNIE.COM

Re: United States Patent Application Serial No. 10/035,952  
Filed: December 26, 2001  
For: SYSTEM AND METHOD FOR AUTHORIZING  
AND PROVIDING INFORMATION RELEVANT  
TO A PHYSICAL WORLD  
By: Kovesdi et al.

Dear Mr. Tate:

Enclosed is a copy of a response to the Office Action dated December 16, 2003 along with a copy of the Office Action itself in the above mentioned application. Having had the opportunity to review the substantially identical response sent to you on September 14, 2003, this response should not raise any new issues. Therefore, please sign, date and return the enclosed response to us for filing with the Patent and Trademark Office without delay. Should you have any specific questions or suggestions, please do not hesitate in timely contacting us.

In the event you decide to not sign this response, for instance, on the grounds forwarded previously, please let us know before the January 16, 2004 due date.

Sincerely,  
  
Rattan Nath  
(Awaiting admission in NY)

Enclosure

c: Ognjan Shentov, Esq.

**Rattan Nath**

---

**From:** Rattan Nath  
**Sent:** Thursday, January 15, 2004 11:35 AM  
**To:** 'Tate, Rodger'  
**Cc:** Ognjan Shentov  
**Subject:** RE: Signature on the Response to the Office Action  
**Importance:** High

Dear Mr. Tate:

You are the one who is missing the point. It is your duty to allow this application to be prosecuted properly so that, if necessary, an interference proceeding rather than interference from you decides the inventorship. Despite ample opportunities, you have been unable to come with any evidence to show that Ajit is properly named as a sole inventor. As you well know, merely repeating that your evidence is 'overwhelming' is insufficient as a matter of law to prove inventorship. It may, however, provide evidence of lack of good faith in addressing the underlying issues.

Therefore, as to inventorship, leave it for the PTO to decide. There is no business meeting in the works either. Unless you are angling to cut out the PTO from adjudicating the matter, send me the executed response without delay for filing no later than tomorrow. Any delay at this juncture is just another breach of the duty of good faith.

Regards,

Rattan

-----Original Message-----

**From:** Tate, Rodger [mailto:rtate@hunton.com]  
**Sent:** Thursday, January 15, 2004 10:15 AM  
**To:** Rattan Nath  
**Cc:** Coddington, Trevor  
**Subject:** RE: Signature on the Response to the Office Action

Dear Rattan,

You seem to have missed the point I was trying to make in our telephone conversation the other day. We have always stated that we believe the record and the facts as communicated to us by our client lead to the conclusion that Rozi and Ajit were the joint inventors of a few of the claims in your case, but not the rest. Those claims that we believe are the sole invention of Ajit are pending in our sole case. Until we hear from Rozi what the basis for her assertion that she is a joint inventor on more of the claims, we cannot in good faith pursue claims in the joint case that we do not believe are jointly invented. Our call for a meeting with Rozi is primarily about resolving this issue. I have stated, and believe that while we are at the table, all other issues between the parties should be resolved. We are not refusing to cooperate in prosecuting the joint case, we are merely seeking your assistance in understanding the facts your client believes support her view before we file the next response. We suggested this meeting months ago and your client refused then and continues to refuse. Your continued demands that we accept your position without providing us the basis for it, does nothing to advance your client's interests.

If you do not wish to take an extension of time to permit such a meeting, you can choose to let the case go abandoned. Those three claims that we seem to agree were jointly invented may be lost by this action, but the remaining claims are pending in our sole case.

1/15/2004

Please advise if based on the foregoing clarification of our position, Rozi is willing to meet to provide us with the basis for her position.

-----Original Message-----

**From:** Rattan Nath [mailto:rnath@Jonesday.com]

**Sent:** Wednesday, January 14, 2004 10:16 AM

**To:** Tate, Rodger

**Cc:** Ognjan Shentov

**Subject:** Signature on the Response to the Office Action

**Importance:** High

Dear Mr. Tate:

Thank you for the discussion yesterday regarding the filing of the response in the US patent application No. 10/035,952. As promised, I spoke to Ms. Kovesdi and let her know that you were linking the signature on the proposed response to a meeting with her to address some business issues unrelated to the prosecution of the application. I also let her know that in the absence of such a meeting being scheduled, you were not going to sign the response in time for it to be filed with the PTO by the due date of January 16, 2004.

At this point, any such meeting has been ruled out. Thus, there is no reason to withhold the signature in the hope for such a meeting any time soon.

Accordingly, please sign the proposed response and send at least the signature page back to me via facsimile (facsimile # 212-699-0338) in time for filing it with the PTO on January 16, 2004. Please also send the originals by mail separately.

Thank you for the tip on the adverse PTO ruling on our petition for correcting the defective inventorship in the case filed by Ajit. Please send us a copy of the file (all of the public papers) for the case filed by Ajit (Serial No. 09/987,597). We have requested these non-confidential documents previously as well without getting a response. Hopefully, this time we will see more cooperation.


If you have any questions, please do not hesitate in contacting us.

Regards,

Rattan

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Paper No. 8

TREVOR CODDINGTON  
HUNTON & WILLIAMS  
1900 K STREET NW  
WASHINGTON, DC 20006-1109

**COPY MAILED**

**JAN 12 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Rajasekharan , : LETTER  
Application No. 09/987,597 :  
Filed: November 15, 2001 :  
Atty. Dkt. No.: 033393.0003 :

This letter is in response to the petitions filed April 21, 2003 under 37 CFR 1.182 and 37 CFR 1.48.

The petitions will not be treated on the merits as petitioner has failed to establish that he is a proper party in interest, i.e., inventor or assignee.

The inventorship of the instant application was set forth in a properly executed oath or declaration signed by the inventor(s) of record pursuant to 35 USC 115, 35 USC 116, and 37 CFR 1.63. Accordingly, any change in inventorship must be requested by the inventor(s) named in the first executed oath or declaration pursuant to 37 CFR 1.48, and, if applicable, an assignee pursuant to 37 CFR 3.73(b).

As there is no indication in Office records that petitioner herein was ever empowered to represent the instant application, the requested change of power of attorney and correspondence address will not be entered into the record.

Petitioner is entitled to a refund of the previously submitted petition fees totaling \$260.00. A refund may be requested by writing to the Finance Office, Refund Section. A copy of this letter should accompany any request for refund.

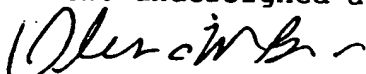
This application is being returned to the appropriate Technology Center for further processing.



Application No. 09/987,597

2



Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.

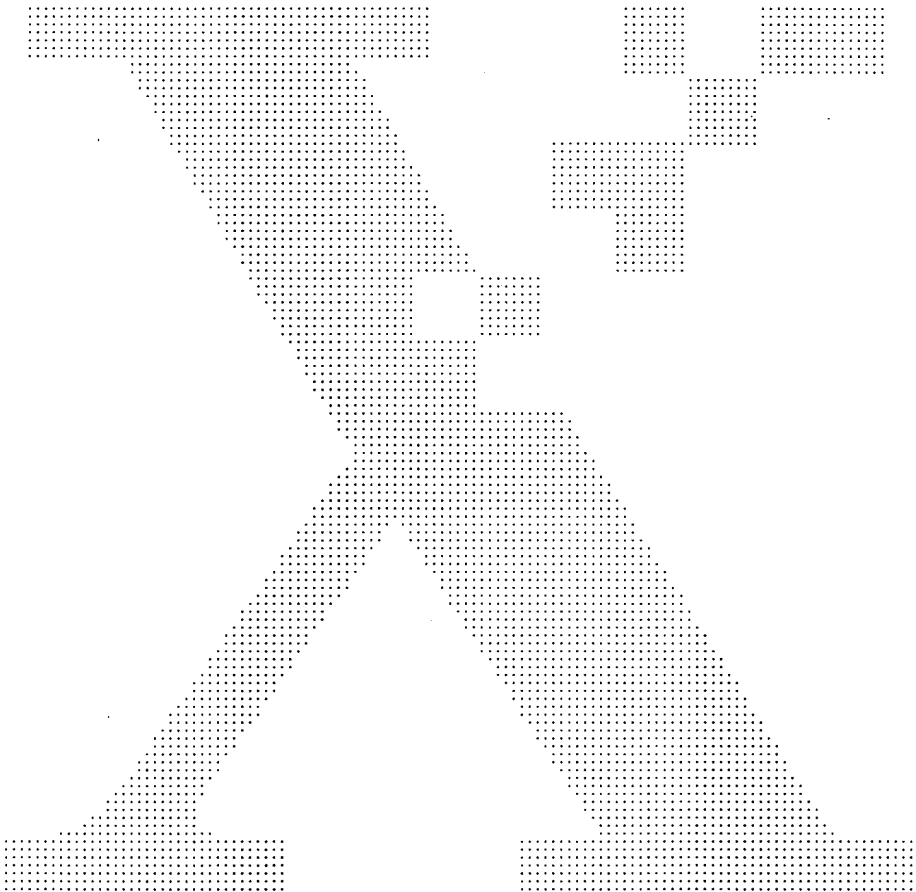


Alesia M. Brown  
Senior Petitions Attorney  
Office of Petitions

CC: ROZSA KOVESDI  
70 DERBY COURT  
MADISON, NJ 07940

# JP813214

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:	)
Ajit RAJASEKHARAN	)
Application Number: 09/987,597	) Group Art Unit: 2876
Filed: November 15, 2001	) Examiner Kumiko C. KOYAMA
For: SYSTEM AND METHOD FOR	) Confirmation No. 7385
AUTHORING AND PROVIDING	)
INFORMATION RELEVANT TO A	)
PHYSICAL WORLD	)

RECEIVED  
JUN 12 2003  
TECHNOLOGY CENTER 2800

REPLY TO NON-FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.111

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed on March 27, 2003, Applicant respectfully requests entry of the following amendments and reconsideration of all rejections in view of these amendments and the following remarks.

Please enter the claim amendments as provided on the following pages and in the simplified amendment format as set forth by the Deputy Commissioner. See Pre-OG Notice, January 31, 2003 (discussing the PTO's proposed revision to and waiver of current 37 C.F.R. § 1.121). No new matter has been added by these amendments as they are fully supported by the original claims.

*Claims 43-45 and 47-50 are amended as follows.*

*Claims 1-42, 46, and 51-70 remain unchanged.*

*No claims are cancelled.*

*Claims 1-70 are currently pending.*

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JUN 16 2003  
OFFICE OF PETITIONS

**AMENDMENTS TO THE CLAIMS:**

1. (Original) A method for authoring information relevant to a physical world, comprising: detecting with an authoring device a first label associated with a first object; and triggering, in response to detecting, a system for authoring content; wherein the content is to be unambiguously bound to the first object and is to be rendered on a playback device during detection of the first label.
2. (Original) The method as recited in claim 1, wherein the system for authoring content is resident on the authoring device.
3. (Original) The method as recited in claim 1, wherein the authoring device and the playback device are integrated within a single apparatus.
4. (Original) The method as recited in claim 1, wherein the label is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, a text string, and any other label type whose information can be transformed to digital data by some transduction means.
5. (Original) The method as recited in claim 1, wherein the content is selected from a group consisting of audio, text, graphics, video, or a combination thereof.
6. (Original) The method as recited in claim 1, wherein the content is a link to a live agent.
7. (Original) The method as recited in claim 1, further comprising the steps of detecting a second label associated with a second object; triggering, in response to detecting, the system for authoring content which is unambiguously bound to the second object; and aggregating the content bound to the first object and the second object into a single logical entity called a tour.

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**JUN 16 2003**

8. (Original) The method as recited in claim 1, further comprising the step of detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can be rendered during detection of either the first or second label in the playback mode.

9. (Original) The method as recited in claim 1, further comprising the step of storing the content in non-volatile memory resident in the apparatus.

10. (Original) The method as recited in claim 1, further comprising the step of uploading the content to a remote server.

11. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wireless network.

12. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wired network.

13. (Original) A computer-readable media having instructions for authoring information relevant to a physical world, the instructions performing steps comprising: detecting a first label associated with a first object; and triggering, in response to detecting, a system for authoring content to be unambiguously bound to the first object; wherein the content is to be rendered during detection of the first label by a device in a playback mode.

14. (Original) The computer-readable media as recited in claim 13, wherein the instructions perform the further steps of detecting a second label associated with a second object; triggering, in response to detecting, a system for authoring content to be unambiguously bound to the second object; and aggregating the content bound to the first object and the second object into a single logical entity called a tour.

15. (Original) The computer-readable media as recited in claim 14, wherein the instructions perform the further step of detecting a second label associated with the first object

and normalizing the first label and the second label such that the content can be rendered during detection of either the first or second label by the device in the playback mode.

16. (Original) A computer-readable media having instructions for authoring content to be associated with objects in a physical world, the instructions performing steps comprising: normalizing a read object label associated with an object into an object identifier; placing the object identifier into an index table repository; accepting content to be rendered when the object label is read in a playback mode; and binding the content to the object identifier in the index table repository.

17. (Original) The computer-readable media as recited in claim 16, wherein the instructions allow a plurality of different label types to be normalized to one object identifier.

18. (Original) A method for providing information relevant to a physical world, comprising: detecting with a device a label associated with an object; normalizing information contained in the detected label into an object identifier; using the object identifier to search an index table repository to find content bound to the object identifier; and rendering the content.

19. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from local memory in the apparatus.

20. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from a remote server.

21. (Original) The method as recited in claim 18, wherein the content is selected from a group consisting of audio, text, graphics, and video.

22. (Original) The method as recited in claim 18, wherein the label is selected from a group consisting of a barcode, a coordinate, an IR tag, a RFID tag, a timestamp, a text string, and any other label type whose information can be transformed to digital data by some transduction means.

23. (Original) The method as recited in claim 18, wherein the content is a connection to a live agent.
24. (Original) The method as recited in claim 18, further comprising the step of determining the current time and comparing the current time to the timestamp before rendering the content.
25. (Original) The method as recited in claim 18, wherein the step of rendering the content comprises streaming the content from a remote server.
26. (Original) The method as recited in claim 18, further comprising the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.
27. (Original) The method as recited in claim 26, further comprising the step of storing the annotation/feedback in local memory.
28. (Original) The method as recited in claim 26, further comprising the step of storing the annotations/feedback in a remote memory.
29. (Original) A computer-readable media having instructions for providing information relevant to a physical world, the instructions performing steps comprising: detecting a label associated with an object; normalizing information contained in the detected label into an object identifier; using the object identifier to search an index table repository to find content bound to the object identifier; and rendering the content.
30. (Original) The computer-readable media as recited in claim 29, wherein the content is selected from a group consisting of audio, text, graphics, and video.
31. (Original) A method for providing information relevant to a physical world, comprising: storing an object identifier indicative of a plurality of read labels associated with an

object into an index table repository; and using the index table repository to bind content to the object identifier and, accordingly, the object; whereby the content is renderable when any one of the plurality of labels is detected in a playback mode.

32. (Original) The method as recited in claim 31, wherein at least one of the plurality of labels is already present on the object.

33. (Original) The method as recited in claim 31, further comprising the step of attaching at least one of the plurality of labels to the object.

34. (Original) The method as recited in claim 31, wherein the plurality of labels is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, a text string, or any other label type whose information that can be transformed to digital data by some transduction means.

35. (Original) The method as recited in claim 31, further comprising the steps of detecting the plurality of labels.

36. (Original) A method for providing information relevant to a physical world, comprising: associating one or more labels with each of a plurality of objects in a tour; storing an object identifier indicative of the one or more labels associated with each of the plurality of objects in the tour in an index table repository; authoring content relevant to each of the plurality of objects in the tour; and binding the content to an object identifier in the index table repository which corresponds to the relevant one of the plurality of objects in the tour whereby the content is renderable when the label is detected by a playback device without regard to the order in which the content was authored.

37. (Original) The method as recited in claim 36, wherein the labels are selected from a group consisting of coordinates, barcode labels, RFID tags, IR tags, timestamps, text strings, and any label type whose information that can be transformed to digital data by some transduction means.



38. (Original) A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising: a plurality of machine readable labels relevant to the physical world; an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and a digital multimedia content collection accessible by the apparatus storing content indexed by the object identifiers.
39. (Original) The system as recited in claim 38, wherein the apparatus further comprises a system for authoring digital multimedia in response to detecting one of the plurality of labels which is to be stored within the digital multimedia content collection and unambiguously bound to the object identifier.
40. (Original) The system as recited in claim 39, wherein the apparatus further comprises a system for rendering digital multimedia in response to detecting one of the plurality of labels, the digital multimedia rendered being the content unambiguously bound to the object identifier associated with a detected label.
41. (Original) The system as recited in claim 40, wherein the digital multimedia content collection includes one or more of audio files, visual graphics files, text files, video files, XML files, hyperlink references, live agent connection links, programming code files, and configuration information files.
42. (Original) The system as recited in claim 40, wherein the apparatus comprises programming that renders digital multimedia as a function of output capabilities of the apparatus.
43. (Currently Amended) The system as recited in claim 38, wherein the [tour] digital multimedia content collection is stored on one or more computer servers external to the apparatus.
44. (Currently Amended) The system as recited in claim 43, wherein the [tour] digital multimedia content collection and the apparatus communicate via a wired network.

45. (Currently Amended) The system as recited in claim 43, wherein the [tour] digital multimedia content collection and the apparatus communicate via a wireless network.
46. (Original) The system as recited in claim 45, wherein the wireless network comprises a cellular telephone network.
47. (Currently Amended) The system as recited in claim 38, wherein the [tour] digital multimedia content collection resides on the apparatus.
48. (Currently Amended) The system as recited in claim 38, wherein the apparatus accesses the [tour] digital multimedia content collection via the Internet.
49. (Currently Amended) The system as recited in claim 38, wherein the apparatus accesses the [tour] digital multimedia content collection via a voice portal.
50. (Currently Amended) The system as recited in claim 38, wherein the apparatus accesses the [tour] digital multimedia content collection via a cellular telephone voice mailbox.
51. (Original) The system as recited in claim 38, wherein the digital multimedia is aggregated into a tour.
52. (Original) The system as recited in claim 38, wherein the digital multimedia is randomly accessible by the apparatus.
53. (Original) The system as recited in claim 38, wherein the digital multimedia is accessible by the apparatus in a sequential order.
54. (Original) The system as recited in claim 38, wherein the apparatus comprises a personal digital assistant.

55. (Original) The system as recited in claim 38, wherein the apparatus comprises a cellular telephone.
56. (Original) The system as recited in claim 38, wherein the apparatus comprises purpose built devices targeted to a specific application.
57. (Original) An apparatus for authoring information relevant to a physical world, comprising: circuitry for detecting a label associated with an object; and a system for authoring content to be unambiguously bound to the object as represented by the detected label which content is to be rendered during detection of the label in a playback mode.
58. (Original) The apparatus as recited in claim 57, wherein the circuitry comprises a barcode reader.
59. (Original) The apparatus as recited in claim 57, wherein the circuitry comprises an IR tag reader.
60. (Original) The apparatus as recited in claim 57, wherein the circuitry comprises a RFID tag reader.
61. (Original) The apparatus as recited in claim 57, wherein the circuitry comprises a keyboard for inputting textual information.
62. (Original) The apparatus as recited in claim 57, wherein the circuitry comprises of analog to digital information transducer.
63. (Original) An apparatus for authoring and providing information relevant to a physical world, comprising: circuitry for detecting a label associated with an object; and programming for normalizing information contained in the detected label into an object identifier; a system for authoring content in an authoring mode which content is to be unambiguously bound to the object identifier; and a system for rendering content in a playback

mode, the content rendered being the content unambiguously bound to the object identifier associated with a detected label.

64. (Original) The apparatus as recited in claim 63, further comprising a communications link for downloading authored content to a remote location and for retrieving content from the remote location for rendering.

65. (Original) The apparatus as recited in claim 63, further comprising a memory for storing the content.

66. (Original) The apparatus as recited in claim 63, wherein the circuitry comprises a barcode reader.

67. (Original) The apparatus as recited in claim 63, wherein the circuitry comprises an IR tag reader.

68. (Original) The apparatus as recited in claim 63, wherein the circuitry determines a coordinate location.

69. (Original) The apparatus as recited in claim 63, wherein the circuitry is a RFID tag reader.

70. (Original) The apparatus as recited in claim 63, wherein the circuitry is an analog to digital information transducer.

REMARKS

Claims 1-70 are currently pending. Applicant respectfully requests that the Examiner reconsider all rejections in the outstanding Office Action in view of the foregoing amendments and the following remarks.

1. Related Application 10/035,952

At the outset, Applicant notes related U.S. Patent Application No. 10/035,952 ("the '952 application") filed on December 26, 2001, naming Applicant and Ms. Rozsa Kovesdi as joint inventors, and addresses the attempted Petition under 37 C.F.R. § 1.182 ("the Petition," apparently submitted sometime in March) alleging joint inventorship in the instant application by non-Applicant, Ms. Kovesdi. Because prosecution of the instant application is conducted *ex parte*, Applicant believes there is no legal requirement to substantively respond to the merits of such an improper Petition. Nonetheless as a courtesy to the Examiner, the following is provided in an attempt to better elucidate Applicant's position maintained in these related applications.

First and foremost, Applicant submits that the instant application does not claim any subject matter that was either solely or jointly conceived by Ms. Kovesdi. Certainly, the present application claims priority to U.S. Provisional Application No. 60/306,356 ("the provisional application"), which names Applicant and Ms. Kovesdi as a joint inventive entity. Be that as it may, the only claims of the provisional application that Ms. Kovesdi arguably made a conceptual contribution to are claims 44 and 45 therein, subject matter which is not pursued nor claimed by Applicant in this application. Therefore, the sole inventive entity as originally declared in this application is correct and legally proper in view of the subject matter claimed herein.

Applicant notes that the subject matter of claims 44 and 45 in the provisional application is being pursued by Ms. Kovesdi and Applicant in the '952 application. For this reason, Applicant executed and submitted a Declaration declaring himself as a joint inventor "to which at least one claim is directed" in the '952 application.

The Declarations executed by Applicant in this application and the '952 application do not conflict, but rather are in agreement with one another due to the respective absence or presence of claimed subject matter corresponding to that recited in claims 44 and 45 of the provisional application. Contrary to Ms. Kovesdi's allegations set forth in the Petition, the pending claims herein are not substantially identical to those in the '952 application for at least this reason. Because of the lack of her conceptual contribution to any of the subject matter set

forth in the claims presented herein, the exclusion of Ms. Kovesdi from the inventive entity of this application is legally justified.

2. Claim Objections

Claims 47-50 are objected due to usage of the term "the tour" and appropriate correction by Applicant is requested. Applicant has amended these claims to better describe the claimed invention. Applicant respectfully submits that the instant objection is rendered moot and the Examiner is requested to withdraw this objection.

3. 35 U.S.C. § 102(b)

Claims 18, 19, 21, 22, 31, 34, 38, 52, and 56 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,480,306 to Liu. Office Action, page 2, item 3. Particularly, the Examiner contends that Liu teaches a method and apparatus for providing information relevant to the physical world by reading a bar code associated with sound data, wherein the bar code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored and the sound is applied to a loud speaker system. *Id.* The Examiner further contends that the conversion from the bar code to a digital code then to an address pointer is considered to be normalizing a read object label associated with an object into an object identifier. *Id.* Applicant respectfully disagrees with such contentions and traverses this rejection on the following grounds.

Liu is directed toward a language learning apparatus for the playback of pre-recorded sounds and particularly, for converting optical codes into true human speech or natural sound. *See* Liu, abstract and col. 2, ll. 26-34. Liu discloses converting (*i.e.*, translating) bar code information into an address pointer for the retrieval of pre-recorded sounds. *Id.* at col. 4, ll. 1-29. Applicant submits that such a conversion process is performed on a mere one to one basis, *i.e.*, a particular labeling scheme format (only one of which is disclosed) is converted to a specified address pointing format.

To anticipate a claim, the reference must teach every limitation of the claim. *See* M.P.E.P. § 2131.

Applicant submits that Liu fails to disclose "normalizing information contained in the detected label into an object identifier" as recited in independent claim 18, and "an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier" as recited in independent claim 38. The

concept of “normalizing” is discussed throughout Applicant’s specification, particularly at page 22, line 8 to page 23, line 9. To summarize, a label value read from any labeling scheme such as a barcode, global positioning system (GPS) coordinates, or RFID scheme is processed into a normalized label, *i.e.*, an object identifier generic to two or more interpretation schemes, such that all information associated with the label retrieving scheme is removed. Applicant’s Specification, page 14, ll. 5-7. For example, if the value encoded on the barcode label was the UPC code of a particular product, after normalization, it would become a numeric string, such as, “05928000200,” which does not reveal any information about how the value was retrieved. *Id.* at page 17, ll. 4-8. Therefore, multiple labeling schemes can be used to access the same piece of media content. In turn, devices of different label reading capabilities can access the same media content. *Id.* at page 14, ll. 12-15. As submitted above, Liu merely discloses a one to one conversion or translation of barcode information into a digital address and not “normalizing” information contained in a detected label into a generic object identifier as claimed. Therefore, Applicant respectfully submits that Liu does not anticipate claims 18 and 38.

Liu also fails to disclose “storing an object identifier indicative of a plurality of read labels associated with an object into an index repository” as recited in independent claim 31. Emphasis added. Referring to Figs. 5A and 5B, Liu discloses only a one to one correspondence between digital codes (each converted from a single read optical code) and respective memory addresses. Liu, col. 3, ll. 32-47 and col. 4, ll. 11-27. Therefore, Applicant respectfully submits that Liu does not anticipate claim 31.

Claims 19, 21, 22, 34, 52, and 56 are not anticipated by Liu at least because they depend from one of independent claims 18, 31, and 38.

Applicant respectfully requests the Examiner to withdraw the rejection of claims 18, 19, 21, 22, 31, 34, 38, 52, and 56.

4. 35 U.S.C. § 103(a)

I. Liu In View Of Savchenko

Claims 1-5, 9, 13, 16, 29, 30, 39-42, 57, 58, 61-63, 65, 66, and 70 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered unpatentable over Liu in view of U.S. Patent No. 6,111,567 to Savchenko et al. (“Savchenko”). Office Action, page 3, item 5. Applicant traverses this rejection on the following grounds.

(a) Claims 1-5 and 9

The Examiner contends that Liu teaches a method an apparatus for reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored, converted to an analog signal, and the sound applied to a loud speaker system. *Id.* The Examiner admits that “Liu fails to teach a method for authoring information.”<sup>1</sup> *Id.* at page 4. In order to cure such a deficiency, Savchenko is introduced as teaching a method of authoring multimedia titles. *Id.*

In order to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (citations omitted). In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the modification of a single reference, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

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<sup>1</sup> The Examiner’s basis for this obviousness-type rejection is rendered unclear at the onset as the preamble of claim 1 recites “A method for authoring information . . . .”



There is no showing of any objective teaching to combine Liu and Savchenko. The Office action merely states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teaching of Liu in order to create a well organized system so that minimal memory is utilized, but at the same time provide a good quality sound and maintain the flow of the music or sound produced." This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these two references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination.

Even assuming, *arguendo*, that a proper motivation to combine exists for the Examiner's proposed combination, Liu and Savchenko do not teach or suggest all claim limitations. Claim 1 is repeated as follows.

1. A method for authoring information relevant to a physical world, comprising:  
detecting with an authoring device a first label associated with a first object; and  
triggering, in response to detecting, a system for authoring content;  
wherein the content is to be unambiguously bound to the first object and is to be rendered on a playback device during detection of the first label.

Liu, as previously discussed, is simply directed toward a language learning apparatus for the playback of pre-recorded sounds. Liu's apparatus has no authoring capabilities whatsoever. Savchenko is directed to seamless multimedia branching achieved during authoring and storing of the multimedia. *See* Savchenko, abstract. No apparent nexus exists between Savchenko's seamless multimedia branching method and authoring content upon label detection. Clearly, Liu, either taken alone or in combination with Savchenko, fails to teach or suggest "detecting with an authoring device a first label associated with a first object" and "triggering, in response to detecting, a system for authoring content" as claimed. Emphasis added.

For at least these reasons, Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that independent claim 1 is patentable over the cited references. Claims 2-5 and 9 are patentable at least because they depend from independent claim 1.

(b) Claim 13

As with claim 1, the Examiner contends that Liu teaches a method an apparatus for reading a bar code associated with a sound data and the code is converted into a memory address

pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored, converted to an analog signal, and the sound applied to a loud speaker system. Office Action at page 3. However, with respect to claim 13, the Examiner apparently contends that Liu fails to teach a computer-readable media having instructions for authoring information as Savchenko is relied on for curing such a deficiency.<sup>2</sup> *Id.* at page 5.

There is no showing of any objective teaching to combine Liu and Savchenko. The Office action merely states "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teaching of Liu in order to speed up the process by storing all the instruction in the memory and have the processor access and execute the instructions instead of loading or inputting the instructions one-by-one by the user." This broad, conclusory statement is not sufficient, under the controlling authorities set forth in above to justify combining the teachings of these two references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination.

Even assuming, *arguendo*, that a proper motivation to combine exists, the proposed combination does not teach or suggest all claim limitations. Claim 13 is repeated as follows.

13. A computer-readable media having instructions for authoring information relevant to a physical world, the instruction performing steps comprising:  
detecting with an authoring device a first label associated with a first object; and  
triggering, in response to detecting, a system for authoring content;  
wherein the content is to be unambiguously bound to the first object and is to be rendered on a playback device during detection of the first label.

Liu, either taken alone or in combination with Savchenko, fails to teach or suggest "detecting with an authoring device a first label associated with a first object" and "triggering, in response to detecting, a system for authoring content" as claimed. *See* Remarks § 4.I.(a), *supra*.

For at least these reasons, Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that independent claim 13 is patentable over the cited references.

---

<sup>2</sup> Similar to claim 1, the Examiner's basis for this obviousness-type rejection is rendered unclear at the onset as the preamble of claim 13: "A computer-readable media having instructions for authoring information . . . ."

(c) Claims 16, 29, and 30

With respect to these claims, the Examiner apparently contends that in addition to the purported combination of Liu and Savchenko as applied to the preceding claims<sup>3</sup>, the conversion from the bar code to the digital code then to an address pointer is considered to be normalizing a read object label associated with an object into an object identifier. Office Action at page 5. Applicant respectfully disagrees.

As with claims 1 and 13, there is no showing of any objective teaching to combine Liu and Savchenko. *See* Remarks § 4.I(a) and (b), *supra*.

Even assuming, *arguendo*, that a proper motivation to combine exists, Liu does not disclose “normalizing a read object label associated with an object into an object identifier” as recited in independent claim 16 nor “normalizing information contained in the detected label into an object identifier” as recited in independent claim 29. *See* Remarks § 3, *supra*. Savchenko fails to cure such a deficiency as it is solely directed to seamless multimedia branching.

For at least these reasons, Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that independent claims 16 and 29 are patentable over the cited references. Claims 30 is patentable at least because it depends from independent claim 29.

(d) Claims 39-42

With respect to claim 42, the Examiner contends “Liu teaches . . . rendering digital multimedia as a function of output capabilities of the apparatus.” Office Action at page 5. However, Liu fails to teach programming that renders digital multimedia as a function of output capabilities as recited in claim 42. *Id.* To cure such a deficiency, Savchenko is introduced as teaching a computer application that executes instructions. *Id.*

At the outset, Applicant respectfully submits that the instant rejection is improper with respect to claims 39-42 as it does not address any of the limitations claimed in claims 39-41. Claim 42 depends from dependent claim 40. As such, the rejection fails to address all limitations of claim 42.

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<sup>3</sup> The basis for this rejection is unclear and difficult for Applicant to address as independent claims 16 and 29 recite several limitations not addressed by the Examiner in the preceding claims. Future adherence to the “Graham Factual Inquiries” as required under M.P.E.P. § 2141 is respectfully requested.

Moreover, there is no showing of any objective teaching to combine Liu and Savchenko. The Office Action merely states "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teaching of Liu in order to provide the proper sound signal that matches the output characteristics of the apparatus so that the user can listen to a good quality sound with less background noise and interruption." This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these two references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination.

Applicant submits these dependent claims are patentable at least because they depend from independent claim 38, which Applicant submits is patentable over the cited references. For example, Liu does not disclose "an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier" as recited in independent claim 38. See Remarks § 3, *supra*. Savchenko fails to cure such a deficiency.

Claim 39 further recites "a system for authoring digital multimedia in response to detecting one of the plurality of labels which is to be stored within the digital multimedia content collection and unambiguously bound to the object identifier." Liu, either taken alone or in combination with Savchenko, fails to teach or suggest this limitation. See Remarks § 4.I.(a), *supra*.

Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that claims 39-42 are patentable over the cited references.

(e) Claims 57, 58, 61, and 62

In regard to independent claim 57, the Examiner apparently relies on the reasoning stated in connection with claim 1 and further contends that Liu teaches circuitry for detecting a label associate with an object. Office Action at page 3. Applicant respectfully disagrees.

As with claim 1, Applicant submits that there is no showing of any objective teaching to combine Liu and Savchenko as proposed. See Remarks § 4.I.(a), *supra*.

Even assuming, *arguendo*, that a proper motivation to combine exists, neither Liu nor Savchenko teaches or suggests "a system for authoring content to be unambiguously bound to

the object as represented by the detected label which content is to be rendered during detection of the label in a playback" as recited in independent claim 57. *See* Remarks § 4.I(a), *supra*.

Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that independent claim 57 is patentable over the cited references. Claims 58, 61, and 62 are patentable at least because they depend from independent claim 57.

(f) Claims 63, 65, 66, and 70

Independent claim 63 is apparently rejected on the grounds stated in the Office Action with respect to independent claims 1, 13, 16, 29, 57, and 63.

As submitted above, Applicant submits that there is no showing of any objective teaching to combine Liu and Savchenko. *See* Remarks § 4.I(a),(b), and (d), *supra*.

Even assuming, *arguendo*, that a proper motivation to combine exists, neither Liu nor Savchenko teaches or suggests "programming for normalizing information contained in the detected label into an object identifier" and "a system for authoring content in an authoring mode which content is to be unambiguously bound to the object identifier" as recited in independent claim 63. *See* Remarks § 4.I(a), (c), and (d), *supra*.

Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that independent claim 57 is patentable over the cited references. Claims 58, 61, and 62 are patentable at least because they depend from independent claim 57.

Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-5, 9, 13, 16, 29, 30, 39-42, 57, 58, 61-63, 65, 66, and 70.

II. Liu And Savchenko In View Of Conley

Claims 7, 14, 36, 37, 47, and 51 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13, and Liu as applied to claim 38, and further in view of U.S. Patent No. 6,434,745 to Conley, Jr. et al. ("Conley"). Office Action, page 6, item 7. Particularly, the Examiner admits that Liu as modified by Savchenko fails to teach aggregating the content into a single logical entity called a tour. *Id* at page 7. In order to cure such a deficiency, Conley is introduced as teaching a tour component of a browser that allows the end-user to identify one or more URLs and save them into a group called a tour and to create one or more such tours, and to save each tour to a

searchable local tour database on the end-user computer similar to the searchable local image database. *Id.* Applicant respectfully traverses this rejection on the following grounds.

There is no showing of any objective teaching to combine Liu, Savchenko, and Conley. The Office Action merely states "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Conley to the teachings of Liu as modified by Savchenko in order to organize the data so that related data are grouped in the same group to help and speed up the searching process when the data needs to be retrieved." This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these three references. *See also* Remarks § 4.I, *supra*. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination.

Even assuming, *arguendo*, that a proper motivation to combine exists for the Examiner's proposed combination, Liu, Savchenko, and Conley do not teach or suggest all the limitations of claim 36, which is repeated as follows.

36. A method for providing information relevant to a physical world, comprising:
- associating one or more labels with each of a plurality of objects in a tour;
  - storing an object identifier indicative of the one or more labels associated with each of the plurality of object in the tour in an index table repository;
  - authoring content relevant to each of the plurality of objects in the tour;
  - and
  - binding the content to an object identifier in the index table repository which corresponds to the relevant one of the plurality of objects in the tour whereby the content is renderable when the label is detected by a playback device without regard to the order in which the content was authored.

As previously discussed, Liu's apparatus has no authoring capabilities whatsoever. Savchenko is directed to seamless multimedia branching achieved during authoring and storing of the multimedia. *See* Savchenko, abstract. No apparent nexus exists between Savchenko's seamless multimedia branching method and authoring content in association with object identifiers. Conley is merely directed to customized web browsing and marketing software. *See* Conley, abstract. Clearly, Liu, either taken alone or in combination with Savchenko and Conley, fails to teach or suggest "authoring content relevant to each of the plurality of objects in the tour" and "binding the content to an object identifier in the index table repository which corresponds to the relevant one of the plurality of objects in the tour whereby the content is renderable when the

label is detected by a playback device without regard to the order in which the content was authored" as claimed.

Claims 7, 14, 37, 47, and 51 are patentable at least because they depend from either independent claim 1, 13, 36, or 38, which Applicant submits are patentable over the cited references. *See* Remarks § 3 and 4.I, *supra*. Conley fails to cure the identified deficiencies of the primary references with respect to these claims.

Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that claims 7, 14, 36, 37, 47, and 51 are patentable over the cited references.

Applicant respectfully requests the Examiner to withdraw the rejection of claims 7, 14, 36, 37, 47, and 51.

### III. Liu And Savchenko In View Of Remaining Cited References

Dependent claims 6, 8, 10-12, 15, 17, 20, 23-28, 32, 33, 35, 43-46, 48-50, 53-55, 59, 60, 64, and 67-69 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered unpatentable over Liu as modified by Savchenko, and further in view of one or more of the following: U.S. Patent No. 5,958,014 to Cave; U.S. Patent No. 4,963,719 to Brooks et al.; U.S. Patent No. 5,616,876 to Cluts; U.S. Patent No. 6,264,106 to Bridgelall; U.S. Patent No. 6,324,165 to Fan et al.; U.S. Patent No. 5,566,291 to Boulton et al.; U.S. Patent No. 6,195,531 to Aguirre et al.; U.S. Patent No. 6,359,711 to Cole et al.; U.S. Patent No. 5,598,540 to Krueger; U.S. Patent No. 6,315,195 to Ramachandran; U.S. Patent No. 5,869,820 to Chen et al.; and U.S. Patent No. 5,613,137 to Bertram et al. Office Action, items 6 and 8-20. Applicant respectfully traverses these rejections on the following grounds.

Applicants submit that there is no showing of any objective teaching to combine these references as the reasoning provided is conclusory at best and is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these references. *See also* Remarks § 4.I, *supra*. There is no showing that either of the applied references, or any other prior art, even remotely suggests the proposed combinations set forth in the Office Action.

Moreover, these dependent claims are patentable at least because they depend from one of independent claims 1, 13, 16, 18, 31, 38, 57, and 63, which Applicant submits are patentable over the cited references. *See* Remarks § 3 and 4.I, *supra*. The secondary references fail to cure

the identified deficiencies of the primary references relied on by the Examiner with respect to the independent claims.

Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully submits that claims 6, 8, 10-12, 15, 17, 20, 23-28, 32, 33, 35, 43-46, 48-50, 53-55, 59, 60, 64, and 67-69 are patentable over the cited references.

Applicant respectfully requests the Examiner to withdraw the rejections of claims 6, 8, 10-12, 15, 17, 20, 23-28, 32, 33, 35, 43-46, 48-50, 53-55, 59, 60, 64, and 67-69.

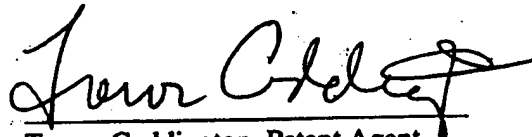
### CONCLUSION

Applicant respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. Should the Examiner believe anything further is desirable in order to place the Application in even better condition for allowance, the Examiner is invited to contact the Applicant's undersigned representative.

No fee is believed to be required for the entry of this response. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Response or to maintain the present application as pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,  
HUNTON & WILLIAMS LLP

By:

  
Trevor Coddington, Patent Agent  
Registration No. 46,633

Dated: June 11, 2003

Hunton & Williams LLP  
Intellectual Property Department  
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## JONES DAY

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006596:rxn  
CAM

April 1, 2004

By Facsimile

Mr. Rodger Tate  
HUNTON & WILLIAMS  
1900 K Street, N.W., Suite 1200  
Washington, D.C. 20006-1109

Re: United States Patent Application Serial No. 10/035,952  
Filed: December 26, 2001  
For: SYSTEM AND METHOD FOR AUTHORIZING  
AND PROVIDING INFORMATION RELEVANT  
TO A PHYSICAL WORLD  
By: Kovesdi et al.

Dear Mr. Tate:

I acknowledge your letter dated March 31, 2004. As you know, we would like to find an amicable resolution which is in the best interest of all parties. Still, absent any indication of what new facts or information may be discussed with her, it is our client's belief that there is no point in a face-to-face meeting. In particular, Ms. Kovesdi feels that in view of your inability to provide facts or evidence directed to demonstrating that she is not a co-inventor of the US Patent Application No. 09/987,597 ("the '597 application"), there is little to be gained in any such meeting. We are unable to find any error in her perception based on the evidence provided by you, which we understand was the result of your careful review of the underlying facts. Ms. Kovesdi has already indicated that she is not interested in entering into any business arrangements at this time.

In fact, as you must know from your review of the correspondence, Mr. Rajasekharan has not only acknowledged the broad and deep contributions by Ms. Kovesdi from conception to realization of the invention claimed in the '597 application, but he also has admitted to specific details relevant to the inventorship issue. For instance, in email exchanges Mr. Rajasekharan has admitted that Ms. Kovesdi contributed the "key idea" of coincident authoring to solve the tricky binding problem. This solution undeniably underlies claim 1 of the '597 application. Similarly, Mr. Rajasekharan also admitted that Ms. Kovesdi originated the idea for a pen-shaped device, which is a significant part of the pending US Patent Application No. 10/103,777 naming Mr. Millman as a co-inventor.

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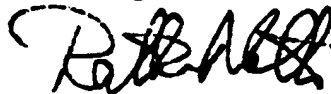
JONES DAY

Mr. Rodger Tate, Esq  
April 1, 2004  
Page 2

Mr. Rajasekharan's admissions clearly support Ms. Kovesdi's proper status as an inventor. Accordingly, unless Ms. Kovesdi is included as an inventor on all of the applications, resolution of this dispute is unlikely. Please provide us with details on the other patent applications that you seem to have filed to allow us to correct the record, if required. In particular, it would appear that Ms. Kovesdi should be named a co-inventor of the design patent disclosed in your letter as she undeniably contributed the idea of a pen-shaped device.

Based on the above, if your client is seriously considering a resolution, we ask you to countersign the copy of the response to the pending Office Action in the above-captioned case and send it to me no later than 4:00 pm on Tuesday, April 6, 2004. We can then discuss the mechanics for adding Ms. Kovesdi as a co-inventor to the various applications as soon as possible. If you have any questions, please let us know.

Best regards,



Rattan Nath  
Associate

c: Ognjan Shentov, Esq.



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RUDGER L. TATE  
DIRECT DIAL 202-414-2100  
EMAIL rtate@hwt.com

FILE NO. 63044 000001

March 31, 2004

Rattan Nath  
Jones Day  
1155 Avenue of the Americas  
New York, N.Y. 10036-2711

Re: Kovesdi Matter

Dear Mr. Nath:

It has been sometime since we last discussed the dispute between our clients. Please let me know if you have filed any further papers in the dual representation case naming Ms. Kovesdi and Ajit. I understand that the period to respond to the PTO's notice of non responsiveness will expire, with extension, on June 16, 2004.

While you and I have agreed on several occasions, that it makes good sense to both our clients to put this dispute behind them, we have not been able to get them to talk about this. I believe it is appropriate to try one more time.

In the context of a global resolution of all issues we would like to hear Ms. Kovesdi's position on what contributions she made to the first provisional case she and Ajit filed, and my client has reaffirmed its willingness to reevaluate the inventorship position on this case based on what Ms. Kovesdi has to say.

While we believe that the meeting we are proposing should include a discussion of possible business resolutions, the primary purpose of the meeting will be to attempt to reach an agreement on the inventorship issues by mutually discussing the legally relevant facts.

As to the second case our client filed (SN 10/103,777) we are prepared to explain why the claims being pursued there do not relate to any potentially jointly invented subject matter. A design patent just issued (U.S. Des. 487746) on a device developed long after our clients stopped talking to one another. Our client also has recently filed a number of provisional applications directed to new technology developed long after the period of interaction. This technology is so clearly different that it will not be subject to these discussions.

**HUNTON &  
WILLIAMS**

Rattan Nath  
March 31, 2004  
Page 2

I would like your thoughts on who you think should attend this meeting. I propose that both Rozi and Ajit and you and I would be the most productive. If you think that nix is too explosive, maybe only you, I and Rozi could meet.

Please let me have your thoughts on how we can tie up these loose ends in a win-win manner.

Very truly yours,




Rodger L. Tate

RLT:mia

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RODGER L. TATE  
DIRECT DIAL: 202-419-2069  
EMAIL: rtate@hunton.com

FILE NO: 63044.000005

April 8, 2004

**VIA FACSIMILE**

Rattan Nath  
Jones Day  
222 East 41<sup>st</sup> Street  
New York, N.Y. 10017-6702

Re: Kovesdi Matter

Dear Mr. Nath:

I am in receipt of your letter of April 1, 2004. We are disappointed by your client's continued refusal to meet and try to resolve these issues. Her motives in taking this position are a mystery to us. We repeat that Readia remains willing to have the face-to-face meeting we have proposed on numerous occasions, and urge Rozi to reconsider this position.

We continue to find her broad unsupportable position that she is a co-inventor untenable. We have provided facts and contextual explanations supporting Readia's position and Rozi has continued to simply demand she be added pointing only to out-of-context statements by Ajit who did not understand the law of co-inventorship at the time he made them. At the proposed meeting, we think both parties should provide any documentary evidence supporting their positions on inventorship so an informed, good faith resolution of this dispute could occur.

Frankly, my client finds incredulous Rozi's increasingly broadening positions that she contributed, as a co-inventor, to the coincident authoring concept or the pen-shaped device form factor concept. I am sure you have advised Ms. Kovesdi that she has, and will have, the **burden** to establish facts supporting her claim of co-inventorship. As you will appreciate, the claim to co-inventorship on the design patent is also legally spurious as design patents do not cover "ideas" but ornamental designs. The facts are clear that Rozi had nothing to do with the later-developed specifics of the patented design.

Despite Rozi's continued refusal to engage in good faith discussion about this matter, we remain prepared to cooperate with you in taking appropriate action in application Serial No. 10/035,952. In that regard please consider the following proposal. If Rozi is willing to agree to promptly meet and discuss all issues with Readia in good faith, Readia is willing to consider adding what we have consistently viewed as the jointly invented claims (42-43) to our sole

# HUNTON WILLIAMS

Rattan Nath  
April 8, 2004  
Page 2

case (Serial No. 09/987,597) and adding her name to that case as a co-inventor. Acceptable ground rules for such a proposal include (i) Rozi agrees in writing to discuss and resolve the inventorship issue she raised regarding our CIP (Serial No. 10/103,777) in good faith and to only take positions that are factually supportable by documentary evidence and (ii) Rozi agrees to sign a NonDisclosure Agreement (NDA) containing customary nondisclosure and nonuse provisions covering (a) the prosecution strategy in our CIP and (b) the subject matter disclosed in Readia's recently filed provisionals, which we would share with her subject to the NDA and Rozi's good faith undertaking to review them and formally waive any potential claims of inventorship that she cannot support with documentary evidence.

The proposed process can take place quickly before any action needs to be taken in the '952 application. If Rozi refuses to engage in the process of the above proposal, then please advise us which of the following alternative options you will join us in regarding the '952 application:

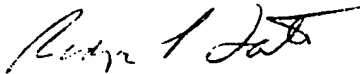
- Option 1: Sign the enclosed responsive amendment to continue the prosecution on those patentable claims we have agreed are jointly invented.
- Option 2: Sign a joint Petition to suspend prosecution.
- Option 3: Sign a joint request for the filing of a continuation application.

If you refuse to cooperate with us on all of these proposals, it is likely that the application will become irrevocably abandoned. While we believe that the majority of our client's interest are protected in the sole application we filed, an intentional abandonment resulting from your refusal to cooperate would cause my client loss of rights to the joint subject matter.

Selection of options 2 or 3 would provide for the potential downstream resolution of the dispute by (a) agreement of the parties, (b) arbitration of the dispute or (c) an interference proceeding upon the PTO's determination of allowable subject matter in our sole case.

Please let me have your response by April 12, 2004.

Very truly yours,



Rodger L. Tate

RLT:cbt:mia



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of: )  
)  
Rozsa KOVESDI and Ajit RAJASEKHARAN ) Group Art Unit: 2876  
)  
Application Number: 10/035,952 ) Examiner Kumiko C. KOYAMA  
)  
Filed: December 26, 2001 ) Confirmation No. 3522  
)  
For: SYSTEM AND METHOD FOR )  
AUTHORING AND PROVIDING )  
INFORMATION RELEVANT TO A )  
PHYSICAL WORLD )

REPLY TO NON-FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.111

U.S. Patent and Trademark Office  
2011 South Clark Place  
Customer Window  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Dear Sir:

In response to the Office Action mailed on March 18, 2003, and the Notice of Non-Responsive Amendment mailed on December 16, 2003, Applicants respectfully request entry of the following amendments and reconsideration of all rejections in view of these amendments and the following remarks.

**Amendments to the Claims** are reflected in the listing of claims, which begins on page 2 of this paper.

*In sum, claims 43 and 44 are amended as follows.<sup>1</sup>*

*Claims 1-42 and 45-109 have been cancelled.*

*Claims 43 and 44 are currently pending.*

**Remarks/Arguments** begin on page 3 of this paper.

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<sup>1</sup> Due to the absence of claim 22 in the application as originally filed, claims 23-110 have been renumbered to claims 22-109, respectively. See Office Action, page 2.

Claims 1-42. (Cancelled)

43. (Currently Amended) [The system as recited in claim 39] A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising:  
a plurality of machine readable labels relevant to the physical world;  
an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and  
a digital multimedia library accessible by the apparatus storing content indexed by the object identifiers,

wherein the physical world comprises labeled locations containing labeled mobile objects.

44. (Currently Amended) The system as recited in claim [44] 43, wherein the labeled locations are used to determine proximity of the labeled mobile objects.

45-109. (Cancelled)

REMARKS

Claims 43 and 44 are pending. Applicants respectfully request that the Examiner reconsider all rejections in the outstanding Office Action in view of the foregoing amendments and the following remarks.

1. Claims 1-42 and 45-70

Claims 1-42 and 45-70 have been cancelled. Accordingly, all rejections in the instant application with respect to these claims are rendered moot.

Applicants note that these claims are solely conceived by Mr. Ajit Rajasekharan and are therefore being pursued in related U.S. Patent Application No. 09/987,597, which correctly identifies Mr. Rajasekharan as the sole inventor.

2. 35 U.S.C. § 103

Claims 43 and 44 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered unpatentable over U.S. Patent No. 5,480,306 to Liu in view of U.S. Patent No. 6,111,567 to Savchenko, and further in view of U.S. Patent No. 4,037,302 to Hollander and U.S. Patent No. 4,654,727 to Blum. Office Action, page 13. The Examiner concludes that Liu as modified by Savchenko fails to teach that the physical world comprises labeled locations containing labeled mobile objects and the labeled locations are used to determined proximity of the labeled mobile objects. *Id.* In an attempt to cure such a deficiency, Holland is introduced as teaching labeled locations, such as a labeled bin or labeled shelf.<sup>2</sup> *Id.* Applicants respectfully traverse this rejection on the following grounds.

In order to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (citations omitted). In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references."). It is well-settled that an Examiner can "satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge

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<sup>2</sup> It appears that the Office Action does not rely on Blum with respect to claim 43.

generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the combination of multiple references, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

There is no showing of any objective teaching to combine Liu, Savchenko, and Hollander as applied to claim 43. The Office action merely states: “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the teachings of Holland to the teachings of Liu as modified by Savchenko in order to identify the purpose, use or the physical description of the location of the labeled location so that the locations can easily and quickly [be] identified.” This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these three references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination. Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness.

Even assuming, *arguendo*, that a *prima facie* case of obviousness has been established, Liu, either taken alone or in combination with any of the cited secondary references, fails to teach or suggest all of the limitations of claim 43.

For at least the reasons set forth above, Applicants respectfully submit that the instant rejection is improper and therefore, request that the Examiner withdraw the rejection of claims 43 and 44.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. Applicants submit concurrently herewith a three-month extension of time and the requisite fee for consideration of this response.

Respectfully submitted,

Dated: \_\_\_\_\_

By: \_\_\_\_\_  
Rodger L. Tate  
Registration No. 27,399  
(Representative for Mr. Rajasekharan)  
Hunton & Williams LLP  
Intellectual Property Department  
1900 K Street, N.W., Suite 1200  
Washington, DC 20006-1109

Dated: \_\_\_\_\_

By: \_\_\_\_\_  
Ognjan V. Shentov  
Registration No. 38,051  
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Jones Day  
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## Introduction

The United States Congress and federal regulatory agencies have and do play important roles in the regulation of the sale of cigarettes. It is not surprising, therefore, that cigarette companies, including the Defendants herein, have, from time to time, presented their point of view to such bodies. Such activities are constitutionally protected by the First Amendment, which applies in product liability actions involving tobacco and smoking. Plaintiffs here might argue that Defendants have provided false information to Congress during the 1994 Congressional Subcommittee Hearings or may seek to introduce evidence of other protected political speech and activities. Consequently, R.J. Reynolds Tobacco Company and Philip Morris Incorporated (“Defendants”) request an order prohibiting Plaintiffs from introducing any evidence or testimony, making any innuendo, or commenting or arguing in the jury’s presence concerning Defendants’ advocacy efforts, government petitioning activities, or testimony at Congressional Subcommittee Hearings.

The Court should exclude all such references to Defendants’ advocacy efforts and government petitioning activities.<sup>1</sup>

## Argument

The First Amendment Prohibits the Imposition of Civil Liability for Advocating Governmental Action.

The First Amendment to the United States Constitution articulates the fundamental “right of the people” to peaceably assemble, and “to petition the government for a redress of grievance.” Indeed, the right to petition the government is “fundamental to the very idea of a republican or of governance.” Stern v. United States Gypsum, Inc., 547 F.2d 1329, 1342 (7<sup>th</sup> Cir. 1977). That right would be a “hollow promise” if the government were free to impose direct or indirect restraints upon it. United Mine Workers of America v. Illinois State Bar Ass’n, 389 U.S. 217, 222 (1967). Imposing civil liability is precisely the kind of indirect restraint the First Amendment forbids. Accordingly, Plaintiffs cannot, consistent with the First Amendment, seek to hold Defendants liable for advocacy efforts before the government.

That a defendant cannot be held liable for exercising its First Amendment right to petition the government is clear from a series of United States Supreme Court cases. Beginning with Eastern Railroad Presidents Conference v. Noerr Motor Freight, Inc. (“Noerr”), 365 U.S. 127, 145 (1961), the Supreme Court repeatedly has held that liability cannot be imposed for lobbying and public relations activities designed to influence governmental action with respect to the passage and enforcement of laws.

In Noerr, trucking companies sought to impose antitrust liability on defendant railroads for defendants’ efforts to foster the adoption of laws that would be detrimental to the trucking industry. The Court refused to allow the imposition of liability on the basis of such advocacy efforts, stating that to hold otherwise would:

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<sup>1</sup> In Whiteley v. Raybestos-Manhattan, Inc., No., 303184 (San Francisco Super. Ct.) *appeal pending*, No. A091444 (Cal. Ct. App.), the Honorable John E. Munter granted defendants’ motion *in limine* to apply the *Noerr-Pennington* doctrine precluding testimony on advocacy efforts. See Declaration of Bobbie J. Wilson (“Wilson Decl.”) Ex. A (Whiteley Trial Tr.) at 156:17-157:3. Additionally, in Falise v. American Tobacco Co., No. CV 9907392, 2000 U.S. Dist. LEXIS 10153, at \*2 (E.D.N.Y. July 18, 2000), modified in part on other grounds, No. CV-997392, 2000 U.S. Dist. LEXIS 10154 (E.D.N.Y. July 19, 2000), vacated in part on other grounds, No. CV-997392, 2000 U.S. Dist. LEXIS 10575 (E.D.N.Y. July 25, 2000) (Request for Judicial Notice (“RJN”) Exs. 1-3), Judge Jack B. Weinstein granted defendants’ motion *in limine* and ruled that “alleged misstatements made” in earlier court proceedings and “before Congress are not admissible to show misleading of courts or Congress.”

disqualify people from taking a public position on matters in which they are financially interested [and] would thus deprive the government of a valuable source of information and, at the same time, deprive the people of their right to petition in the very instances in which that right may be of the most importance to them. (Id. at 12430)

Moreover, the fact that defendants' speech was motivated by seeking an economic advantage in the regulatory or legislative context did not alter the protected status of the speech. Id. Seeking a preferred regulatory standard is exactly the type of speech intended to be protected. Senart v. Mobay Chem. Corp., 597 F. Supp. 502, 506 (D. Minn. 1984). "Taking a particular view in a scientific debate and ... trying to retain a regulatory standard which defendants preferred" does not constitute a tort, and is conduct that is protected by the First Amendment. Id. Furthermore, the fact that defendants act in some coordinated fashion as an industry does not create liability. Hamilton v. Accu-Tek, 935 F. Supp. 1307, 1321 (E.D.N.Y. 1996), aff'd, 32 F. Supp. 2d 47 (E.D.N.Y. 1998). In United Mine Workers of America v. Pennington, 381 U.S. 657 (1965), the Court indicated that activities specifically designed to influence regulatory activity are constitutionally protected:


Noerr shields from the Sherman Act a concerted effort to influence public officials regardless of intent or purpose.... Joint efforts to influence public officials do not violate the antitrust laws even though intended to eliminate competition. Such conduct is not illegal, either standing alone or as part of a broader scheme itself violative of the Sherman Act. (Id. at 670) (emphasis added) The United States Supreme Court recently reiterated that the Noerr-Pennington doctrine is not limited to antitrust context. Rather, it is the First Amendment that defined the broad contours of the Noerr-Pennington doctrine. In Professional Real Estate Investors, Inc. v. Columbia Pictures Industries, Inc., the Court stated that "[w]hether applying Noerr as an antitrust doctrine or invoking it in other contexts, we have repeatedly reaffirmed that evidence of anticompetitive intent or purpose alone cannot transform otherwise legitimate activity into a sham." 508 U.S. 49, 59 (1993) (emphasis added). The Court then cited NAACP v. Claiborne Hardware Co., a case in which the first Amendment rights of speech, assembly, association, and petition were held to preclude liability on civil conspiracy theories for damages suffered by business owners as a result of an NAACP-led economic boycott. 458 U.S. 886, 913-14 (1982). See Computer Assocs. Int'l v. American Fundware, 831 F. Supp. 1516, 1522-23 (D. Colo. 1993) (Professional Real Estate Investors and its citation of Claiborne Hardware establish that the Noerr-Pennington doctrine is a constitutional, and not simply an antitrust, doctrine).<sup>2</sup>

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<sup>2</sup> Similarly, lower courts have applied the Noerr-Pennington doctrine in a variety of contexts to preclude civil liability for the exercise of First Amendment rights. See, e.g., Brownsville Golden Age Nursing Home, Inc. v. Wells, 839 F.2d 155, 160 (3d Cir. 1988) (dismissing civil conspiracy claim alleging that defendants tortiously reported a nursing home's

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:	Kovesdi et al.	Confirmation No.:	3522
Serial No.:	10/035,952	Art Unit:	2876
Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	802959-999002

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.47(A),  
FOR REMOVAL OF A JOINT SIGNATURE REQUIREMENT AND ENTRY OF A  
PREVIOUSLY SUBMITTED RESPONSE TO OFFICE ACTION, AND FOR  
SUSPENSION OF PROSECUTION UNDER 37 C.F.R. § 1.183**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, Va 20231

Dear Sir:

Inventor Rozsa Kovesdi respectfully requests the Commissioner to grant this application a 37 C.F.R. § 1.47(a) status, or in the alternative to remove the joint signature requirement currently in place and to allow her representatives to prosecute the application on behalf of herself and co-inventor Ajit Rajasekharan. In particular, it is respectfully requested that a response to the outstanding Office Action, which representatives of Ms. Kovesdi filed on September 18, 2003 be entered without the signature of co-inventor Rajasekharan. Unless the requested relief is granted, the application would likely become abandoned, causing irreparable harm to her interests in the inventions claimed therein, and would leave her with no opportunity to request the Patent Office to resolve the disputed inventorship. To prevent this application from going abandoned before the Patent Office can rule on the instant submission, petitioner Kovesdi urgently requests the Commissioner to suspend its prosecution under 37 C.F.R. § 1.103.

The core issue to be resolved is whether petitioner Kovesdi is entitled to seek an opportunity to have a potential inventorship dispute between her and Mr. Rajasekharan resolved by the Patent Office. The underlying facts are simple: in July 2001 Ms. Kovesdi and Mr. Rajasekharan filed a provisional application naming both as inventors. In November 2001, Mr. Rajasekharan filed a non-provisional application that claims priority from the joint provisional application but lists him as the sole inventor (the '597 application). Ms. Kovesdi filed the present application (the '952 application) in December 2001 also claiming priority of the joint provisional application and listing both herself and Mr. Rajasekharan as co-inventors. As efforts to agree on a joined prosecution of the '952 application failed, Ms. Kovesdi filed a petition under 37 C.F.R. § 1.47(a) to prosecute the application on behalf of both inventors. Subsequently, Mr. Rajasekharan petitioned to join in the '952 application, expressly stating that he is the sole inventor "of a substantial number of the presented claims including all independent claims." Mr. Rajasekharan's petition further requested the Patent Office to require both parties to sign all subsequent replies under MPEP § 402.10, stating that "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources."

Despite the fact that Mr. Rajasekharan's request appears to violate MPEP § 409.03(i) which directs a party asserting sole inventorship of claims in a joint application to resolve the issue in a different patent application, the Patent Office denied Ms. Kovesdi's § 1.47(a) petition, granted Mr. Rajasekharan's petition to join, and imposed a requirement that all subsequent papers in this application be signed by both parties. By contrast, the Patent Office denied Ms. Kovesdi's petition to join in the '597 application as a co-inventor, allegedly because she was not a "proper party in interest." This determination was not based on the merits of her request to join, but solely on the fact that the originally filed declaration in the '597 application did not list Ms. Kovesdi as a co-inventor.

As a result of the above procedures, Ms. Kovesdi was placed in the anomalous position of not having even an opportunity to present for resolution to the Patent Office any potential issues of inventorship, because her co-inventor effectively has a veto power over any submission to the Patent Office. Indeed, the prosecution of the '952 application before the Patent Office has demonstrated that Mr. Rajasekharan's previous statement that a joint signature requirement would "encourage the parties to work out a jointly submitted

amendment” simply meant that Ms. Kovesdi would have no choice, and based solely on his own allegations Mr. Rajasekharan could resolve any issue in his favor.

In particular, in response to a rejection of the claims in the ‘952 application, Mr. Rajasekharan has taken the position that only two out of 107 claims in this application were jointly invented, and has refused to sign any response that does not involve the cancellation of the remaining claims in favor of prosecuting the claimed subject matter in his own ‘597 application. Mr. Rajasekharan has taken this position despite the fact that he has acknowledged in writing that a substantive response addressing all claims in the application and prepared by Ms. Kovesdi’s representatives is technically accurate. The Patent Office did not enter Ms. Kovesdi’s response because it did not have the signatures of both inventors. At present, facing a new deadline to respond to the same Office Action, Ms. Kovesdi’s options appear to be: letting the application go abandoned (and irreparably damaging her interest in the subject matter claimed therein), or canceling virtually all claims in the application and expressly acknowledging Mr. Rajasekharan’s alleged sole inventorship.

The above alternatives are testament of what can go wrong if the Patent Office’s rules of practice are applied inconsistently or fail to take into account the equities in a case. These rules of practice are intended to protect the rights of the parties and the fairness of the process, not to unfairly treat one party for the benefit of another. Accordingly, in view of the Mr. Rajasekharan’s refusal to cooperate in the prosecution of this application, and to protect the interests of Ms. Kovesdi as an innocent co-inventor risking a complete loss of rights through no fault of her own, it is respectfully requested that the ‘952 application be granted 37 C.F.R. § 1.47(a) status and/or that the joint signature requirement be removed, allowing Ms. Kovesdi’s previously filed response to be entered. To prevent this ‘952 application from going abandoned, it is respectfully requested that its prosecution be suspended under 37 C.F.R. § 1.103.

#### **STATEMENT OF FACTS**

1. Petitioner Rozsa Kovesdi filed the present application, Serial No. 10/035,952 (the ‘952 application) on December 26, 2001, claiming priority of provisional application Ser. No. 60/306,356, filed July 18, 2001 (the ‘356 application). In a declaration to the Patent Office Ms. Kovesdi listed herself and Mr. Ajit Rajasekharan as co-inventors of the ‘952

application; the same two are listed as co-inventors of the provisional '356 application, which has identical disclosure and claims. (Exh. A).

2. After attempts to reach out to Mr. Rajasekharan failed, on May 1, 2002 Ms. Kovesdi's filed a petition under 37 C.F.R. § 1.47(a) asking to prosecute the application on behalf of herself and the non-signing inventor. (Exh. B).

3. On June 4, 2002 Mr. Rajasekharan filed a petition under 37 C.F.R. § 1.182 in the '952 application, asking for appointment of a power of attorney by less than all applicants. The petition stated that Mr. Rajasekharan desires his own representation to prosecute the '952 application, because he is the sole inventor "of a substantial number of the presented claims including all independent claims," and that "a portion of the solely conceived claims are being prosecuted in a copending U.S. utility patent application" naming him as the sole inventor. Mr. Rajasekharan's June 4 petition also requested that both parties be required to sign all subsequent replies under MPEP §402.10, stating that "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources." (Exh. C, p.2).

4. The Patent Office dismissed Mr. Rajasekharan's June 4 petition, because the declaration filed along with this petition omitted Ms. Kovesdi as an inventor. In the same document the Patent Office invited Mr. Rajasekharan to consider filing his own application in case he believed the inventorship of the '952 application to be in error. (Exh. D).

5. On August 23, 2002, Mr. Rajasekharan filed a second, substantially similar petition under 37 C.F.R. § 1.182, which included a newly executed declaration, listing both himself and Ms. Kovesdi as co-inventors of the '952 application. (Exh. E).

6. On September 17, 2002, the Patent Office granted Mr. Rajasekharan's second 37 C.F.R. § 1.182 petition, dismissed Ms. Kovesdi's 37 C.F.R. § 1.47(a) petition, and imposed a requirement that all further correspondence be signed by representatives of both parties. (Exh. F).

7. The first Office Action in the '952 application, issued on March 18, 2003, rejecting all pending claims of the application. (Exh. G).

8. Mr. Rajasekharan provided a draft response to the Office Action on May 21, 2003, proposing to cancel all pending claims except dependent claims 43 and 44, and to include a statement that the canceled claims are pursued in U.S. Patent Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. (Exh. H, p.3). This draft response is the first time Mr. Rajasekharan stated his contentions concerning the inventorship of the claims in the '952 application, and included no support for these contentions.

9. Ms. Kovesdi's representatives drafted a separate response addressing all pending claims and provided this draft response to Mr. Rajasekharan for review and signature on September 15, 2003. (Exh. I).

10. On September 17, 2003 representatives of both parties discussed the response proposed by Ms. Kovesdi on the phone, and agreed that the response was not objectionable. On that basis, and to prevent the application from going abandoned for failure to respond, Ms. Kovesdi's representatives filed in the Patent Office the discussed response, although it was not signed by both parties. (Exh. J).

11. On September 22, 2003 Mr. Rajasekharan's representatives sent a letter insisting that their draft of the response should be filed, stating that "[a]lthough we find your technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case, the overall approach of this response is certainly adverse to Mr. Rajasekharan's interests as it continues Ms. Kovesdi's pursuit of claims solely conceived by Mr. Rajasekharan, i.e., renumbered claims 1-42 and 45-70." (Exh. K). Ms. Kovesdi's representatives filed on the same day a supplemental response to the Office Action, including a copy of the September 22 letter, and asked the Patent Office to accept it in lieu of Mr. Rajasekharan's signature. (part of Exh. K).

12. On December 16, 2003, the Patent Office issued an Office Action, stating that while the September 18 and 22, 2003 reply "appears to be *bona fide*," it lacked the signatures of both parties. The examiner gave applicants one month to correct. (Exh. L).

13. Representatives of Ms. Kovesdi have been unable to obtain Mr. Rajasekharan's signature, despite diligent efforts. In particular, following the December 16, 2003 Office Action, representatives of Ms. Kovesdi unsuccessfully requested Mr. Rajasekharan in letters dated January 6, 2004 and April 1, 2004 respectively and in other

communications, to sign the admittedly correct response they have prepared to the Office Action in the '952 application. (Exh. M).

14. On January 12, 2004, the Patent Office rejected Ms. Kovesdi's petition to join as a co-inventor in Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. The rejection is on the ground that she is not a "proper party in interest" apparently because she was not listed on the first executed declaration in this application. The Patent Office expressly stated that it did not consider the petition to join as a co-inventor on the merits. (Exh. N).

15. In March and early April 2004, representatives of both parties communicated again on issues related to the contested inventorship but were unable to reach an agreement. In particular, in a letter of April 8, 2004, Mr. Rajasekharan's representatives informed Ms. Kovesdi that the acceptable options in the '952 application are: (1) to cancel the claims that allegedly are solely Mr. Rajasekharan's contribution; (2) sign a joint petition to suspend the prosecution of the application; and (3) sign a joint request for the filing of a continuation application. The April 8 letter also states that "[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned." (Exh. O).

16. Unless a response to the Office Action dated December 16, 2003 is entered in the '952 application by June 16, 2004, the application will become abandoned.

### **ARGUMENT**

1. **Section 1.47 (a) Status Is Proper Because Mr. Rajasekharan Has Refused to Cooperate in the '952 Application**

37 C.F.R. 1.47 (a) provides that if a "joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor." Although Mr. Rajasekharan was allowed to join in the '952 application, his refusal to cooperate on any substantive matter during its means that *de facto* Mr. Rajasekharan refuses to join in this application. Thus, for the reasons set forth below, Section 1.47 (a) status of the '952 application is warranted.

The facts in the prosecution of the '952 application unambiguously establish that after Mr. Rajasekharan was allowed to join in by decision of the Patent Office dated September 17, 2002 (Exh. F), he has consistently obstructed the prosecution of the '952 joint application in favor of his '597 application, in which he is listed as the sole inventor. Specifically, in response to a March 18, 2003 Office Action in the '952 application, Mr. Rajasekharan has asserted repeatedly that the only response acceptable to him is to cancel all but two claims in the application in favor of prosecuting the claimed subject matter in his '597 application. *See* response drafted by Mr. Rajasekharan's representatives dated May 21, 2003, which draft includes an express statement that the canceled claims are pursued in U.S. Patent Application Ser. No. 09/987,597 (Exh. H); *see also* subsequent correspondence in Exh. J, where commenting on an alternative draft response proposed by Ms. Kovesdi, Mr. Rajasekharan's representatives stated that they "find [the] technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case," but would not cooperate because prosecuting such claims in the joint application is against Mr. Rajasekharan's interests; *see also* Mr. Rajasekharan's letter of April 8, 2004 (Exh. O), which gives Ms. Kovesdi only three options in this case: (1) to cancel the claims that allegedly are solely Mr. Rajasekharan's contribution; (2) sign a joint petition to suspend the prosecution of the application; or (3) sign a joint request for the filing of a continuation application. As noted, the April 8, 2004 letter also states that "[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned." (Exh. O).

Clearly, unless Ms. Kovesdi agrees with his unilateral assertion of sole inventorship of virtually all claims, Mr. Rajasekharan is going to ensure that no substantive response can be filed. Ms. Kovesdi respectfully requests that the facts concerning the prosecution of the '952 application be accepted as proof of refusal under MPEP 409.03 (d).

The above facts are plainly inconsistent with Mr. Rajasekharan properly joining the '952 application, in fact they virtually define a joint inventor who "refuses to join in an application" and indicate that he may have "joined in" the '952 application simply to prevent its normal prosecution on the merits. Thus, inventor Kovesdi respectfully submits that granting a Section 1.47(a) status of the '952 application is necessary to protect her interests - holding otherwise would be contrary to the spirit the rules of patent practice and would be demonstrably inequitable.

Likewise, the joint signature requirement pursuant to MPEP 402.10, which applies in this case is intended to protect the interests of parties who have retained separate representation. Mr. Rajasekharan has refused to sign any joint responses to the Patent Office in the '952 application that do not involve canceling of all claims that he has unilaterally decided to be his own invention. His insistence that these claims be canceled unquestionably is injurious to Ms. Kovesdi's interests in the claimed subject matter, in favor of those of Mr. Rajasekharan, which are admittedly protected in a separate, '597 application. Mr. Rajasekharan's unilateral determination of the issues, based solely on its own allegations is undoubtedly wrong and contrary to Patent Office's rules and practice.

For the foregoing reasons, Ms. Kovesdi respectfully requests that she be allowed to prosecute the application on behalf of herself and Mr. Rajasekharan without the joint signature requirement.

2. The Decision to let Mr. Rajasekharan Join in the '952 Application Was In Error

The '952 application should be granted Section 1.47(a) status also because the Patent Office's September 17, 2002 decision allowing Mr. Rajasekharan to join in the application (Exh. F) was improper and violates MPEP 409.03 (i).

Mr. Rajasekharan's first and second Section 1.182 declarations filed on June 4 and August 23, 2002 respectively (Exh. C and Exh. E), included an express statement that he is the sole inventor of "a substantial number of claims including all independent claims." This declaration also included a statement that he has already filed a patent application (apparently the '597 application, which was not identified at the time) directed "to a portion of the solely conceived claims."

MPEP 409.03 (i) provides that "if a nonsigning inventor feels that he or she is the sole inventor of an invention claimed in a 37 CFR 1.47 application naming him or her as a joint inventor, a nonsigning inventor may file his or her own application and request that he is or her application be placed in interference with the 37 CFR 1.47 application. If the claims in both the nonsigning inventor's application and the 37 CFR 1.47 application are otherwise found allowable, an interference may be declared."



It is clear therefore, that the Patent Office erred in allowing Mr. Rajasekharan to join in this application, because the Patent Office was already on notice that he “feels that he is the sole inventor” and has already filed a separate application covering a portion of the “solely conceived claims.” Ms. Kovesdi had no notice of the actual claims that appear in dispute until the April 8, 2004, when Mr. Rajasekharan confirmed which claims he considers his sole invention, and stated that unless Ms. Kovesdi agrees to “cooperate” with his unilateral decision, the joint ‘952 application will go abandoned or will be suspended until allowable subject matter is indicated in his ‘597 application. (Exh. O).

Accordingly, Ms. Kovesdi respectfully requests submits that Section 1.47(a) is warranted for the additional reason that the Patent Office’s decision to allow Mr. Rajasekharan to join in the ‘952 application was in error.

3. Unless the Request is Granted, Ms. Kovesdi Will Suffer Irreparable Harm

Mr. Rajasekharan’s April 8, 2004 letter (Exh. O) states that unless Ms. Kovesdi agrees to cancel the claims that he believes are his sole invention, “the application will become irrevocably abandoned.” With a pending deadline to respond to an Office Action and a requirement that both co-inventors sign any such response (Exh. L), it is clear that the ‘952 application may be abandoned through no fault of Ms. Kovesdi’s, unless the Patent Office intervenes without a delay. Abandonment without question will cause irreparable harm to Ms. Kovesdi’s interests in the application and any inventions described therein.

Furthermore, the joint signature requirement in the ‘952 application effectively leaves Ms. Kovesdi with no possibility to raise the inventorship issue before the Patent Office. Mr. Rajasekharan’s interests are protected in the co-pending ‘597 application that Ms. Kovesdi was not allowed to join. In contrast, Ms. Kovesdi cannot even raise the issue, because to do so in the ‘952 application would require Mr. Rajasekharan’s consent. But in the very first submission made in this application (Exh. C) Mr. Rajasekharan has expressed his preference “to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources” - in other words, to avoid interference and prosecution by Ms. Kovesdi. Working out a joint solution is one thing, precluding the other party’s choice in this matter, as appears to be Mr. Rajasekharan’s intention in this application, is quite another. Removing even the opportunity to present any issue for resolution before

the Patent Office is clearly inequitable, it is contrary to the spirit and letter of the Patent Office's rules and practice and should not be allowed.

In addition, it has come to Ms. Kovesdi's attention that a second patent application, Ser. No. 10/103,777 (the '777 application) has been filed on March 25, 2002, as a continuation-in-part of the '597 application. The '777 application also does not list Ms. Kovesdi as an inventor although it appears that subject matter claimed in at least some claims of the application was contributed by her. Mr. Rajasekharan and Readia, the company that seems to be the assignee of his applications, have already put Ms. Kovesdi on notice that the "ground rules" for her to be considered as co-inventor in the '597 and '777 applications would involve her providing documentary support of all her contributions (apparently for review by Mr. Rajasekharan or Readia) (Exh. O).

Finally, under Federal Circuit precedent Ms. Kovesdi may also lose any potential interest in the patent or patents that may issue from the '597 application, because of the possibility that such patents may be declared unenforceable. *See, Frank's Casing Crew and Rental Tools, Inc. v. PMR Technologies, Ltd.*, 63 USPQ.2d 1065, 1069 (Fed. Cir. 2002) ("if unenforceable due to inequitable conduct, a patent may not be enforced even by innocent co-inventors.").

**Conclusion**

For the foregoing reasons, Ms. Kovesdi respectfully requests that the '952 application be granted a 37 C.F.R. § 1.47(a) status, or in the alternative that the Patent Office removes the joint signature requirement currently in place to allow her representatives to prosecute the application on behalf of herself and co-inventor Ajit Rajasekharan. No fee is believed due with this submission. Please charge any required fees to Jones Day Deposit Account No. 503013. A copy of this submission is also being served on the representatives of Mr. Rajasekharan.

Date April 16, 2004

Respectfully submitted,

*for* *Dan Roth* *Regals 43,827*  
Ognjan V. Shentov

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:	RAJASEKHARAN et al.	Confirmation No.:	4321
Serial No.:	10/103,777	Art Unit:	2876
Filed:	March 25, 2002	Examiner:	LEE, Diane I.
For:	METHOD AND SYSTEM FOR AUTHORING AND PLAYBACK OFAUDIO COINCIDENT WITH LABEL DETECTION	Attorney Docket No.:	033393.0004 & 802959-999002

**REQUEST FOR RECOGNITION AS A PROPER PARTY UNDER 37 C.F.R. §§ 1.181-1.183**

Commissioner for Patents  
Office of Petitions  
P. O. Box 1450  
Alexandria, Va 20231

Dear Sir:

Inventor Rozsa Kovesdi respectfully requests the Commissioner to grant her Proper Party in Interest status in the above-captioned application, or in the alternative stay the prosecution to prevent issuance of any patents based on the above-captioned application to ensure that the disputed inventorship in the above-captioned application is resolved by the Patent Office on the merits to conform with 35 U.S.C. §§ 102(f), 116 & 131. Since the prosecution of the above-captioned application is already advanced, this is an urgent request to avoid irreparable harm to petitioner Kovesdi, who has no other remedy to her claims be heard due to the actions of the party prosecuting the above-captioned application as is explained herein. These actions have not only stalled the prosecution of the utility patent application naming Ms. Kovesdi ("the '952 application"), but also necessarily disrupt the proper examination of the above-captioned application by preventing examination of all of the issues on the merits.

Petitioner Kovesdi notes that the present procedures' failure to take this interconnectedness of the above-captioned application with other co-pending applications

into account will result in issuance of a patent based on the above-captioned application to an applicant who under 35 U.S.C. § 131 does not “appear to be entitled” to the patent. This result is likely since the Patent Office has allowed itself to be placed, by the party prosecuting the above-captioned application, in the position of deliberately not addressing the merits underlying the alleged inventorship in the above-captioned application even when faced with prior admissions that are inconsistent with the position now taken before the Patent Office. The procedural rule in question is a presumption that ordinarily prevents the Patent Office from examining the merits of a request by a party other than those already recognized as being Proper Parties in Interest. Thus, effective examination to ensure that a patent is not issued in contravention of 35 U.S.C. § 102(f), and consequently 35 U.S.C. § 131, in above-captioned application is not possible unless Ms. Kovesdi’s claim to being a co-inventor is evaluated on the merits in an evenhanded proceeding prior to the issuance of any patent based on the above-captioned application even if an Interference is avoided by the party presently prosecuting the above-captioned application.

Although, the Patent Office usually only recognizes the parties named in the first filed declaration as Proper Parties in Interest, this procedure is not suitable for the above mentioned application. Indeed this rule has to be rebuttable to allow justice to be done when it interferes with effective examination of an application. To ensure justice, this and other procedures that otherwise would prevent consideration of Ms. Kovesdi as a Proper Party in Interest should be waived or suspended pursuant to 37 C.F.R. § 1.183. Such a waiver/suspension will also ensure compliance with the statutory requirements for issuing a patent.

Specifically, petitioner Kovesdi, while clearly a co-inventor based on substantive evidence, such as, prior written admissions of inventor, Mr. Ajit Rajasekharan, is unable to actually file or maintain a utility application for a patent to ensure resolution of her claim to inventorship on the merits due to the actions of Mr. Rajasekharan. Therefore, she does not have the ability to seek the opportunity to timely resolve the disputed inventorship on the merits by the Patent Office in an Interference proceeding. This handicap prevents contested consideration (if the requested relief is denied) by the Patent Office of, for example, both general and specific admissions of Mr. Rajasekharan of Ms. Kovesdi’s contributions of in the form of

(i) conception and development of “coincident authoring;” a concept pervasive in all

of the claims in the above-captioned application; and

(ii) the subject matter introduced into many of the pending claims in the response filed on February 13, 2004 in the above-captioned application to overcome rejections. This subject matter was admitted in writing to be contributed by Ms. Kovesdi. At present all of the pending claims include Ms. Kovesdi's contributions.

This inability of petitioner Kovesdi to point out the obvious corrections required in the above-captioned application stems directly from the Patent Office's denial, a copy of which is attached as Exhibit H, of Ms. Kovesdi's petition to prosecute the only application that names her as an inventor, i.e., U.S. Patent Application No. 10/035,952 ("the '952 application") under the provisions of 37 C.F.R. § 1.47 (a). Further, the petition to join the '952 application by Mr. Rajasekharan was granted by the Patent Office, not appreciating his implicit intent to disrupt prosecution of the '952 application, as well as the proper examination of the above-captioned application and its parent application.

Mr. Rajasekharan had not expressly withdrawn his intention to use the requirement that both parties sign all subsequent replies in the '952 application for other than advancing fair prosecution. Specifically, in a previous rejected petition he stated "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources." The Patent Office granted the request for dual signatures without appreciating the continued, but implicit, disruptive intent.

By imposing this signature requirement, the Patent Office effectively provided Mr. Rajasekharan with the power to decide whether and how to resolve the disputed inventorship, effectively quenching petitioner Kovesdi's right to participate in substantive prosecution as is spelled out by their representatives in the April 8 letter in Exhibit T.

The firm indication that Mr. Rajasekharan considered this privilege as an opportunity to prevent any substantive prosecution in the '952 application was received in a communication received by the representatives of Ms. Kovesdi on April 8, 2004, which for the first time starkly laid out the options allowed to Ms. Kovesdi in violation of the duty of good faith. Perfecting a claim for an Interference with either the above-captioned application or the parent of the above-captioned application was not one of the options. Briefly, Ms. Kovesdi was given the limited options of (i) conceding the inventorship issue and canceling

any claims that may lead to an Interference proceeding; or (ii) seeking suspension of prosecution; or (iii) filing a continuation application rather than a technically correct response. No evidence of Ms. Kovesdi not being a co-inventor was provided to justify this drastic stance. A copy of the April 8 letter is attached as Exhibit T.

The actions of Mr. Rajasekharan, who is one of the alleged inventors in the above-captioned application, in denying Ms. Kovesdi the opportunity to contest the defective inventorship in the above-captioned application or present any of Mr. Rajasekharan's extensive admissions for consideration by the Patent Office require treating these disruptive actions in a related application as the required permission to allow Ms. Kovesdi to join the above-captioned application so that her claim to being a co-inventor is evaluated on the merits regardless of the disruptive efforts.

Petitioner Kovesdi has requested the Patent Office to revisit the decision to grant Mr. Rajasekharan's petition to join the '952 application in view of this conduct. She cannot, however, ensure that her rights in the above-captioned application will be protected by this request, which may fail to prevent issuance of a patent based on the above-captioned application, thus resulting in irreparable harm to her. The request to reconsider the decision in the '952 application is attached in Exhibit U (w/o exhibits).

The above situation is a testament of what can go wrong if the Patent Office's rules of practice are applied inconsistently or fail to take into account the equities in a case. These rules of practice are intended to protect the rights of the parties and the fairness of the process, not to unfairly treat one party for the benefit of another. Accordingly, in view of the Rajasekharan's refusal to cooperate in the prosecution of the '952 application, and to protect the interests of Ms. Kovesdi as an innocent co-inventor risking a complete loss of rights through no fault of her own, it is respectfully requested that this failure to cooperate be treated as the requisite permission or grounds for recognizing her as a proper party in interest in the above-captioned application to allow consideration of Mr. Rajasekharan's admission of petitioner Kovesdi's proper status as a co-inventor. In view of the admissions, Patent Office should fairly require resolution of the inventorship by adding Ms. Kovesdi as a co-inventor.

### **STATEMENT OF FACTS**

1. Petitioner Rozsa Kovesdi disclosed her ideas to Mr. Ajit Rajasekharan while developing object and location linking technology over a period of about seven months in the year 2001. This disclosure is extensively documented by email messages. The development was provided its impetus by Ms. Kovesdi's contributions. For example, one "key contribution" according to Mr. Rajasekharan was the notion of coincident authoring, which means binding content to a label associated with an object immediately after detecting the label. In an email from Mr. Rajasekharan to Ms. Kovesdi dated April 30, 2001, Mr. Rajasekharan admits that Ms. Kovesdi was responsible for this key idea. (Exh A, 2<sup>nd</sup> email & abstract of attachment in 3<sup>rd</sup> email)

2. Mr. Rajasekharan admitted to Ms. Kovesdi's conception of the proper form factor for the device being developed. Specifically, Ms. Kovesdi suggested a pen-like shape for the device. The device form factor clearly served both the aesthetic and utilitarian goals in designing a commercial device. Mr. Rajasekharan agreed in an email message dated August 22, 2001 noting that he was "convinced" that Ms. Kovesdi's idea is the right way to go about it. (Exh. B).

3. Ms. Kovesdi & Mr. Rajasekharan filed the provisional application, Ser. No. 60/306,356, on July 18, 2001 (the '356 application), which included seventy claims of which sixty-seven were retained as such in the parent of the above-captioned application.

4. Due to mutual disagreements between Mr. Rajasekharan and Ms. Kovesdi, Mr. Rajasekharan undertook to summarize the relative contributions of the two and those of Mr. Travis Millman, a named inventor in the above-captioned application in an August 31, 2001 email message to Ms. Kovesdi. Mr. Rajasekharan, while acknowledging the relatively low threshold of contribution to at least one claim for co-inventorship, went on to admit "[t]he system patent – the one we already filed, there is no doubt in my mind about who its inventors are – Rozi and Ajit in equal measure." The terms 'system patent' refer to the '356 application. (Exh. D at page 6, 4<sup>th</sup> full paragraph).

5. On November 15, 2001 Mr. Rajasekharan filed United States Patent Application 09/987,597 ("the '597 application), claiming priority to the '356 application and naming himself as sole inventor and omitting Ms. Kovesdi as co-inventor. The above captioned application is a continuation-in-part of the '597 application through which it



claims priority to the '356 application. Further, Ms. Kovesdi then filed the utility application, Ser. No. 10/035,952 (the '952 application) on December 26, 2001, also claiming priority of the '356 application. In a declaration to the Patent Office Ms. Kovesdi listed herself and Mr. Ajit Rajasekharan as co-inventors of the '952 application; the same two are listed as co-inventors of the provisional '356 application, which has identical disclosure and claims. As a result, the published '952 application lists Ms. Kovesdi and Mr. Rajasekharan as co-inventors (Exh. C).

6. After attempts to reach out to Mr. Rajasekharan failed, on May 13, 2002 Ms. Kovesdi filed a petition under 37 C.F.R. § 1.47(a) asking to prosecute the '952 application on behalf of herself and the non-signing inventor. (Exh. E).

7. On June 4, 2002 Mr. Rajasekharan filed a petition under 37 C.F.R. § 1.182 in the '952 application, asking for appointment of a power of attorney by less than all applicants. The petition stated that Mr. Rajasekharan desires his own representation to prosecute the '952 application, because he is the sole inventor "of a substantial number of the presented claims including all independent claims," and that "a portion of the solely conceived claims are being prosecuted in a copending U.S. utility patent application" naming him as the sole inventor. Mr. Rajasekharan's June 4 petition also requested that both parties be required to sign all subsequent replies under MPEP §402.10, stating that "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources." (Exh. F, p.2).

8. The Patent Office dismissed Mr. Rajasekharan's June 4 petition in the '952 application, because the declaration filed along with this petition omitted Ms. Kovesdi as an inventor. In the same document the Patent Office invited Mr. Rajasekharan to consider filing his own application in case he believed the inventorship of the '952 application to be in error. (Exh. G, p.1).

9. On September 17, 2002, the Patent Office granted Mr. Rajasekharan's second 37 C.F.R. § 1.182 petition, which included a newly executed declaration, listing both himself and Ms. Kovesdi as co-inventors of the '952 application, dismissed Ms. Kovesdi's 37 C.F.R. § 1.47(a) petition, and imposed a requirement that all further correspondence be signed by representatives of both parties. (Exh. H).

10. The first Office Action in the '952 application, issued on March 18, 2003, noted that 67 of the 70 pending claims were provisionally rejected for statutory double patenting in view of the pending claims in the parent of the present application, the '597 application. (Exh. I, p.3).

11. On May 15, 2003 the above-captioned application was published and that was the first time that Ms. Kovesdi learnt of its existence although it had been filed on March 25, 2002. (Exh. J)

12. Mr. Rajasekharan proposed, on May 21, 2003, to cancel all pending claims except dependent claims 43 and 44, in the '952 application and to include a statement that the canceled claims are pursued in U.S. Patent Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. (Exh. K, p.1 & 3). This draft response is the first time Mr. Rajasekharan stated his specific contentions concerning the inventorship of particular claims in the '952 application, and included no support for these contentions.

13. Ms. Kovesdi's representatives drafted a separate response addressing all pending claims and provided this draft response to Mr. Rajasekharan for review and signature on September 15, 2003. (Exh. L).

14. On September 22, 2003 Mr. Rajasekharan's representatives sent a letter insisting that their draft of the response should be filed, stating that "[a]lthough we find your technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case, the overall approach of this response is certainly adverse to Mr. Rajasekharan's interests as it continues Ms. Kovesdi's pursuit of claims solely conceived by Mr. Rajasekharan, i.e., renumbered claims 1-42 and 45-70." (Exh. M). Ms. Kovesdi's representatives filed on the same day a supplemental response to the Office Action, including a copy of the September 22 letter, and asked the Patent Office to accept it in lieu of Mr. Rajasekharan's signature.

15. Ms. Kovesdi's representatives drew the attention of Mr. Rajasekharan's representatives to the improper inventorship declared in the above-captioned application in a letter dated September 29, 2003 and October 9, 2003. (Exh. N). Mr. Rajasekharan's representatives responded by asserting that the claimed invention of the above captioned application was not even conceived prior to the time when the relationship between Ms. Kovesdi and Mr. Rajasekharan soured, i.e., on or about September 14, 2001.

16. The Patent Office mailed on November 13, 2003 a rejection of all but one claim of the pending claims in the above-captioned application based on obviousness-type double patenting in view of the pending claims 1-70 of the parent '597 application. (Exh. O, p.10). 1-70 claims of the '597 application were also used by the Patent Office to make a statutory double patenting rejection of 67 of the 70 claims in the '952 application. (See, Exh. I, p.3).

17. On December 16, 2003, the Patent Office issued an Office Action, stating that while the September 18 and 22, 2003 reply in the '952 application "appears to be bona fide," it lacked the signatures of both parties. The examiner gave applicants one month to correct. Representatives of Ms. Kovesdi have been unable to obtain Mr. Rajasekharan's signature, despite diligent efforts. In particular, following the December 16, 2003 Office Action, representatives of Ms. Kovesdi unsuccessfully requested Mr. Rajasekharan in letters dated January 6, 2004 and in other communications, to sign the admittedly correct response to the Office Action in the '952 application. (Exh. P).

18. On January 12, 2004, the Patent Office rejected Ms. Kovesdi's petition to join as a co-inventor in Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. The rejection is on the ground that she is not a "proper party in interest" apparently because she was not listed on the first executed declaration in this application. The Patent Office expressly stated that it did not consider the petition to join as a co-inventor on the merits. (Exh. Q).

17. In the above-captioned application, a response was filed on February 13, 2004 which amended some of the pending claims, e.g., claim 15, to further include specific subject matter that was conceded previously to be due to Ms. Kovesdi in an email message. (Exh. R). This subject matter was also relied upon to overcome a rejection under 35 U.S.C. § 112. (Exh. R, p.13-14 quoting from the specification with the admitted contribution of Ms. Kovesdi underlined). No attribution to Ms. Kovesdi was provided.

18. Ms. Kovesdi's representatives again informed Mr. Rajasekharan's representatives in a letter dated April 1, 2004 that Ms. Kovesdi's rights were being violated by inclusion of her contributions in the above-captioned application. (Exh. S).

19. In a letter of April 8, 2004, Mr. Rajasekharan's representatives informed Ms. Kovesdi that the acceptable options in the '952 application are: (1) to cancel the claims that

allegedly are solely Mr. Rajasekharan's contribution; (2) sign a joint petition to suspend the prosecution of the application; and (3) sign a joint request for the filing of a continuation application. The April 8 letter also states that "[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned." (Exh. T). No explanation for the continued use of Ms. Kovesdi's contributions over her protests was provided.

### **ARGUMENT**

#### **Stalling the prosecution of the '952 application necessarily disrupts the proper examination of the above-captioned application by preventing examination of the alleged inventorship which requires waiving the presumption preventing the Patent Office from addressing challenges to inventorship on the merits**

Although the presumption that Proper Parties in Interest in the first instance are determined by the first filed declaration or the assignments has been adopted for efficient ex parte examination of applications by separating subject matter from inventorship issues, it is only a useful presumption that furthers the objectives of 35 U.S.C. § 122(c) when an Interference proceeding is subsequently available to determine Inventorship. However, the presumption is necessarily rebuttable if it can be shown that no Interference proceeding is available due to the actions of the already recognized Proper Parties in Interest and through no fault of an innocent excluded inventor and that an insistence on the presumption it is actually defeating other statutory provisions and regulations.

The Patent Office has limited authority to examine and issue patent applications under 35 U.S.C. §§ 131 & 135, which includes examination to prevent issuance of applications that should be rejected under 35 U.S.C. § 102(f). If adherence to the presumption results in ineffective examination by undercutting or avoiding Interference proceedings, then the presumption has to be waived, e.g., by treating such a showing as being sufficient to rebut it. A proper rebuttal argument then has to show (i) that Interference proceedings are compromised, (ii) there is evidence that needs to be examined on the merits since it raises clear doubts about patentability that would otherwise go unaddressed, and (iii) likely irreparable harm to an affected party that can be avoided by rebutting the presumption.

Ms. Kovesdi has satisfied these requirements by showing that (i) her right to seek an interference proceeding has been compromised by the opposing party also seeking to enforce the presumption; (ii) admissions ascribable to the opposing party show that she has a

substantiated claim to be a co-inventor; and (iii) case law likely provides her no relief if the Patent Office insists on issuing a patent, even if invalid or unenforceable, to the incorrect inventive entity.

The mutually consistent admissions in Exhibits A, B, and D establish that the presently declared inventive entity of the above-captioned application does not appear to be entitled to a patent pursuant to 35 U.S.C. §§102(f) & 131 because of the failure to include petitioner Kovesdi. Ms. Kovesdi has no opportunity to correct this error in inventorship through an Interference in the above-captioned application. Moreover, improper exclusion of an inventor may result in an unenforceable patent that cannot be enforced by even the excluded innocent inventor.

To further substantiate her assertion of co-inventorship for the purpose of this petition, the salient facts for considering Mr. Rajasekharan's admissions are summarized herein. It is clear that the claimed subject matter in the above-captioned application is insignificantly different from that presented in the provisional '356 application. This follows from the Patent Office's determinations since, the above-captioned application had all but one of its claims rejected for double patenting in view of the claims of the '597 application, see Exhibit O. Almost all (67 of 70) of the claims in the '597 application are identical to those in the '356 application. The '356 application is identical to the '952 application, and both identify Ms. Kovesdi as an inventor. Not surprisingly, the Patent Office rejected 67 of the claims in the '952 application for statutory double patenting over the '597 application. Therefore, the record of the above-captioned-application itself with other determinations of the Patent Office establishes that the claimed subject matter in the above-captioned application is substantially similar to that disclosed in the '597, the '356 and the '952 applications.

**Mr. Rajasekharan has admitted that petitioner Kovesdi contributed key features of most of the claims pending in the above-captioned application.**

**1. Mr. Rajasekharan admitted in a detailed email dated August 31, 2001 that Ms. Kovesdi and Mr. Rajasekharan were inventors in equal measure**

Mr. Rajasekharan, in an email dated August 31, 2001, conceded petitioner Kovesdi's contribution in terms that are striking for their clarity: "[l]et me get the facts straight . . . The

system patent – the one we already filed, there is no doubt in my mind about who its inventors are – Rozi and Ajit in equal measure.” See, e.g., page 6, 4<sup>th</sup> full paragraph in **Exhibit D**, which provides a copy of the entire document. The terms ‘system patent’ refer to the ‘356 application to which priority is claimed by the above-captioned application while ‘Rozi’ refers to petitioner Kovesdi.

Mr. Rajasekharan concedes the extensive contributions made by petitioner Kovesdi. For example, he states on page 8 of **Exhibit D**, that in “fact, even with both our contributions to the system and device patent – there have been several instances where I would say some statement which may not have a direct relevance to a claim but it would trigger the right idea in you and vice versa. *Most* of the claims in our system are the results of such confluences of both our ideas – to me it is a *futile* exercise to dissect them apart and say who contributed what” (emphasis added). See, e.g., page 8, lines 13-15 of **Exhibit D**. Here, the terms ‘device patent’ and ‘system patent’ refer to the above-captioned application and the ‘356 application, the grandparent of the above-captioned application, respectively.

**2. Mr. Rajasekharan specifically admitted that Petitioner Kovesdi contributed a key idea, which is present in all of the original as well as pending claims of the above-captioned application**

Mr. Rajasekharan admitted that petitioner Kovesdi conceived of a ‘key’ idea in direct conflict with the declaration filed in the above-captioned application. In an email message sent on April 30, 2001, to petitioner Kovesdi, Mr. Rajasekharan noted that the “key idea that you mentioned in your kitchen . . . .That is a very important one – it solves the problem of maintaining association between objects, labels, and the authored content” (emphasis added). See, e.g., the second email message in **Exhibit A**. Mr. Rajasekharan noted in the same email communication that he had added this key idea to the abstract of the document describing their invention. A copy of the relevant email communications including those with the modified attachments that were sent later are provided in **Exhibit A**.

The only sentence added by Mr. Rajasekharan to the abstract of the description of the joint invention, sent as an attachment in a subsequent email, contains the *key idea* contributed by petitioner Kovesdi reads “[i]n the authoring mode the device supports content authoring to immediately follow object scanning – this enables authored content to be unambiguously bound to the scanned object and thus solving the problem of maintaining

correspondence between physical object, object label and the authored content” (emphasis added). See, e.g., attachment to the third email message, dated May2, 2001, in **Exhibit A**.

This concededly key idea is present in all of the independent claims of the above-captioned application, which are listed in the response filed on February 13, 2004 to the Office Action provided in **Exhibit R**. For example, claim 1 of the above-captioned application reads in pertinent part “[a]n apparatus comprising: a scanner for acquiring first data associated with a label; an input for acquiring second data; and a processor for processing data and creating binding data binding said first data to said second data.” The emphasized language goes to the heart of the claim with the processor immediately operating on the acquired first and second data to create a binding data to effect unambiguous binding. Similarly, remaining independent claims in the above-captioned application include this key idea.

The key idea is also easily located in the background of the above-captioned application, which reads “One disadvantage of [the prior art] is that a user is burdened with the responsibility of manually maintaining the association between label data and authored content” (emphasis added). See, paragraph # 11 of the published version of the above-captioned application, which is included in **Exhibit J**. Then it goes on in paragraph # 14 in the Summary of the Invention section of the above-captioned application to note that the “present invention *overcomes* these and other deficiencies of the related art by providing a labeling detection and recording/playback scheme that enables label detection coincident with the recording and playback of authored content, e.g., audio.”

3. **The response submitted in the ‘777 application on February 13, 2004 amended the claims to further add admitted contributions of petitioner Kovesdi**

**Exhibit B** provides a copy of an email message dated August 22, 2001 from Mr. Rajasekharan to petitioner Kovesdi that admits that petitioner Kovesdi came up with the idea of a pen-like shape for the device. In the attached email, Mr. Rajasekharan states that “I am convinced your notion of the pen form factor is the right way to look at it.

In an effort to obtain allowance of the pending claims, the response filed in the ‘777 application amends claim 15 to add that said “housing is substantially shaped as a writing

instrument,” which includes a pen-like shape, and is anticipated or obvious in view thereof since it is well established that a species anticipates a genus. Similar amendments were also made to additional claims such as claims 16, 17, 20-22, among others. See, e.g., **Exhibit R**.

**The Federal Circuit has held that a patent that fails to name an inventor due to inequitable conduct may be unenforceable even by the innocent inventor**

The Federal Circuit has emphasized that “if unenforceable due to inequitable conduct, a patent may not be enforced even by innocent co-inventors. One bad apple spoils the entire barrel. Misdeeds of co-inventors, or even a patent attorney, can affect the property rights of an otherwise innocent individual.” See, Frank’s Casing Crew and Rental Tools, Inc. v. PMR Technologies, Ltd., 63 USPQ.2d 1065, 1069 (Fed. Cir. 2002).

Frank’s Casing held that a patent was unenforceable due to inequitable conduct where two named inventors deliberately concealed a true inventor’s involvement in the conception of the invention. Frank’s Casing confirmed that the US Patent No. RE 34,063, a reissue of US Patent No. 4,091,451 (“the ‘451 patent”), was unenforceable due to inequitable conduct on part of inventors who filed the underlying patent application for the ‘451 patent and excluded an inventor by not naming him as a co-inventor. See, Frank’s Casing at 1069. The Court clarified that even if the guilty inventors were not the true inventors, the patent tainted by their acting in bad faith or with deceptive intent was unenforceable and even the innocent inventor could not enforce it. Ibid.

**CONCLUSION**

Therefore, petitioner Kovesdi respectfully requests that she be expressly recognized as being a Proper Party in Interest in the above-captioned application to allow evaluation of her inventorship claim on the merits. Not only is such a determination in agreement with the evidence in the record, common sense, and equity, it would also serve to make the prosecution fair and allow consideration of facts on the merits rather than invite the burden associated with inequitable conduct in the above-captioned application.

Petitioner Kovesdi is also attaching a request to correct the inventorship under 37 CFR § 1.48. A copy of the request has been provided to the representative of party prosecuting the above-captioned application to obtain the necessary consents required by 37 CFR § 1.48. Further, recognizing the possible hurdles in obtaining the consent of the assignee, and co-inventors Mr. Ajit Rajasekharan and Mr. Travis Millman, petitioner Kovesdi



respectfully requests that in view of the evidence submitted herein, if the consent of the assignee, Mr. Rajasekharan, and Mr. Millman cannot be obtained, such consent be required or presumed as is allowed pursuant to 37 CFR §§ 10.18(c) & 1.83.

In view of the facts and arguments presented herein, it would be beneficial if the interests of each party, and Ms. Kovesdi, were represented by their own respective counsel and both parties or their representatives be required to sign all subsequent replies under MPEP §402.10. Such a requirement will remove the incentive to exclude or otherwise misuse the privileges by bringing the rights of the parties into parity. Therefore, please accept the attached power of attorney pursuant to 37 C.F.R. § 1.182.

The undersigned further declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.

The authorization for payment of the estimated fees for processing this request under 37 CFR §§ 1.182, 183 & 1.48 and any other required fee is attached on a separate sheet. A copy of this submission is being served on the representatives of the party prosecuting the above-captioned application.

Date April 22, 2004

Respectfully submitted,



Ms. Rozsa Kovesdi  
(Applicant/Petitioner)